165-518

165-518 **No. 311**

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE NINTH CIRCUIT.

EDWIN NORTON and OLIVER W. NORTON,

Appellants,

vs.

M. A. WHEATON,

Appellee.

639

TRANSCRIPT OF RECORD.

Appeal from the Circuit Court of the United States, for the Northern District of California.

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NOTE.—The printed copy of the record on appeal in the case of *Wheaton* vs. *Norton*, No. 141, in U. S. Circuit Court of Appeals, which formed a part of the record on appeal in this case, was by stipulation omitted from the printed record herein, for the purpose of saving expense. While said record in *Wheaton* vs. *Norton* is not in any respect material or necessary to the decision of any question on this application, still we file with the clerk a printed copy of that record, so that it may be examined if any member of the Court desires it. J. H. M.

s for the

Appellants,

vs.

No. 311.

M. A. WHEATON,

Appellee.

Stipulation as to Printing Record.

It is hereby stipulated and agreed that in printing the record on appeal now on file in this case, the clerk of the court may omit therefrom the printed copy of the record on appeal in the case of Wheaton v. Norton, No. 141, which is attached to the record on appeal herein.

The object of this stipulation being to save the expense of printing a second time a portion of the record which has already been printed in the case of Wheaton v. Norton.

Dated at San Francisco, Aug. 5th, 1896.

MUNDAY, EVARTS & ADCOCK,
JNO. H. MILLER,
Attorneys for Appellant.
WHEATON, KALLOCH & KIERCE,
Attorneys for Appellee.

[Endorsed]: Filed Aug. 5, 1896. F. D. Monckton, Clerk.

At a stated term, to-wit, the February term, A. D. 1896, of the Circuit Court of the United States of America, of the Ninth Judicial Circuit, in and for the Northern District of California, held at the courtroom in the City and County of San Francisco, on Thursday the 19th day of March, in the year of our Lord one thousand eight hundred and ninety-six.

Present: The Honorable JOSEPH McKENNA, Circuit Judge.

EDWIN NORTON, et al.,
vs.
MILTON A. WHEATON. } No. 11,680:

Order for Entering of Mandate and for Decree.

Upon motion of F. J. Kierce, Esq., counsel for respondent, ordered that the mandate of the United States Circuit Court of Appeals for the Ninth Circuit herein, be filed and spread upon the minutes of this court; and it is further ordered upon motion of the said F. J. Kierce, Esq., that a decree be filed and entered herein dismissing complainants' bill with costs.

Mandate from U. S. Circuit Court of Appeals.

UNITED STATES OF AMERICA, ss.

The President of the United States of America, to the Honorable the Judges of the Circuit Court of the United States for the Northern District of California, Greeting:

[Seal]

Whereas, lately in the Circuit Court of the United States, for the Northern District of California, before you, or some of you, in a cause between Edwin Norton and Oliver W. Norton, complainants, and Milton A. Wheaton, respondent, an interlocutory decree was duly filed and entered, in favor of said complainants, which said decree is of record in the office of the clerk of said Circuit Court; to which record reference is hereby made and the same is hereby expressly made a part hereof, and as by the inspection of the transcript of the record of the said Circuit Court, which was brought into the United States Circuit Court of Appeals, for the Ninth Circuit, by virtue of an appeal agreeably to the act of Congress, in such cases made and provided, fully and at large appears,

And whereas, in a term of October, and in the year of our Lord one thousand eight hundred and ninety-five, the said cause came on to be reheard before the said Cir-

cuit Court of Appeals, on the said transcript of record, and was argued by counsel:

On consideration whereof. it is now here ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in this cause be, and the same is hereby reversed, with costs, and the cause is remanded with directions to said Circuit Court to dismiss the bill at complainants' cost.

(October 31, 1895.)

You, therefore, are hereby commanded that such reversal and further proceedings be had in said cause, not inconsistent with the opinion and decree of this court, and as according to right and justice, and the laws of the United States, ought to be had, the said decree of said Circuit Court notwithstanding.

Witness, the Honorable MELVILE W. FULLER, Chief Justice of the Supreme Court of the United States, the 19th day of March, in the year of our Lord one thousand eight hundred and ninety-six.

F. D. MONCKTON,

Clerk of the United States Circuit Court of Appeals for the Ninth Circuit.

COSTS OF APPELLANT.

Clerk's fees in lower court preparing record.....	$119.00
" " 12 copies of patents for original transcript.....	1.20
" " Circuit Court of Appeals, filing record, etc.	25.00
" " order recalling mandate, etc.....	.20
" " issuing second mandate.....	5.00

Clerk's fees filing petition for rehearing and costs thereon	7.50
Printing record on appeal	355.20
30 copies U. S. letters patent No. 267,014, granted to Edwin Norton	3.00
30 copies U. S. letters patent No. 477,584, granted to M. A. Wheaton	3.00
30 copies U. S. letters patent No. 376,804, granted to M. Jensen	3.00
30 copies U. S. letters patent No. 274,363, granted to Norton and Hodgson	3.00
30 copies U. S. letters patent No. 371,484, granted to Angell and Kendall	3.00
30 copies U. S. letters patent No. 391,912, granted to Angell and Kendall	3.00
30 copies U. S. letters patent No. 152,757, granted to Geo. A. Marsh	3.00
30 copies of U. S. letters patent No. 235,700, granted to Geo. H. Pierce	3.00
30 copies U. S. letters patent No. 238,079, granted to Dillon and Cleary	3.00
30 copies U. S. letters patent No. 238,351, granted to Wm. J. Clark	3.00
Solicitor's docket fee on appeal	20.00
Affidavit to this cost bill	.25
Total, taxed at	$563.35

F. D. MONCKTON,
Clerk.

[Endorsed]: Filed and entered Mch. 19th, 1896. W. J. Costigan, Clerk.

In the Circuit Court of the United States, Ninth Circuit, Northern District of California.

EDWIN NORTON, et al., Complainants,
vs.
MILTON A. WHEATON, Respondent. } No. 11,680.

Enrollment.

This cause having been appealed to the Circuit Court of Appeals for the Ninth Judicial Circuit, Northern District of California, and, after being duly heard in said Circuit Court, the judgment of the lower court was reversed, and the bill of complaint herein ordered dismissed, the mandate of said Circuit Court of Appeals being annexed hereto; that on the 19th day of March, A. D. 1896, an order was made in pursuance of said order, and on the same day a decree dismissing the bill of complaint here in, was duly filed and entered, which is hereto annexed.

At a stated term, to-wit, the February term, A. D. 1896, of the Circuit Court of the United States of America, of the Ninth Judicial Circuit, in and for the Northern District of California, held at the courtroom in the City and County of San Francisco, on Thursday, the 19th day of March, in the year of our Lord one thousand eight hundred and ninety-six.

Present: The Honorable JOSEPH McKENNA, Circuit Judge.

EDWIN NORTON, et al.,
Complainants,
vs.
MILTON A. WHEATON,
Respondent.
No. 11,680

Decree.

This cause having been tried before this court and an interlocutory decree entered in favor of complainants, on the 22d day of July 1893, from which decree an appeal was duly allowed and prosecuted in the United States Circuit Court of Appeals for the Ninth Judicial Circuit, from which a mandate has been duly issued to this Court reversing the said decree of this Court, and ordering that the bill of complaint herein be dismissed:

Thereupon, upon consideration thereof, it is ordered, adjudged, and decreed that the complainants' bill of complaint herein be and the same hereby is dismissed and

that respondent recover his costs herein taxed at $703.65/100.

Dated March 19th, 1896.

JOSEPH McKENNA, Judge.

[Endorsed]: Filed and entered March 19th, 1896. W. J. Costigan, Clerk.

In the Circuit Court of the United States, Ninth Circuit, Northern District of California.

EDWIN NORTON and OLIVER W. NORTON,
Complainants,
vs.
MILTON A. WHEATON,
Respondent.
No. 11,680.

Memorandum of Costs and Disbursements.

Clerk's fees, original deposit, including cost of a copy of bill of complaint	$ 20.00
Clerk's fees, accrued costs	4.60
E. H. Heacock, examiner's fees	75.00
Exhibits in evidence:	
Certified copy file wrapper complainants' patent.	6.50
Copies of Marsh patent, Geo. H. Pierce patent, Dillon & Cleary patent, and W. J. Clark patent, introduced in evidence	.40

Deposition witness fees for five witnesses, to wit: Melville E. Dayton, Arthur F. L. Bell, H. B. Angell, R. D. Hume, and Wales L. Palmer, at $2.50 each	12.50
Docket fee	20.00
Affidavits to bond on appeal	.50
Affidavit to this cost bill	.25
Total	$139.75
Costs taxed in the mandate from the U. S. Circuit Court of Appeals of the Ninth Circuit	563.90
Mch. 21/96, Costs taxed at	$703.65

W. J. COSTIGAN, Clerk.

United States of America,
Northern District of California,
City and County of San Francisco. } ss.

F. J. Kierce, being duly sworn, deposes and says that he is one of the solicitors for the respondent in the above-entitled cause and as such, is better informed relative to the above costs and disbursements, than the said respondent; that the items in the above memorandum contained are correct to the best of this deponent's knowledge and belief, and that the said disbursements have been necessarily incurred in the said cause.

F. J. KIERCE.

Subscribed and sworn to before me this 19th day of March A. D., 1896.

W. B. BEAIZLEY.

Commissioner of the U. S. Circuit Court, Northern District of California.

To Messrs. Haven & Haven, and Messrs Munday, Evarts & Adcock, solicitors for complainants:

You will please take notice that on Saturday, the 21st day of March, A. D. 1896, at the hour of 10:30 o'clock A. M., we will apply to the clerk of said Court to have the within memorandum of costs and disbursements taxed pursuant to the rule of said Court, in such case made and provided.

WHEATON, KALLOCH & KIERCE,
Solicitors for Respondent.

Service of within memorandum of costs and disbursements, and receipt of a copy thereof, acknowledged this 19th day of March, 1896.

MUNDAY, EVARTS & ADCOCK,
By J. H. MILLER,
Solicitors for Complainants.

[Endorsed]: Filed March 20th. W. J. Costigan, Clerk.

Certificate to Enrollment.

Whereupon, said mandate, decree dismissing bill, and a memorandum of taxed costs (accruing in the U. S. Circuit Court of Appeals), and since filing mandate in this court, are hereto annexed, said final decree being

duly signed, filed, and enrolled pursuant to the practice of said Circuit Court.

Attest, etc.,

[Seal] W. J. COSTIGAN,
Clerk.

[Endorsed]: Enrolled Papers. Filed March 19th, 1896. W. J. Costigan, Clerk.

In the Circuit Court of the United States for the Northern District of California.

EDWIN NORTON and OLIVER W. NORTON,
Complainants,
vs.
MILTON A. WHEATON,
Respondent.
} No. 11,680.

Petition for an Order Allowing Appeal.

Petition of complainants for an order allowing an appeal from the final decree heretofore entered in this case, to the United States Circuit Court of Appeals for the Ninth Circuit.

Edwin Norton and Oliver W. Norton, complainan

the above-entitled cause, feeling themselves aggrieved by the final decree heretofore made and entered by this court in this cause on the 19th day of March, 1896, whereby it was ordered, adjudged, and decreed, that the said cause be dismissed and that the said respondent Milton A. Wheaton have judgment against the said complainants Edwin Norton and Oliver W. Norton for costs amounting to $703–65/100, come now by John H. Miller as solicitor and counsel, and petition this court for an order allowing them, the said complainants, to prosecute an appeal on the said final decree to the Honorable United States Circuit Court of Appeals for the Ninth Circuit, under and according to the laws of the United States in that behalf made and provided, and also that an order be made fixing the amount of security which the complainants shall give and furnish upon such appeal, and upon the giving of such security all further proceedings in this court be superseded and stayed until the determination of the said appeal by the said United States Circuit Court of Appeals for the Ninth Circuit.

And your petitioner will ever pray, etc.

MUNDAY, EVARTS & ADCOCK, and
JNO. H. MILLER,

Solicitors and of Counsel for Complainants.

In the Circuit Court of the United States for the Northern District of California.

EDWIN NORTON and OLIVER W. NORTON,
Complainants,
vs.
MILTON A. WHEATON,
Respondent.
No. 11,680.

Assignment of Errors.

Now comes Edwin Norton and Oliver W. Norton, complainants and appellants herein, by John H. Miller, Esq., their solicitor and counsel, and particularly specify the following as the errors upon which they will rely and which they will urge on their appeal in the above-entitled cause to the Honorable the United States Circuit Court of Appeals for the Ninth Circuit, from the final decree heretofore made and entered in the Circuit Court of the United States for the Northern District of California, whereby it was ordered, adjudged, and decreed that said suit be dismissed and that the respondent Milton A. Wheaton, have judgment for his costs, amounting to $703.65-100, against the said Edwin Norton and Oliver W. Norton, complainants.

The Honorable the Circuit Court of the United States

for the Northern District of California, which entered the said final decree in said cause, erred:

I.

In dismissing the said suit and entering a final decree therein in favor of the said Milton A. Wheaton for his costs against the said Edwin Norton and Oliver W. Norton.

II.

In not submitting and referring the said cause to the standing master in chancery to take an accounting of damages and profits.

III.

In not dismissing and setting aside the injunction contained in the interlocutory decree, and allowing the said interlocutory decree to stand as to all the other matters and things therein adjudged and decreed.

IV.

In holding and deciding that the can-heading machines made and sold by the respondent, Milton A. Wheaton, were not an infringemeut of the letters patent sued on.

V.

In holding and deciding that the complainants, Edwin Norton and Oliver W. Norton, were not entitled to an

accounting of damages and profits suffered and realized from and by reason of the infringement by the said respondent upon the patent sued on.

VI.

In rendering a final decree dismissing the suit prior to the taking and stating of an accounting of damages and profits by the standing master of chancery.

VII.

In making, rendering, and entering said final decree dismissing the suit before there was any report made and filed in said cause by the standing master in chancery.

VIII.

In making, rendering, and entering a final decree awarding to the said Milton A. Wheaton costs.

All of which is respectfully submitted.

MUNDAY, EVARTS & ADCOCK, and
JNO. H. MILLER,
Solicitor and of Counsel for Appellants, Complainants below.

[Endorsed]: Filed May 11, 1896, W. J. Costigan, Clerk. By W. B. Beaizley, Deputy Clerk.

At a stated term, to wit, the February term, A. D. 1896, of the Circuit Court of the United States of America, of the Ninth Judicial Circiut, in and for the Northern District of California, held at the court-room in the City and County of San Francisco, on Thursday the 14th day of May, in the year of our Lord one thousand eight hundred and ninety-six.

Present: The Honorable JOSEPH McKENNA, Circuit Judge.

EDWIN and OLIVER W. NORTON,
vs.
MILTON A. WHEATON.
} No. 11,680.

Order Allowing Appeal.

On reading and filing the petition of Edwin Norton and Oliver W. Norton, complainants herein, for an order allowing an appeal, and the assignment of errors herein made and filed by the said Edwin Norton and Oliver W. Norton, on motion of John H. Miller, Esq., of counsel for said complainants and appellants, F. J. Kierce, Esq., counsel for respondent being present, and having withdrawn the objections of respondent to the allowance of appeal herein, it is ordered that an appeal to the United States Circuit Court of Appeals for the

Ninth Circuit, from the final decree heretofore made, entered, and filed herein on the 19th day of March, A. D. 1896, be and the same is, hereby allowed, and that a transcript of the record be forthwith transmitted to the said United States Circuit Court of Appeals for the Ninth Circuit, said record to consist of a printed copy of the transcript of the record heretofore used on appeal from the interlocutory decree taken by Milton A. Wheaton, herewith produced by complainants and left with the clerk to be annexed to the transcript, together with a transcript of all proceedings had and taken in the case subsequent to said appeal.

It is further ordered that the amount of the security on appeal herein to be furnished by the said Edwin Norton and Oliver W. Norton be, and the same is hereby, fixed at the sum of $1,500, and that, upon the making and filing with the clerk of this court of a good and sufficient bond in said sum by the said Edwin Norton and Oliver W. Norton, all further proceedings, including execution on said final decree, be superseded and stayed until the final determination of said appeal by the said United States Circuit Court of Appeals, and until the further order of this court.

And the said F. J. Kierce, Esq., counsel for respondent, having objected to the allowance of any order, or the filing of any bond which will stay execution as to costs allowed in the mandate of the United States Circuit Court of Appeals for the Ninth Circuit heretofore filed and

entered herein, it is ordered that respondent be, and hereby is, allowed an exception to such part of the foregoing order as grants a stay of execution as to said costs.

In the Circuit Court of the United States for the Northern District of California.

EDWIN NORTON and OLIVER W. NORTON,
Complainants,
vs.
MILTON A. WHEATON,
Respondent.
} No. 11,680.

Bond on Appeal.

Know All Men by These Presents, that we, E. and O. W. Norton, as principals, and Sidney M. Smith and A. D. Cutler, as sureties, are jointly and severally held and firmly bound unto the above-named Milton A. Wheaton in the sum of fifteen hundred ($1500) dollars lawful money of the United States of America, to be paid to the said Milton A. Wheaton, his heirs, executors, administrators, and assigns, for which payment, well and truly to be made, we bind ourselves, our, and each of our

heirs, executors, and administrators, jointly and severally, firmly by these presents.

Sealed with our seals, and dated this 14th day of May, in the year of our Lord one thousand eight hundred and ninety-six.

The condition of the above obligation is such that, whereas the said Edwin and O. W. Norton have taken an appeal to the Circuit Court of Appeals of the United States for the Ninth Circuit to reverse a final decree rendered and entered by the Circuit Court of the United States for the Northern District of California in the above-entitled suit, wherein E. and O. W. Norton are complainants, and Milton A. Wheaton is respondent, which said decree was rendered in said Circuit Court on the 19 day of March, 1896, and signed and entered in said court on the 19 day of March, in the February term of 1896 of said Circuit Court.

Now, therefore, the condition of the above obligation is such that, if the said E. and O. W. Norton shall prosecute their said appeal to effect and answer all damages and costs, if they shall fail to make good their plea, then this obligation shall be void, otherwise to remain in full force and effect.

E. & O. W. NORTON,
SIDNEY M. SMITH,
A. D. CUTLER.

Signed, sealed, and delivered in the presence of:

United States of America,
Northern District of California,
City and County of San Francisco. } ss.

Sidney M. Smith and A. D. Cutler, being duly sworn, each for himself deposes and says that he is a resident and freeholder in said district, and is worth the sum of fifteen hundred ($1500) dollars exclusive of property exempt from execution and over and above all debts and liabilities.

SIDNEY M. SMITH,
A. D. CUTLER.

Subscribed and sworn to before me this 14th day of May, A. D. 1896.

[Seal] LINCOLN SONNTAG,
Notary Public in and for the city and county of San Francisco, State of California.

Form of the within bond and sufficiency of the sureties thereon approved this 16th day of May, 1896.

JOSEPH McKENNA,
Circuit Judge.

[Endorsed]: Filed May 16th, 1896. W. J. Costigan, Clerk.

In the Circuit Court of the United States, of the Ninth Judicial Circuit, Northern District of California.

EDWIN NORTON and OLIVER W. NORTON,
Complainants,
vs.
M. A. WHEATON,
Respondent.
No. 11,680.

Clerk's Certificate to Transcript.

I, W. J. Costigan, Clerk of the Circuit Court of the United States of America, of the Ninth Judicial Circuit, in and for the Northern District of California, do hereby certify the foregoing seventeen (17) pages, numbered from 1 to 17, inclusive, to be a full, true, and correct copy of the order for entering mandate and for decree, the mandate from U. S. Circuit Court of Appeals, the enrollment, the decree, memorandum of costs and disbursements, certificate to enrollment, the petition for an order allowing appeal, assignment of errors, the order allowing appeal, and the bond on appeal in the above and therein entitled cause, and that the same together constitute the transcript of all proceedings had and taken in

said cause subsequent to the appeal from the Interlocutory Decree.

I Further Certify that the cost of the foregoing transcript of record is $13.80, and that said amount was paid by Edwin Norton and Oliver W. Norton, Appellants.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Circuit Court this 22d day of June, A. D. 1896.

[Seal] W. J. COSTIGAN,

Clerk U. S. Circuit Court, Northern District of California.

UNITED STATES OF AMERICA, ss.

The President of the United States, to Milton A. Wheaton, Greeting:

Citation.

You are hereby cited and admonished to be and appear at a United States Circuit Court of Appeals, for the Ninth Circuit, to be holden at the city of San Francisco, in the State of California, on the 13th day of June next, pursuant to an order allowing an appeal entered in the clerk's office of the Circuit Court of the United States, Ninth Circuit, Northern District of California, from a final decree signed, filed, and entered on the 19th

day of March, A. D. 1896, in that certain suit No. 11680, wherein Edwin Norton et al., are complainants and appellants, and you are respondent and appellee, to show cause, if any there be, why the final decree rendered against the said appellants, as in the said order allowing appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the honorable Joseph McKenna, Judge of the United States Circuit Court, Ninth Circuit, Northern District of California, this 18th day of May, A. D. 1896.

JOSEPH McKENNA,
Judge.

Service of within citation and receipt of a copy thereof is hereby admitted this 25th day of May, 1896, all objections thereto reserved.

WHEATON, KALLOCH & KIERCE,
Attorneys for M. A. Wheaton.

[Endorsed]: Filed May 25th, 1896. J. W. Costigan, Clerk.

[Endorsed]: No. 311. United States Circuit Court of Appeals for the Ninth Circuit. Edwin Norton and Oliver W. Norton, Appellants, v. M. A. Wheaton, Ap-

pellee. Transcript of Record. Upon appeal from the Circuit Court of the United States, Ninth Judicial Circuit, Northern District of California.

Filed July 3, 1896.

F. D. MONCKTON,
Clerk.

United States Circuit Court of Appeals, in and for the Ninth Circuit.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants,
vs.
MILTON A. WHEATON,
Appellee.
No. 311.

To Edwin Norton and Oliver W. Norton, appellants, and to Jno. H. Miller, Esq., their solicitor and counsel:

You will please take notice that at the court room of said Court in the City and County of San Francisco, State of California, on Monday, the 3d day of August, 1896, at the hour of 11 o'clock in the forenoon of said day, or as soon thereafter as counsel can be heard, we will move the said Court to dismiss the appeal taken by the appellants herein.

The said motion will be made upon the ground that the said appeal ought not to be entertained by this Court, for the reason that the judgment and decree from which the appeal is taken was a judgment and decree that was made and entered by the Circuit Court by the authority and direction of the former judgment and order of this United States Circuit Court of Appeals. That the former judgment and decree of this said Court of Appeals was a

final order and decree thereof, and was a final adjudication and determination of the rights of the parties which were put in issue by the pleadings and determined by the said final judgment and decree, and that therefore the same issues cannot be, and ought not to be, argued or submitted for a second adjudication or determination.

The said motion will be made upon the files and records of this said Court of Appeals, including those shown on the former appeal of this case and the transcript of the record on file on this appeal, and upon the affidavit of Milton A. Wheaton, a copy of which is attached hereto and is herewith served upon you.

M. A. WHEATON,
I. M. KALLOCH,
F. J. KIERCE,
Solicitors for Milton A. Wheaton, Appellee.

Service of the above notice of motion to dismiss appeal, and affidavit of Milton A. Wheaton, hereto attached, and receipt of a copy of each thereof, admitted this 18th day of July, 1896.

JNO. H. MILLER, per H. T.,
Counsel for Appellants.

United States Circuit Court of Appeals, in and for the Ninth Circuit.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants,
vs.
MILTON A. WHEATON,
Appellee.
No. 311.

STATE OF CALIFORNIA,
City and County of San Francisco, } ss.

Milton A. Wheaton, being first duly sworn, on his oath, deposes and says: That he is the present appellee in the above-entitled case. That the same was formerly in this Court and was then entitled "*Milton A. Wheaton*, Appellant, vs. *Edwin Norton and Oliver W. Norton*, Appellees," and that on the 31st day of October, 1895, this Honorable Court duly made and entered its decision and judgment in the case, wherein it adjudged and decided that the making and selling of a can-heading machine which had been made under and in accordance with the description contained in the patent of this affiant did not constitute any infringement of the complainants' patent that was sued upon in this action. The said judgment and decree of this Honorable Court also reversed the judgment which had been made and entered in the case

by the Circuit Court of the Ninth Circuit, in and for the Northern District of California, which was the lower Court in which the said case was brought and tried and in which the judgments were made and entered, and remanded the cause with directions to the said Circuit Court to dismiss the bill at the complainants' cost. That thereafter the said Edwin Norton and Oliver W. Norton, who are the complainants in the action, on the fourteenth day of November, 1895, duly filed a petition for a rehearing in said cause in this Court, and on the 25th day of November, 1895, they also filed a motion praying that certain questions which they alleged were involved in the case might be certified by this Court to the Supreme Court of the United States, and asking for its opinion thereon.

That afterwards, on the 14th day of February, 1896, the said petition for a rehearing was denied and the said motion praying that the case might be certified to the United States Supreme Court was stricken from the files of this Court. Afterwards, on or about the 19th day of March, 1896, the mandate in the case was duly and regularly issued by the clerk of this Court, and on the same day the said mandate was duly filed in the office of the clerk of the said Circuit Court. The costs of said appeal had been theretofore duly and regularly taxed by the clerk of this Court at $563.90-100, and the amount of such costs was duly certified upon said mandate by the said clerk. That on said 19th day of March, 1896, F. J. Kierce, Esq., one of this affiant's counsel, duly presented to the said Circuit Court the said mandate of this Court, and thereupon, on motion of the said F. J. Kierce,

the said Circuit Court ordered that the said mandate be filed and spread upon the minutes of the Circuit Court, and that a decree be filed and entered in the said cause dismissing the complainants' bill with costs. Thereafter, and on the same day, the said Circuit Court made and entered a decree in the said cause, a copy of which is contained in the record on the present appeal in said case and a duly authenticated copy of which is now on file in the office of the clerk of this Court of Appeals.

That afterwards, on the 20th day of March, 1896, this affiant duly filed his cost bill for his costs incurred in the said case in the said Circuit Court, and which costs amounted to the sum of $139.75-100. That the clerk of said Circuit Court, upon notice regularly given to the complainants' solicitors, duly and regularly taxed the said costs incurred in said Circuit Court at the said sum of $139.75-100.

Affiant further avers that in both instances the said costs were properly and regularly taxed and at only the proper amounts, and that no exception was taken to the filing of either of said cost bills, nor was any exception taken in any way or form whatever to the amounts of either one of said cost bills or to the taxing of either of them at the amounts at which they were respectively taxed.

Affiant further says that notwithstanding that the said last decree was entered by the said Circuit Court under and in pursuance of the judgment and direction of this Court of Appeals, the said appellants on the 14th day of May, 1896, appeared by Jno. H. Miller, Esq., one of

their solicitors and counsel, and obtained an order of the said Circuit Court allowing an appeal to this Court from the said last decree of said Circuit Court. That a copy of the said order allowing said appeal is contained in the record on the present appeal in said case and a duly authenticated copy of which is now on file in the office of the clerk of this Court of Appeals.

Affiant further avers that on the 11th day of May, 1896, the said appellants filed their assignment of errors on said appeal with the clerk of the said Circuit Court, a copy of which assignment of errors is contained in the said record on appeal, the whole of which record on appeal is hereby referred to and made a part of this affidavit.

Wherefore, this affiant prays that the said appeal may be dismissed by this Honorable Court, and that the mandate upon such dismissal may be issued to the said Circuit Court without delay.

M. A. WHEATON.

Subscribed and sworn to before me, this 18th day of July, 1896.

[Seal] GEORGE T. KNOX,
Notary Public in and for the City and County
of San Francisco, State of California.

[Endorsed]: Notice of motion to dismiss appeal, and affidavit of M. A. Wheaton, filed July 20, 1896. F. D. Monckton, Clerk.

United States Circuit Court of Appeals, in and for the Ninth Circuit.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants,
vs.
MILTON A. WHEATON,
Appellee.
No. 311.

Appeal from the Circuit Court of the United States, for the Northern District of California.

This cause having been duly heard upon the motion of the appellee herein to dismiss, heretofore filed, and the said motion having been duly considered, it is now here ordered, adjudged and decreed by this Court that the appeal herein be, and the same is hereby, dismissed, with costs to the appellee.

[Endorsed]: Decree.

Filed Oct. 6, 1896.

F. D. MONCKTON, Clerk.

United States Circuit Court of Appeals, for the Ninth Circuit.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants,
vs.
MILTON A. WHEATON,
Appellee.
No. 311.

I, Frank D. Monckton, Clerk of the United States Circuit Court of Appeals, for the Ninth Circuit, do hereby certify the foregoing thirty-one (31) pages, numbered from one (1) to thirty-one (31), both inclusive, to be a full, true and correct copy of the printed transcript of record, notice and motion to dismiss cause, and the decree of this Court entered thereon.

Attest my hand and the seal of our said Circuit Court of Appeals, at San Francisco, this 12th day of October, 1896.

[Seal] F. D. MONCKTON, Clerk.

165-510

OCT 26 1896
JAMES H. McKENNEY,

165-378

639

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1896.

EDWIN NORTON and OLIVER W. NORTON,
Appellants and Petitioners,

vs.

MILTON A. WHEATON,
Appellee.

Petition for a Writ of Certiorari under Section 6 of the Circuit Court of Appeals Act requiring the Circuit Court of Appeals for the Ninth Circuit to certify to the Supreme Court for review the case of E. & O. W. Norton vs. M. A. Wheaton.

JOHN H. MILLER,
JOHN W. MUNDAY,
EDMUND ADCOCK,
Counsel for Petitioners.

GEO. SPAULDING & CO., PRS., 618 CLAY ST., SAN FRANCISCO.

United States Circuit Court of Appeals, for the Ninth Circuit.

EDWIN NORTON AND OLIVER W. NORTON, *Appellants,*
vs.
MILTON A. WHEATON, *Appellee.*
No. 311.

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Attest my hand and the seal of our said Circuit Court of Appeals, at San Francisco, this 12th day of October, 1896.

[Seal] F. D. MONCKTON, Clerk.

65-578

Office Supreme Court, U. S.
OCT 26 1896
JAMES H. McKENNEY,
CLERK

165-378 639

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1896.

EDWIN NORTON and OLIVER W. NORTON.
Appellants and Petitioners,

vs.

MILTON A. WHEATON.
Appellee.

Petition for a Writ of Certiorari under Section 6 of the Circuit Court of Appeals Act requiring the Circuit Court of Appeals for the Ninth Circuit to certify to the Supreme Court for review the case of E. & O. W. Norton vs. M. A. Wheaton.

JOHN H. MILLER,
JOHN W. MUNDAY,
EDMUND ADCOCK,
Counsel for Petitioners.

GEO. SPAULDING & CO., PRS., 414 CLAY ST., SAN FRANCISCO.

IN THE SUPREME COURT

OF THE

UNITED STATES.

OCTOBER TERM, 1896.

EDWIN NORTON AND OLIVER W. NORTON,

APPELLANTS,

vs.

MILTON A. WHEATON,

APPELLEE.

Petition for a Writ of Certiorari under section 6 of the Act entitled "An Act to establish Circuit Courts of Appeals and to define and regulate in certain cases the jurisdiction of the Courts of the United States and for other purposes," approved March 3, 1891, requiring the Circuit Court of Appeals of the United States for the Ninth Circuit to certify to the Supreme Court for its review and determination the case of Edwin Norton and Oliver W. Norton, appellants, vs. Milton A. Wheaton, appellee.

To the Honorable the Supreme Court of the United States:

The petition of Edwin Norton and Oliver W. Norton respectfully shows to this Honorable Court as follows:

1. That heretofore, to wit, August 16, A. D. 1892, your petitioners commenced a suit by filing a bill in equity in the United States Circuit Court for the Northern District of California against the appellee herein, Milton A. Wheaton, to obtain an injunction and recover damages and profits for the infringement of those certain letters patent of the United States, dated November 7, A. D. 1882, numbered 267,014, for an improvement in can-heading machines; that the said Milton

A. Wheaton duly appeared in said case in said Circuit Court, and filed his answer therein, whereby he denied the validity of the said letters patent and denied the infringement thereof; that thereafter testimony was taken in said case, and the case was duly tried, argued, and submitted for decision before his Honor Judge Joseph McKenna, Circuit Judge of the United States for the Northern District of California, and after due and full consideration thereof, to wit, on July 22, 1893, an interlocutory decree was duly made and entered in the usual form in favor of these petitioners and against the appellee, whereby it was ordered, adjudged, and decreed that said letters patent were good and valid in law; that the said Milton A. Wheaton had infringed the same; that an injunction in the usual form be granted and issued in said case enjoining and restraining the said Milton A. Wheaton from further infringing upon said letters patent, and referring the case to the standing Master in Chancery to take and state an accounting of the damages and profits; that the said decree was duly made and signed by his Honor Judge Joseph McKenna, Circuit Judge aforesaid, and thereafter the same was duly enrolled; that thereafter, to wit, on August 16, 1893, said Milton A. Wheaton duly prosecuted an appeal from said interlocutory decree to the United States Circuit Court of Appeals for the Ninth Circuit, and the same was docketed in said last named Court for hearing, and thereafter came on regularly for hearing and was heard, argued, and submitted in said Circuit Court of Appeals before their Honors Judge Hanford, Judge Ross, and Judge Morrow, and on January 28, 1895, a decree was duly made and entered by said Circuit Court of Appeals affirming the decree of the lower Court in said case in favor of these appellants and remanding the cause for further proceeding, and in and by that decree said Circuit Court of Appeals gave a broad and liberal construction to the claims of the appellants' patent, and held that the invention patented was one of a pioneer and primary character standing at the head of the art, strictly following the decision of said Court in a former case which these petitioners had brought against one Mathias Jensen for infringement of the same patent, said suit being entitled *Jensen* vs. *Norton* and reported in Vol. 49 of the Federal Reporter at page 861, *et seq.*

2. That thereafter the said Milton A. Wheaton petitioned the said Circuit Court of Appeals for a rehearing of the case, and thereupon said Circuit Court of Appeals, without any further oral argument, granted said petition of the said Milton A. Wheaton, and ordered that a rehearing of the case be had, and said case was thereupon placed upon the calendar of said

Circuit Court of Appeals for a rehearing; that such rehearing was duly had, and thereafter, to wit: on October 31, A. D. 1895, the said Circuit Court of Appeals, consisting at the time of their Honors Judge Ross, Judge Hawley, and Judge Morrow, rendered a decree whereby it was ordered, adjudged, and decreed, that the interlocutory decree appealed from by Milton A. Wheaton should be reversed and the cause remanded to the lower Court with instructions to dismiss the bill of complaint. That in and by this last decree the Circuit Court of Appeals decided that the claims of your petitioners' patent were not of a pioneer or primary character, but were of limited construction and that the machine of the appellee was not an infringement thereof, and in arriving at that conclusion the said Circuit Court of Appeals reversed its former decree in the case, and also its decree in *Jensen* vs. *Norton*, 49 Fed. Rep., 861.

3. That thereafter these appellants duly petitioned said Circuit Court of Appeals for a rehearing of the case, and also duly filed in said Circuit Court of Appeals a petition praying that the case be certified to this Honorable Court for the determination of certain stated questions of law under and by virtue of section 6 of the Act of Congress creating the Circuit Courts of Appeals; but nevertheless said Circuit Court of Appeals denied both of said petitions and refused to certify the case to this Court and refused to grant a rehearing to your petitioners.

4. That thereupon said Circuit Court of Appeals issued its mandate in the said case, the material and substantial portion of which was and is as follows:

"*On consideration whereof it is now here ordered, adjudged, and decreed by this Court that the decree of the said Circuit Court in this case be and the same is hereby reversed with costs, and the cause is remanded with directions to said Circuit Court to dismiss the bill at complainants' cost.*"

5. That thereafter said mandate was filed in the United States Circuit Court for the Northern District of California, and upon an *ex parte* application to said Court, without any hearing from or on behalf of your petitioners, and without any notice to them, and without their knowledge, but upon the mere presentation of the said mandate, the said Circuit Court to wit: on March 19, A. D. 1896, made and entered a final decree, the substantial portions of which were and are as follows:

"*This cause having been tried before this Court and an interlocutory degree entered in favor of complainant on the 22nd day of July, A. D. 1893, from which decree an appeal was duly allowed*

and prosecuted in the United States Circuit Court of Appeals for the Ninth Judicial Circuit, from which a mandate has been duly issued to this Court, reversing the said decree of this Court, and ordering that the bill of complaint herein be dismissed: Thereupon upon consideration thereof, it is ordered, adjudged, and decreed that the complainants' bill of complaint herein be and the same hereby is dismissed, and that respondent recover his costs herein taxed at $703.65."

6. That thereafter, in due time your petitioners prosecuted an appeal from said final decree to the United States Circuit Court of Appeals for the Ninth Circuit, and duly docketed the case and filed the record therein, and the same was duly assigned for argument before said Court on the calendar thereof, at the October term of 1896; that before said case could be heard and before the same was reached in its place on the calendar, the said Milton A. Wheaton filed a motion in said Court to dismiss the said appeal, a copy of which notice is as follows:

"You will please take notice that at the courtroom of said Court, in the City and County of San Francisco, State of California, on Monday, the 3d day of August, 1896, at the hour of 11 o'clock, in the forenoon of said day, or as soon thereafter as counsel can be heard, we will move the said Court to dismiss the appeal taken by the appellants herein.

"The said motion will be made upon the ground that the said appeal ought not to be entertained by this Court, for the reason that the judgment and decree from which the appeal is taken was a judgment and decree that was made and entered by the Circuit Court by the authority and direction of the former judgment and order of this United States Circuit Court of Appeals. That the former judgment and decree of this said Court of Appeals was a final order and decree thereof, and was a final adjudication and determination of the rights of the parties which were put in issue by the pleadings and determined by the said final judgment and decree, and that therefore the same issues cannot be, and ought not to be, argued or submitted for a second adjudication or determination.

"The said motion will be made upon the files and records of this said Court of Appeals, including those shown on the former appeal of this case and the transcript of the record on file on this appeal, and upon the affidavit of Milton A. Wheaton, a copy of which is attached hereto and is herewith served upon you."

7. That before said motion was heard your petitioners duly and regularly filed in said Circuit Court of Appeals a petition

praying that said Court certify to this Honorable Court the said case and certain stated questions of law which were necessary for the decision of the case; that thereafter, to wit: on October 6, A. D. 1896, the motion of said Milton A. Wheaton to dismiss and the petition of these petitioners to certify, came on regularly to be heard, and the same were heard by said Court, and thereupon said Court made an order denying the petition on behalf of these petitioners to certify, and granted the said motion of the said Milton A. Wheaton to dismiss the appeal, and did dismiss the appeal in accordance with the said motion, without any hearing on the merits, and upon the ground that petitioners were not entitled to prosecute an appeal from said final decree, and that said final decree was not appealable.

8. That immediately after making said order the said Circuit Court of Appeals granted to these petitioners a stay of proceedings in the case for thirty days, for the purpose of enabling these petitioners to apply to this Honorable Court for a writ of *certiorari* under section 6 of the Act of Congress creating the Circuit Courts of Appeals.

9. And your petitioners show as reasons why this application for a writ of *certiorari* should be granted the following: That under and by virtue of section 6 of the Circuit Court of Appeals Act, your petitioners were entitled to prosecute an appeal from the final decree rendered against them by the Circuit Court in the said case, and they did so prosecute said appeal; that having a right to so prosecute said appeal from said final decree, they had a right to a hearing upon said appeal on the merits of the case; that by granting the motion of the appellee to dismiss said appeal, and summarily dismissing it without any hearing on the merits, the Circuit Court of Appeals deprived your petitioners of rights granted to them by section 6 of the said Circuit Court of Appeals Act, and the said Circuit Court of Appeals, by summarily dismissing said appeal without a hearing on the merits virtually nullified, disregarded, and set aside that portion of section 6 of the Circuit Court of Appeals Act allowing a party to appeal from a final decree in such case. And your petitioners submit that the said Circuit Court of Appeals has no jurisdiction, right, or authority to summarily set aside an Act of Congress and refuse to administer the law thereunder, as provided by the said Act, to the detriment of litigants, and one of the questions for determination by this Court on this application is, whether or not the Circuit Court of Appeals has a right to set aside and nullify section 6 of the Circuit Court of Appeals Act, and to deprive litigants of the benefits to which they are entitled of right under said section of said Act.

And as further reasons for the issuance of a writ of *certiorari* herein, your petitioners show that there is a contrariety of opinion and diversity and conflict of decision on the questions hereinafter stated and propounded among some of the Circuit Courts of Appeals and Circuit Courts of the United States, and as to the proper construction of the patent sued on herein there is a conflict of decision between several different opinions rendered thereon by the Circuit Court of Appeals of the Ninth Circuit, both in the case at bar and other cases.

10. That the precise questions on which a ruling is desired by this Court are as follows:

I. *In a patent case, where the Circuit Court has rendered an interlocutory decree in favor of complainant, sustaining the patent and awarding an injunction, and an appeal has been taken to the Circuit Court of Appeals from said interlocutory decree awarding the injunction, and the Circuit Court of Appeals has reversed said decree, has the Circuit Court of Appeals the jurisdiction, right or authority in or by its mandate to order that the bill of complaint be dismissed?*

II. *If, under such stated circumstances, the Circuit Court of Appeals does in and by its mandate order the bill of complaint to be dismissed, and if, in pursuance thereof, the Circuit Court enters a final decree dismissing the bill, has the complainant the right to prosecute from said final decree an appeal to the Circuit Court of Appeals under and by virtue of section 6 of the Circuit Court of Appeals Act?*

III. *If, under such stated circumstances, the complainant does prosecute an appeal from said final decree to the Circuit Court of Appeals, is the complainant entitled as matter of right to have his case on appeal heard and determined upon the merits?*

IV. *Upon such appeal has the Circuit Court of Appeals jurisdiction or authority to summarily dismiss the appeal without a hearing on the merits?*

V. *On such appeal, does the ruling which was made by the Circuit Court of Appeals on the appeal from the interlocutory decree operate as the law of the case on the appeal from said final decree to such an extent as to debar the complainant from arguing the case on the merits and as to require or authorize the Circuit Court of Appeals to dismiss the appeal from the final decree summarily and without a hearing on the merits?*

VI. *In a suit for the infringement of a patent where a Circuit Court has made an interlocutory decree in the usual form, after a full hearing on pleadings and proofs, sustaining the validity of the patent, decreeing an infringement, awarding an injunction against further infringement, and referring the case to a master to*

take and state an accounting of damages and profits, does an appeal lie from said interlocutory decree or any part thereof, to the Circuit Court of Appeals under section 7 of the Circuit Court of Appeals Act?

VII. *If, under the circumstances stated in the last question, an appeal does lie from said interlocutory decree, can the said Circuit Court of Appeals review, pass upon, and finally adjudicate any other portion of said decree save and except that part which awards the injunction?*

VIII. *In such a case can the said Circuit Court of Appeals reverse the decree* IN TOTO *?*

IX. *In such a case is the review of such decree by the said Circuit Court of Appeals limited to determining whether said injunction was improvidently granted in the legal discretion of the lower Court?*

X. *In such a case, if the jurisdiction of the Circuit Court of Appeals is limited to an inquiry as to whether the injunction was improvidently granted in the legal discretion of the Court, can said Circuit Court of Appeals, in order to enable it to determine that question, adjudicate, and finally pass upon the novelty of the invention, the validity of the patent, the scope of its claims, or the fact of infringement?*

XI. *In such a case, if said Circuit Court of Appeals should reverse that portion of the decree granting the injunction, because it appeared to said Court that said patent was invalid, or that the defendant had not infringed it, what effect will such determination and adjudication have upon the further and future conduct of and proceedings in the case, after it is remanded to the lower Court; will it operate as a final adjudication upon those points, or will such points be still open for adjudication by the lower Court?"*

XII. *In view of the conflicting decisions rendered by the Circuit Court of Appeals for the Ninth Circuit at different times in the case at bar, and at other times in other cases, construing the claims of the patent sued on, No. 267,014, what is the proper and correct construction of the claims of said patent?*

XIII. *Is the Norton invention, claimed in patent No. 267,014, one of a primary and pioneer character, entitled to a broad and liberal construction?*

11. And your petitioners further show that these questions are questions of gravity and importance within the ruling of this Court in the case of *Lau Ow Bew*, 141 U. S. 587, and they are questions of great public importance, inasmuch as they affect a large number of cases in the same plight and condition, and they are of still further public importance by reason of the fact that, if the law as laid down by the Circuit Court of

Appeals for the Ninth Circuit is a correct exposition of the law, then all that portion of section 6 of the Circuit Court of Appeals Act relating to such matters will be wiped out and destroyed and be of no force or effect whatever.

12. And your petitioners further show that there is a contrariety of opinion and diversity of decision on these questions among the various Circuit Courts of Appeals throughout the United States, thereby demanding the issuance of the writ of *certiorari* herein in the interest of justice and uniformity of decision within the ruling of this Court in the case of *Columbus Watch Co.* vs. *Robbins* (148 U. S., 270).

13. Your petitioners further show that the state of the law and the decisions and the rulings of the various Circuit Courts of Appeal in relation to this matter are as follows:

In the case of *Richmond* vs. *Atwood*, 48 Fed. Rep., 910, the Circuit Court of Appeals for the First Circuit, on an appeal from an interlocutory decree in a patent case, adjudging that the patent was valid and had been infringed, and awarding the usual injunction, passed upon the validity of the patent and its infringement and all the merits of the case, and ordered that the said decree of the lower Court be reversed *in toto*. That subsequently, on a petition for rehearing in the same case, the said Court further considered the matter, and, having adjudged that it had jurisdiction to direct in what manner the case should be finally disposed of, reversed the decree *in toto*, and directed the lower Court to dismiss the bill. (*Same* vs. *Same*, 52 Fed. Rep., 10.)

In the case of *Jones* vs. *Munger*, 49 Fed. Rep., 61, substantially the same ruling was made by the Circuit Court of Appeals for the Fifth Circuit, but afterwards in the same case (50 Fed. Rep., 785) on petition for a rehearing, the decree was modified to the extent of merely dissolving the injunction and remanding the case, the Court holding that it had not jurisdiction to finally dispose of the merits of the entire case at that stage of the controversy.

In the case of *Columbus Watch Co.* vs. *Robbins* (52 Fed. Rep., 537), an entirely opposite ruling was made by the Circuit Court of Appeals for the Sixth Circuit, the opinion being delivered by his Honor Judge Jackson, in which case it was held that on appeal to the Circuit Court of Appeals from an interlocutory decree in a patent case granting an injunction, the Court had no jurisdiction to pass on or adjudicate the validity of the patent or the novelty of the invention, or its infringement by the defendant, or any other question save and except the propriety of granting the injunction.

In the very recent case of *Lockwood et al.* vs *Wickes et al.*, (75 Fed. Rep., 118), an appeal was sought to be taken by the defendant from an interlocutory decree in a patent case in favor of the complainant, awarding an injunction in the usual form, and in that case, on the principal hearing, the Circuit Court of Appeals for the Eighth Circuit, held that no appeal at all would lie from such an interlocutory decree, on the ground that it was not a final decree, but was purely interlocutory, and was not within the purview of section 7 of the Circuit Court of Appeals Act.

His Honor, Judge Thayer, Circuit Judge, said, in rendering the opinion of the Court, that section 7 of the Circuit Court of Appeals Act was intended to confer the right of appeal in those cases only where, prior to a hearing on the merits, an injunction is granted, continued, refused, or dissolved, and that an injunction granted after a trial upon the merits, by a decree that is intended to settle the rights of the parties, is not within the provisions of the statute, but is governed by the old rule that an appeal from such a decree can only be prosecuted after it becomes final.

It is true that subsequently, on a rehearing of the same case, the said Circuit Court of Appeals modified its opinion on that point in deference to the views that had been expressed by other Circuit Courts of Appeals, but the case is cited for the purpose of showing the contrariety of decision and diversity of opinion amongst the different Circuit Courts of Appeals on the question stated, and on which this writ of *certiorari* is asked.

In the case of *Blount* vs. *Societe*, etc., (53 Fed. Rep., 98) the Circuit Court of Appeals for the Sixth Circuit decided that on an appeal from an order granting an injunction *pendente lite* against the infringement of a patent, under section 7 of the Circuit Court of Appeals Act, the only question open for review is, whether the injunction was erroneously or improvidently granted in the legal discretion of the trial court, said ruling being the same as that which previously had been made in the case of *Columbus Watch Co.* vs. *Robbins*.

And your petitioners further show that the Circuit Court of Appeals for the Ninth Circuit adopted the law as stated in the case of *Blount* vs. *Societe*, etc., quoted above, in the case of *Jensen* vs. *Norton* (64 Fed. Rep., 663), in which your petitioners were the appellees, and which case involved the validity of the same patent which is involved in the case at bar; and your petitioners aver that it is unjust for the Circuit Court of Appeals to have applied one rule of law in one case of your petitioners, involving the validity of a patent, and to have applied an

entirely opposite and different rule of law in another case of your petitioners involving the validity of the same patent, thereby creating great confusion and uncertainty in the law, so that your petitioners never know from one day to another what rule of law will be enforced against them on the Pacific Coast when they bring suit for the infringement of their patent, and in that behalf your petitioners aver that they have been unjustly dealt with and have not received that uniform and equal protection of the law which is guaranteed to them by the constitution of their country, and by the laws of Congress.

And your petitioners further show to this Court that substantially the same questions are already pending in this Court in the case of *Vulcan Iron Works* vs. *Smith, Myers & Schnier*, in which case this Court granted a writ of *certiorari* to the Circuit Court of Appeals for the Ninth Circuit, because the said Court assumed in that case, on an appeal from an interlocutory decree, to order the case to be dismissed.

That in said Vulcan Iron Works case referred to, the Circuit Court had made an interlocutory decree similar to the one made in the case at bar, and the defendants had prosecuted their appeal therefrom, and upon such appeal the Circuit Court of Appeals reversed the decree and ordered the bill to be dismissed.

That thereupon the appellees in that case, Smith, Myers & Schnier, by the same counsel who is the counsel in the case at bar, petitioned said Circuit Court of Appeals to certify to this Honorable Court certain questions of law involving the construction of the Circuit Court of Appeals Act, and the extent of the jurisdiction thereunder of the Circuit Court of Appeals to review an interlocutory decree granting an injunction, the said questions being identically the same as those hereinabove stated and numbered as VII, VIII, IX, X and XI, but said Circuit Court of Appeals refused to certify said questions to this Court, and ordered that the case be remanded to the Circuit Court to be summarily dismissed; that thereupon the appellees in that case, Smith, Myers & Schnier, applied to this Court for the issuance of a writ of *certiorari* to review the action of said Circuit Court of Appeals, and this Court granted the writ, and thereupon the case was duly docketed in this Court and is on the present term calendar of this Court for hearing. That the questions in said last mentioned case, on which the ruling of this Court was desired, and on which the writ of *certiorari* was granted, were stated in the petition for the writ as follows:

"1. On appeal to the Circuit Court of Appeals of the United States from an interlocutory decree in a patent case, rendered

by a Circuit Court of the United States, which decree adjudges that the patent sued on is valid; that the patentee was the original and first inventor of the invention patented; that the complainant is the owner and holder of the patent; that the defendant had infringed; that the complainant was entitled to an accounting of damages and profits; that the case be referred to the Master in Chancery to take said accounting, and that the defendant be enjoined from further infringement, can the said Circuit Court of Appeals review, pass upon and finally adjudicate any other portion or provision of said decree save and except that part which awards the injunction?

"2. In such a case can the said Circuit Court of Appeals reverse the decree *in toto?*

"3. In such a case is the review of such decree by the said Circuit Court of Appeals limited to determining whether said injunction was improvidently granted in the legal discretion of the lower Court?

"4. In such a case, if the jurisdiction of the Circuit Court of Appeals is limited to an inquiry as to whether the injunction was improvidently granted in the legal discretion of the Court, can said Circuit Court of Appeals, in order to enable it to determine that question, adjudicate, and finally pass upon the novelty of the invention, the validity of the patent, the scope of its claims, or the fact of infringement?

"5. In such a case, if said Circuit Court of Appeals should reverse that portion of the decree granting the injunction, because it appeared to said Court that said patent was invalid, or that the defendant had not infringed it, what effect will such determination and adjudication have upon the further and future conduct of and proceedings in the case after it is remanded to the lower Court; will it operate as a final adjudication upon those points, or will such points be still open for adjudication by the lower Court?"

And your petitioners further aver that in their judgment the determination of those questions in the said case of *Vulcan Iron Works* vs. *Smith, Myers & Schnier* will determine most of the questions presented on the application in the case at bar:

Wherefore your petitioners respectfully pray that a writ of *certiorari* be issued out of and under the seal of the Court directed to the Circuit Court of Appeals for the Ninth Circuit, commanding that Court to certify and send to this Court by a day certain a full and complete transcript of the record and all the proceedings of the said Court of Appeals in the case of *Edwin Norton and Oliver W. Norton,* appellants, vs. *Milton A. Wheaton,* as identified by the transcript of the record

presented herewith, to the end that the said case may be reviewed and determined by this Court, as provided by section 6 of the Act of Congress entitled an "An Act to establish Circuit Courts of Appeals, and to define and regulate in certain cases the jurisdiction of the Courts of the United States, and for other purposes, approved March 3, 1891," and that your petitioners may have such other and further relief and remedy in the premises as to this Court may seem meet and proper and in conformity with the said Act, and that the said decree of the said Circuit Court of Appeals in said case, and every part thereof may be reversed.

And your petitioners will ever pray.

EDWIN AND OLIVER W. NORTON,
Petitioners.

JOHN H. MILLER,
San Francisco,
JOHN W. MUNDAY,
EDMUND ADCOCK,
Edw S. Evarts
Chicago,
Counsel for Petitioners.

UNITED STATES OF AMERICA, }
Northern District of California, } ss.

J. H. Miller, being first duly sworn, says: That he is one of the counsel for petitioners herein; that he has read the said petition and that the facts therein stated are true to the best of his information and belief.

JOHN H. MILLER.

Subscribed and sworn to before me this 17th day of October, A. D. 1896.

Seal

F. D. Monckton
Clerk U. S. Circuit Court of Appeals
for the Ninth Circuit

Certificate of Counsel.

We hereby certify that we have carefully examined the foregoing petition and that in our opinion the same is well founded in point of law and that the case is one in which the prayer of the petition should be granted by this Court.

JOHN H. MILLER,
JNO. W. MUNDAY,
EDMUND ADCOCK,
Edw S. Evarts
Counsel for Petitioners.

165-518

Supreme Court, U. S.
FILED.
OCT 26 1896
JAMES H. McKENNEY,
CLERK.

165-378

Supreme Court of the United States

OCTOBER TERM, 1896.

EDWIN and OLIVER W. NORTON,
Appellants and Petitioners,

vs.

639

MILTON A. WHEATON,
Appellee.

On Application for a Writ of Certiorari under Section 6 of the Circuit Court of Appeals Act to review the case of Norton vs. Wheaton in the Circuit Court of Appeals for the Ninth Circuit.

PRELIMINARY BRIEF FOR PETITIONERS.

JOHN H. MILLER,
JOHN W. MUNDAY,
EDMUND ADCOCK,
Counsel for Petitioners.

GEO. SPAULDING & CO., PRS., 414 CLAY ST., SAN FRANCISCO.

presented herewith, to the end that the said case may be reviewed and determined by this Court, as provided by section 6 of the Act of Congress entitled an "An Act to establish Circuit Courts of Appeals, and to define and regulate in certain cases the jurisdiction of the Courts of the United States, and for other purposes, approved March 3, 1891," and that your petitioners may have such other and further relief and remedy in the premises as to this Court may seem meet and proper and in conformity with the said Act, and that the said decree of the said Circuit Court of Appeals in said case, and every part thereof may be reversed.

And your petitioners will ever pray.

EDWIN AND OLIVER W. NORTON,
Petitioners.

JOHN H. MILLER,
San Francisco,
JOHN W. MUNDAY,
EDMUND ADCOCK,
Edw. S. Evarts Chicago,
Counsel for Petitioners.

UNITED STATES OF AMERICA,
Northern District of California, } ss.

J. H. Miller, being first duly sworn, says: That he is one of the counsel for petitioners herein; that he has read the said petition and that the facts therein stated are true to the best of his information and belief.

JOHN H. MILLER.

Subscribed and sworn to before me this 17th day of October, A. D. 1896.

Seal

F. D. Monckton
Clerk U. S. Circuit Court of Appeals
for the Ninth Circuit

Certificate of Counsel.

We hereby certify that we have carefully examined the foregoing petition and that in our opinion the same is well founded in point of law and that the case is one in which the prayer of the petition should be granted by this Court.

JOHN H. MILLER,
JNO. W. MUNDAY,
EDMUND ADCOCK,
Edw. S. Evarts Counsel for Petitioners.

165-518

Supreme Court, U. S.
FILED
OCT 26 1896
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CLERK.

165-518

Supreme Court of the United States

OCTOBER TERM, 1896.

EDWIN and OLIVER W. NORTON,
Appellants and Petitioners,

vs.

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Appellee.

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On Application for a Writ of Certiorari under Section 6 of the Circuit Court of Appeals Act to review the case of Norton vs. Wheaton in the Circuit Court of Appeals for the Ninth Circuit.

PRELIMINARY BRIEF FOR PETITIONERS.

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In the Supreme Court of the United States

OCTOBER TERM, 1896.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants and Petitioners,
vs.
MILTON A. WHEATON,
Appellee.

Preliminary Brief for Petitioners on Application for a Writ of Certiorari.

This is an application under the provisions of section 6 of the Circuit Court of Appeals Act, praying for the issuance of a writ of *certiorari* requiring the Circuit Court of Appeals for the Ninth Circuit to certify to this Court for review the case of *Edwin Norton and Oliver W. Norton*, appellants, vs. *Milton A. Wheaton*, appellee.

Briefly stated, the facts are as follows: The petitioners, residing at Chicago and engaged in the business of manufacturing sheet metal goods under the firm name of E. & O. W. Norton, brought suit in equity against Milton A. Wheaton in the Circuit Court of the United States for the Northern District of California, to recover in the usual form for infringement of a patent on a can heading machine.

A trial of the case in the Circuit Court resulted in an interlocutory decree in favor of petitioners sustaining the validity of the patent, adjudging an infringement, awarding an accounting, and decreeing an injunction, in the usual form, against further infringement.

The defendant in the case prosecuted an appeal from said interlocutory decree, prior to the entering of a final decree, to the Circuit Court of Appeals for the Ninth Circuit, claiming the right to so do under the provisions of section 7 of the Circuit Court of Appeals Act.

By reference to the record it will be seen that said appeal was sought to be taken from *the whole of said interlocutory decree*, and was not limited to that part granting the injunction.

The appeal was duly argued in the Circuit Court of Appeals, and a decree was rendered by that Court, on January 28, 1895, affirming the decision of the lower Court. The opinion, delivered by Judge Hanford, will be found in volume 3 of the decisions of that Court.

Thereafter Mr. Wheaton petitioned for a rehearing, which was granted, and upon such rehearing the Court of Appeals reversed its former ruling and entered a decree reversing the interlocutory decree of the lower Court, and ordered the case remanded, with instructions to the lower Court to dismiss the bill.

Thereupon these petitioners petitioned the said Court of Appeals for a rehearing, and also moved said Court to certify the case to this Court. Both petition and motion were denied, and thereupon the case was remanded to the lower Court.

When the case reached the lower Court, the bill was dismissed, in accordance with the mandate, on an *ex parte* application by the defendant and without any hearing on the merits and without any notice to the complainants.

Thereafter the complainants, these petitioners, duly prosecuted an appeal from said final decree to the Circuit Court of Appeals for the Ninth Circuit, under the provisions of section 6 of the Circuit Court of Appeals Act, allowing an appeal from the final decree in a suit for the infringement of a patent.

When this last appeal reached the appellate tribunal, Mr. Wheaton made a motion to dismiss the said appeal on the ground that no appeal would lie from the said final decree, because, upon the prior appeal taken by him from the interlocutory decree, the Court of Appeals had disposed of the case upon the merits, and on the ground that the final decree which was entered by the lower Court in accordance with the mandate was in effect a decree of the Court of Appeals and could not therefore be appealed from. In other words, his contention was, that upon the first appeal from the interlocutory decree granting the injunction, the Circuit Court of Appeals had jurisdiction to, and did, as matter of fact, pass upon and adjudicate the entire case upon the merits and dispose of the same by ordering the suit to be dismissed.

At the same time that the motion was made to dismiss the last appeal, to wit, the appeal from the final decree, these petitioners filed a petition in the Circuit Court of Appeals praying that the case be certified to this Court for the purpose of construing the Circuit Court of Appeals Act, and determining whether or not upon an appeal from an

interlocutory decree granting an injunction in a patent case, the Court of Appeals could finally dispose of the case and thereby prevent any appeal from being taken from a final decree that might thereafter be entered in the lower Court dismissing the bill.

This petition was denied and the motion of Mr. Wheaton to dismiss was granted, and a stay of proceedings was then entered by the Court of Appeals for the purpose of allowing these petitioners to apply to this Court for a writ of *centiorari* to determine the following questions concerning the construction of the Circuit Court of Appeals Act hereinabove adverted to, viz.:

I. *In a patent case, where the Circuit Court has rendered an interlocutory decree in favor of complainant, sustaining the patent and awarding an injunction, and an appeal has been taken to the Circuit Court of Appeals from said interlocutory decree awarding the injunction, and the Circuit Court of Appeals has reversed said decree, has the Circuit Court of Appeals the jurisdiction, right or authority in or by its mandate to order that the bill of complaint be dismissed?*

II. *If, under such stated circumstances, the Circuit Court of Appeals does in and by its mandate order the bill of complaint to be dismissed, and if, in pursuance thereof, the Circuit Court enters a final decree dismissing the bill, has the complainant the right to prosecute from said final decree an appeal to the Circuit Court of Appeals under and by virtue of section 6 of the Circuit Court of Appeals Act?*

III. *If, under such stated circumstances, the complainant does prosecute an appeal from said final decree to the Circuit Court of Appeals, is the complainant entitled as matter of right to have his case on appeal heard and determined upon the merits?*

IV. *Upon such appeal has the Circuit Court of Appeals jurisdiction or authority to summarily dismiss the appeal without a hearing on the merits?*

V. *On such appeal, does the ruling which was made by the Circuit Court of Appeals on the appeal from the interlocutory decree operate as the law of the case on the appeal from said final decree to such an extent as to debar the complainant from arguing the case on the merits and as to require or authorize the Circuit Court of Appeals to dismiss the appeal from the final decree summarily and without a hearing on the merits?*

VI. *In a suit for the infringement of a patent where a Circuit Court has made an interlocutory decree in the usual form, after a full hearing on pleadings and proofs, sustaining the validity of the patent, decreeing an infringement, awarding an injunction against further infringement, and referring the case to a master to take and state an accounting of damages and profits, does an appeal lie from said interlocutory decree or any part thereof, to the Circuit Court of Appeals under section 7 of the Circuit Court of Appeals Act?*

VII. *If, under the circumstances stated in the last question, an appeal does lie from said interlocutory decree, can the said Circuit Court of Appeals review, pass upon, and finally adjudicate any other portion of said decree save and except that part which awards the injunction?*

VIII. *In such a case can the said Circuit Court of Appeals reverse the decree* IN TOTO *?*

IX. *In such a case is the review of such decree by the said Circuit Court of Appeals limited to determining whether said injunction was improvidently granted in the legal discretion of the lower Court?*

X. *In such a case, if the jurisdiction of the Circuit Court of Appeals is limited to an inquiry as to whether the injunction was improvidently granted in the legal discretion of the Court, can said Circuit Court of Appeals, in order to enable it to determine that question, adjudicate, and finally pass upon the novelty of the invention, the validity of the patent, the scope of its claims, or the fact of infringement?*

XI. *In such a case, if said Circuit Court of Appeals should reverse that portion of the decree granting the injunction, because it appeared to said Court that said*

patent was invalid, or that the defendant had not infringed it, what effect will such determination and adjudication have upon the further and future conduct of and proceedings in the case, after it is remanded to the lower Court; will it operate as a final adjudication upon those points, or will such points be still open for adjudication by the lower Court?

XII. *In view of the conflicting decisions rendered by the Circuit Court of Appeals for the Ninth Circuit at different times in the case at bar, and at other times in other cases, construing the claims of the patent sued on, No. 267,014, what is the proper and correct construction of the claims of said patent?*

XIII. *Is the Norton invention, claimed in patent No. 267,014, one of a primary and pioneer character, entitled to a broad and liberal construction?*

ARGUMENT.

Upon this preliminary hearing the question to be considered is whether this is a proper case for the issuance of a writ of *ceritorari* under the provisions of section 6 of the Act of Congress, approved March 3, 1891, creating Circuit Courts of Appeals and commonly known as the Evart's Act.

Many applications have been made to this Court for the issuance of similar writs, but only a few of them have been granted.

In considering these applications, however, this Court has laid down certain rules for the guidance of petitioners for the writ. Thus, in the case of *American Construction Co.* vs. *The Jacksonville Railroad Co.* (148 U. S., 383), it was said that "the writ would issue only in cases of peculiar gravity and general importance, or in order to secure uniformity of decision."

In the case of *In re Woods* (143 U. S., 206), Mr. Chief Justice Fuller, speaking for the Court, said:

> "But in the interest of jurisprudence and uniformity of decision, to use the language of the eminent jurist and statesman who had charge of the bill, provision was made under section 6 for such supervision on our part as would tend to avert diversity of judgments and guard against inadvertence of conclusion in controversies involving weighty and serious matters."

Similar views were expressed in *Lau Ow Bew's* case (141 U. S., 583). It would seem, therefore, from the decisions of this Court, there are two general classes of cases in which it is proper for this writ to issue, viz.: (1) *Cases of peculiar gravity and general importance.* (2) *Cases where its issuance is proper in the interest of uniformity of decision.* We subnit that the case at bar presents both of these conditions.

I.

The Writ Should Issue because the Questions on which a Decision is Asked are of "Peculiar Gravity and Great Importance."

By its decision herein the Circuit Court of Appeals for the Ninth Circuit has annulled and abrogated that provision of section 6 of the Circuit Court of Appeals Act, allowing an appeal from a final decree in cases similar to the one at bar.

By that section a defeated litigant is entitled as of right to appeal to the Circuit Court of Appeals from a "final decision" rendered against him in a Circuit Court in "all cases arising under the patent laws." Being so entitled, he is necessarily entitled to a hearing of the merits of his

case on such appeal. But the Circuit Court of Appeals for the Ninth Circuit said, in the case at bar, that in all those cases where, prior to a final decree, an appeal had been taken from "an interlocutory order or decree granting, continuing, refusing, dissolving or refusing to dissolve an injunction," under the provisions of section 7 of the act, and where, upon such appeal, the appellate Court had passed upon the merits of the case and ordered a final decree to be entered by the lower Court, in such case no appeal would lie from such final decree. This ruling, we submit, effectually abrogated and nullified that provision of section 6 of the act which authorizes appeals from final decrees.

The process of reasoning by which the lower Court worked out this result seems to have been that the final decree entered by the Circuit Court was virtually a decree of the Circuit Court of Appeals, because it was entered in accordance with the terms of its mandate, and that, therefore, it was not appealable. This reasoning was based on the general rule that where, on an appeal, the appellate tribunal has jurisdiction to pass on the entire case and does so pass upon it and directs the lower Court to enter a final decree in certain specified terms, and the lower Court does enter such final decree, in such case the said final decree is not appealable. This argument assumes that on the first appeal in this case, to wit: the appeal from the interlocutory decree, the Court of Appeals had full jurisdiction to pass on the entire case and make final disposition thereof by directing the lower Court to enter a final decree in certain stated terms. But we submit that this assumption is erroneous. The rule may possibly be as

stated above, where the first appeal is taken from a final decree and upon such appeal the appellate court has jurisdiction to pass on the merits of the entire case and finally dispose of it. But we deny that the rule exists where the first appeal is taken from some interlocutory order prior to a final decree. Upon such an interlocutory appeal the Court of Appeals is not vested with jurisdiction to pass on and finally adjudicate the entire case on the merits so that the decision becomes the law of the case and estops all future inquiry.

By section six of the Evart's Act it is provided:

> "That the Circuit Courts of Appeals established by this Act shall exercise appellate jurisdiction to review by appeal or by a writ of error *final decision* in the District Court and the existing Circuit Courts in all cases other than those provided for in the preceding section of this Act, unless otherwise provided by law, and the judgments or decrees of the Circuit Courts of Appeals shall be final in all cases * * * arising under the patent laws."

By this section there is conferred on the Circuit Courts of Appeals jurisdiction to review by appeal final decrees in patent cases which had formerly been reviewable only by the Supreme Court. In other words, such appeals are transferred from the Supreme Court to the Circuit Court of Appeals.

By section seven of the Act, as originally passed by Congress, March 3, 1891, it was provided as follows:

> "That where upon a hearing in equity in a District Court or in an existing Circuit Court, an injunction shall be granted or continued by an interlocutory order or decree in a cause in which an appeal from a final decree may be taken, under the provisions of this act, to the Circuit Court of Appeals, an appeal may be

taken from such interlocutory order or decree granting or continuing such injunction to the Circuit Court of Appeals; *provided*, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate Court and the proceedings in other respects in the Court below shall not be stayed, unless otherwise ordered by that court during the pendency of such case."

This section was afterwards amended by the Act of Congress of February 18, 1895 (28 Stats., 666), to read as follows:

"That where upon a hearing in equity in a District Court or in an existing Circuit Court an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused IN A CASE IN WHICH AN APPEAL FROM A FINAL DECREE MAY BE TAKEN UNDER THE PROVISIONS OF THIS ACT TO THE CIRCUIT COURT OF APPEALS, an appeal may be taken from such order or decree granting, denying, refusing, dissolving or refusing to dissolve an injunction, to the Circuit Court of Appeals; provided, that the appeal must be taken within thirty days of the entry of such order or decree, and it shall take precedence in the appellate Court and the proceedings in other respects of the Court below shall not be stayed until otherwise ordered by that Court during the pendency of said appeal; and provided further, that the Court below may, in its discretion, require as a condition of the appeal an additional injunction bond."

It must be remembered that prior to the passing of the act in question no appeal would lie from any interlocutory order or decree granting or refusing an injunction, but an appeal in such cases could be taken only from the final decree.

This section provides a new remedy, to wit: an appeal from an interlocutory order or decree granting an injunc-

tion, etc., prior to the entry of a final decree, and the question for consideration is, what is the extent of this new remedy?

The Circuit Court of Appeals in the case at bar adjudged that this new remedy was sufficiently plenary to authorize the appellate tribunal on such an interlocutory appeal to finally dispose of the entire case upon its merits, and thereby prevent any future appeal from the final decree ordered by the appellate Court to be entered.

We submit that this ruling is erroneous, and that the section merely provides a temporary remedy for the correction of certain hardships which might arise prior to a final decree, thereby enabling an appellate Court to correct those hardships instantly, and that that is the sole extent of the section, and it is to be applied only in those cases "in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals."

In our construction of this section of the act we submit the two following propositions:

(1) *By said section no right of appeal is given from an interlocutory decree after a trial upon the merits which is intended to settle and does settle the rights of the parties; but it merely authorizes appeals from orders relating to preliminary and provisional injunctions that may be granted or refused in a case prior to the entry of the interlocutory decree.*

(2) *Upon appeals under section 7 of the act the appellate Court cannot finally dispose of the entire case on the merits, but its review is limited to determining whether the lower Court abused its discretion in granting or refusing the injunction.*

These are questions of peculiar gravity and importance, justifying, in our judgment, the issuance of a writ of *certiorari*. While we do not deem it necessary to argue them on the merits, at this stage of the proceedings, we will say a few words to indicate, in a general way, the view we take of these questions.

Our contention is based on the wording of section 7, and a comparison of the same with the provisions of section 6, as well as upon general and well known principles governing appellate practice.

By section 6 of the act it is clear that a right of appeal is given from a final decree in a patent case. If, therefore, on an appeal under section 7 from an interlocutory decree, the entire case can be disposed of, then the provision quoted from section 6, allowing appeals from a final decree, would be a vain and idle thing. Inasmuch as the two sections must be construed together for the purpose of giving full force and effect to each of them it would seem that our construction is correct. But further: the wording of section 7 sustains us, because it provides for these interlocutory appeals only.

> "In a case in which an appeal from a final decree may be taken under the provision of this act to the Circuit Court of Appeals."

This language would appear to contemplate a distinction between appeals taken from final decrees under section 6, and appeals taken from interlocutory matters under section 7, and does not authorize the interlocutory or lesser appeal to destroy and nullify the final or greater appeal.

The further provisions of the section, that the appeal must be taken within thirty days, and that it shall take

precedence in the appellate Court, and that the proceedings in other respects in the Court below shall not be stayed unless otherwise ordered, all indicate to our mind that the appeals contemplated by the section are appeals from orders granting preliminary or provisional injunctions and not appeals from an interlocutory decree granting an injunction after a full trial of the case upon the merits.

This precise question arose in the Court of Appeals for the Eighth Circuit in the case of *Lockwood et al.* vs. *Wickes et al.* (75 Fed. Rep., 118). The appeal in that case was taken from an interlocutory decree, made in the usual form, after a full trial of the case on the merits and before an accounting was had or a final decree made. In rendering its decision the Court said:

> "The first question to be considered is whether the appeal was properly taken and whether this Court has jurisdiction to entertain the same. It admits of no doubt that the decree from which the appeal was taken was not a final decree from which an appeal will lie, and that the appeal cannot be sustained on that ground. It did not dispose of all the issues in the case, so that nothing remained to be done except to execute the decree. The profits realized by the infringement had neither been reported nor ascertained, and until an accounting of the profits and damages had been taken, stated, and approved, the trial Court retained jurisdiction of the case and was at liberty to revise or modify its decree. *Perkins* vs. *Fourniquet*, 6 How., 206. It has always been held that such decrees are not final in such sense that an appeal may be taken therefrom. *Barnhard* vs. *Gibson*, 7 How., 650; *Humiston* vs. *Stainthorp*, 2 Wall., 106; *Crawford* vs. *Points*, 13 How., 11; *Keystone Iron Co.* vs. *Martin*, 132 U. S., 93, and cases there cited."

The Court in its decision then proceeds to say that the right of appeal was predicated on section 7 of the Circuit Court of Appeals Act, and, after quoting the said section in full, proceeds to construe it as follows:

> "It has been generally supposed, or at least there are no decisions to the contrary, that the foregoing section of the act of March 3, 1891, was inserted in the act for the purpose of securing a right of appeal in those cases where, before the hearing of the case on the merits, an application for a preliminary injunction is either granted or refused, and in those cases where a preliminary injunction is dissolved in advance of a trial upon the merits by some interlocutory order. It may be conceded that the statute is broad enough in its terms to confer a right of appeal in every case where an injunction is granted, refused, or dissolved by an order or decree that is in its nature interlocutory, but it can hardly be presumed that it was the intention of Congress to permit two appeals from a decree rendered after the trial of a case on its merits merely because a portion of the relief consists in granting, continuing, refusing or dissolving an injunction.
>
> "If the statute is construed in its broadest sense and is held to confer a right of appeal whenever an injunction is granted, continued, or refused, then it may frequently happen that an appellate Court may be called upon to hear and decide three or more appeals in the same case which involves substantially the same question or questions. For example, an appeal may be taken when the trial Court grants a temporary injunction, an appeal may be taken when the temporary injunction thus granted is continued or made perpetual by an interlocutory decree rendered after the trial upon the merits, and a further appeal may be prosecuted on the coming in of the master's report when the interlocutory decree is made final. We can hardly suppose that it was the purpose of Congress to thus enlarge the right of appeal and increase litigation and make it more burdensome and expensive. It seems more reasonable to believe that

> section 7 of the act of March 3, 1891, was intended *to confer the right of appeal in those cases only where, prior to a hearing on the merits, an injunction is granted, continued, refused, or dissolved, and* THAT AN INJUNCTION GRANTED AFTER A TRIAL UPON THE MERITS, BY A DECREE THAT IS INTENDED TO SETTLE THE RIGHTS OF THE PARTIES, IS NOT WITHIN THE PROVISION OF THE STATUTE, BUT IS GOVERNED BY THE OLD RULING THAT AN APPEAL FROM SUCH A DECREE CAN ONLY BE PROSECUTED AFTER IT BECOMES FINAL."

It is true that afterwards, on a rehearing of the case, the Court of Appeals modified its views on this question in deference to the views thereon of a contrary nature that had been announced by the Court of Appeals for the First and Fifth Circuits in the cases of *Richmond* vs. *Atwood*, 52 Fed. Rep., 10, and *Jones* vs. *Munger*, 50 Fed. Rep., 685; but said modification was made, according to the opinion, in order "that a uniform interpretation should be placed on the act in question;" and it is evident that the Court of Appeals for the Eighth Circuit was not convinced that its original view was wrong. But, however, that may be, we submit that the reasoning of the Court of Appeals for the Eighth Circuit was correct and sound, and that the question is of sufficient gravity and importance and is sufficiently enveloped in doubt, by reason of a contrariety of opinion amongst the courts, to justify the issuance of the writ in this case in order that there may be an authoritative and final determination of the question by this Court for the guidance of the various Circuit Courts of Appeals throughout the United States.

The second proposition stated by us *supra*, viz.: that on appeal from an interlocutory decree granting an injunction under section 7 of the act, the appellate Court cannot

finally dispose of the entire case on the merits, but that its review is limited to the inquiry whether the lower Court abused its discretion in granting the injunction, is likewise a question "of peculiar gravity and general importance." It affects not only these litigants, but all others placed in a similar plight.

The question here involved materially affects a vast number of people who own a vast number of patents. It is of importance to every owner of a patent in the United States to know what is the correct exposition of the law on this point. When we reflect on the magnificent growth which our patent system has reached, and its importance to the material welfare of the whole country, it must be apparent that the question is one of "peculiar gravity and great importance."

The question is likewise of vital importance to practitioners of the patent law throughout the entire United States, and should be decided in the interest of the legal profession and of correct practice.

Patent law has become one of the largest and most important branches of the law. It perhaps constitutes the bulk of the business in the Federal Courts, certainly in some of them. Hence the necessity of knowing the correct practice on so vital a point as this. Certainly it is a question which all practitioners of the patent law throughout the entire United States desire to have speedily decided, to the end that a uniform practice may be established.

II.

The Writ should issue in the interest of uniformity of decision, because there is a diversity of opinion and conflict of decision on the question presented by this application.

That question relates to the extent of the jurisdiction of the Circuit Court of Appeals on appeal from an interlocutory decree in a patent case in favor of the complainant, drawn in the usual form, and is the same question which was involved in *Columbus Watch Co.* vs. *Robbins*, 148 U. S., 269, but which was not there decided, on account of informality in the certificate by which that case was brought up, and it is the same question involved in the case of *Vulcan Iron Works* vs. *Smith, Myers & Schnier*, pending in the Court on the present calendar. The question has never been passed on by this Court, so far as we are aware.

It may be stated as follows: On appeal from an interlocutory decree in a patent case, made after full hearing on the proofs, and drawn in the usual form in favor of complainant, adjudging the validity of the patent and the scope of its claims, finding infringement, awarding the usual accounting, and granting an injunction against future infringement, are the findings of the lower Court upon the facts and law decided by it conclusive upon the Court of Appeals, so as to leave open for review only the question whether the injunction was properly granted in the legal discretion of the trial Court; or, on the other hand, are all questions of fact and law open for review *de novo* by the appellate Court, and can said Court so review them and finally dispose of the entire case?

It is not our purpose to discuss the merits of these questions at this stage of the controversy. We reserve that for a future occasion, in case the writ is granted. At present we are merely urging the advisability of issuing the writ in order that those questions may hereafter be argued by counsel and disposed of by the Court. And with that end in view we state as our first point that there is a diversity of decision on these questions among different Circuit Courts of Appeals.

In *Richmond* vs. *Atwood*, 48 Fed. Rep., 910, the Circuit Court of Appeals for the First Circuit (Colt, Carpenter and Aldrich presiding), on appeal from an interlocutory decree in a patent case, examined the whole case on its merits, passed upon the patent, the scope of its claims and its infringement, and reversed the whole decree. Subsequently on petition for rehearing the Court further considered the question, and having adjudged that it had jurisdiction to direct in what manner the case should be finally disposed of, reversed the decree *in toto* and ordered the lower Court to dismiss the bill. (*Richmond* vs. *Atwood*, 52 Fed. Rep., 10.)

In *Jones* vs. *Munger* (49 Fed. Rep., 61) substantially the same ruling was made by the Court of Appeals for the Fifth Circuit (Pardee, Locke and Bruce presiding); but afterwards, in the same case, on petition for rehearing (50 Fed. Rep., 785), the decree was modified to the extent of merely dissolving the injunction.

In the case at bar the Court of Appeals for the Ninth Circuit followed the authority of *Richmond* vs. *Atwood* and *Jones* vs. *Munger*. The same ruling has also been made

by the same Court in several other cases, and hence it may be taken as a rule of decision in the Ninth Circuit.

In *Columbus Watch Co.* vs. *Robbins*, 52 Fed. Rep., 537, a diametrically opposite ruling was made by the Court of Appeals for the Sixth Circuit, where it was held that on appeal from an interlocutory decree in a patent case, the Court of Appeals had no jurisdiction to pass on or adjudicate the validity of the patent, or the novelty of the invention, or its infringement by defendant, or any other question save and except the propriety of granting the injunction in the legal discretion of the Court.

In the trial Court the defendant had prayed for the allowance of an appeal from the *whole* decree, in order that the appellate Court might adjudicate all the questions involved in the decree and dispose of the entire case. But the trial Court refused to allow an appeal from the *whole* decree, and allowed it from *that portion only granting the injunction*. Accordingly the appeal was so taken. In the appellate Court counsel for both parties joined in a request to the Court to hear and determine *all questions* raised by the decree and to finally dispose of the entire case. This request was denied by the Court for want of jurisdiction, and His Honor Mr. Justice Jackson, then Circuit Judge, speaking for the Court, said:

> "It admits of no question that the *entire decree of the Circuit Court was not appealable either under the sixth section of the Act of March 3, 1891, or under previous provisions of law*. *Barnhard* vs. *Gibson*, 7 How., 650; *Humiston* vs. *Stainthorp*, 2 Wall., 106; *Iron Co.* vs. *Martin*, 132 U. S., 91. It was not final, but interlocutory in its character, and subject to the further and future control of the Court below, and that Court properly denied an appeal from the *entire decree*, and

allowed it only from *so much thereof as related to the injunction*, as authorized by section 7 of the Act of March 3, 1891. This limited appeal from a part of the interlocutory decree clearly did not remove the whole case or the entire decree from the Circuit Court to this Court. It only brought up for review the question whether the action or order of the Circuit Court granting the injunction was proper or improper. This Court, by virtue of that appeal, has before it for determination, only the question whether that injunction should be sustained or dissolved. The cause is still pending in the Circuit Court upon all other questions and matters involved in the litigation. It is well settled that, in respect to all matters and questions not withdrawn by said appeal, and still under its jurisdiction and control, the Circuit Court may hereafter, either before or upon the coming in of the master's report upon the matters of account, change its opinion on the very questions this Court is requested to decide finally. In *Fourniquet* vs. *Perkins*, 16 How., 84, the rule is laid down that the whole case is open for revision, and that the Court may change all interlocutory decrees or orders relating to the merits when the cause comes to final hearing. The same general principle is announced in *Bebee* vs. *Russell*, 19 How., 283–87; *Craighead* vs. *Wilson*, 18 How., 199; *Farrelly* vs. *Woodfolk*, 19 How., 288, and *Green* vs. *Fisk*, 103 U. S., 518. * * * 'The Act of 1891, § 7, permits an appeal from an interlocutory order *granting or continuing an injunction*. The present appeal is allowed and taken from *such an order*, and its legal effect and operation is to remove from the trial Court to this Court *only that part of the decree which relates to the injunction*. That part of the interlocutory decree is before this Court for review. The lower Court has no further control or jurisdiction over that subject until it receives the mandate of this Court affirming or reversing its order granting the injunction. *But all other parts or portions of the interlocutory decree, such as those relating to the validity of the reissue patent, and its infringement, and the questions that may arise upon the account ordered to ascertain damages and*

profits, have not yet left the jurisdiction of the lower Court. That Court may hereafter change its interlocutory decree on the very questions this Court is requested to decide finally. For aught that appears or is known to this Court, the lower Court may have already done so. But suppose this Court should decide the merits of the case, its decision of matters or questions not before it for review, under the present appeal, *would have no binding force on the lower Court, and might be wholly disregarded when that Court comes to a final hearing of the cause.* Nor would the premature decision of this Court upon questions not properly before it prevent either side from taking an appeal from the final decree of the Circuit Court when such a decree shall be hereafter rendered.

"Such a course of practice and procedure as this Court is requested to pursue, in respect to matters not properly before it, involving the exercise of original jurisdiction, would be attended with great confusion and perplexity, and would greatly embarass the orderly administration of justice. It is contrary to all precedent, and entirely out of harmony with the federal judicial system of the United States. Under that system, original jurisdiction can only be exercised by the Courts on which it is conferred by the constitution or laws. The blending of original and appellate jurisdiction is not sanctioned by either the constitution or laws of the United States. Sound principle, as well as wise public policy, require that original and appellate jurisdiction should be kept distinct and independent. To blend them or allow one Court to exercise both, would be attended inevitably with evil and serious results. *It would doubtless have been well if, in the creation of this Court, the seventh section of the act had permitted or authorized an appeal from interlocutory decrees sustaining the validity of patents and adjudging their infringement,* so as to obviate in many cases the taking of expensive accounts and the delays incident thereto. *This has not, however, been done,* as we construe the act of March 3, 1891, *and it is not in the power of this Court to afford relief, such as the present application seeks to secure.*

> "In our view of the subject, *this Court cannot properly comply with or accede to the application of the parties, for the reasons already stated, that the appeal as allowed and taken does not bring up for review, anything more than that portion of the interlocutory decree which granted the injunction, and that to consider and finally decide other matters not covered by or included in the appeal, would involve the exercise of original jurisdiction, when this Court, under the law of its creation, is restricted and confined to the exercise of appellate jurisdiction.*"

It requires but slight discernment to see that the ruling in this case is at war with that of the Court of Appeals of the First Circuit in *Richmond* vs. *Atwood*, and that of the Fifth Circuit in *Jones* vs. *Munger*, and that of the Ninth Circuit in the case at bar. Which of the two rulings is correct? Both cannot be right. There is no middle ground. One must necessarily be wrong. It is for this Court to determine between these rival rulings which one is correct, and the determination of that question can be had only by the issuance of a writ of *certiorari* under section 6 of the act of March 3, 1891. This would seem to be a case specially contemplated by that section, as construed by this Court in its recent decisions, especially in *Columbus Watch Co.* vs. *Robbins* (148 U. S., 270), where it was said:

> "While the fact that the Circuit Court of Appeals for one Circuit has rendered a different judgment from that of the Circuit Court of Appeals for another, under the same conditions, might furnish ground for a *certiorari* on proper application," etc., etc., etc.

There is one other matter, which may or may not influence the Court in granting this writ, to which we venture to call attention, and that is the history of this Norton litigation and the conflict between the decisions rendered

therein at different times on the Pacific coast. The Norton Brothers are large manufacturers of sheet metal goods, having extensive factories at Chicago, New York, Baltimore, San Francisco, Astoria, and in the Dominion of Canada. They have expended many millions of dollars in building up this industry. The most valuable patent they have in connection with these factories is the can heading patent involved in this litigation.

The first suit they brought for infringement of this patent on the Pacific coast was against Mathias Jensen at Portland, Oregon. The trial of that case upon the merits before Judge Sawyer, resulted in an interlocutory decree in favor of the Nortons, in the usual form. An appeal was taken from that interlocutory decree by Jensen to the Circuit Court of Appeals for the Ninth Circuit, and that appeal was fully argued on the merits and resulted in an affirmance of the decree appealed from. The Circuit Court of Appeals in that case consisted of Judges Hanford, Hawley and Morrow. The opinion of the Court was delivered by Judge Hawley, and is reported in the 49th volume of the Federal Reporter, at page 860. In and by that opinion a very lengthy review of the merits of the case was made, and amongst other things it was there said:

> "Norton's invention must therefore be considered as being of a primary character, standing at the head of the art as the first machine ever invented for applying exterior tight-fitting can heads to cans, and appellees are entitled to a broad and liberal construction of the claims of their patent."

That decision was rendered March 10th, 1892. Thereafter Mr. Jensen devised a new machine, which he supposed avoided the Norton patent, and proceeded to man-

ufacture the same. A new suit was then brought by the Nortons against Jensen for against infringing this Norton patent, and a motion for a preliminary injunction was made, which was resisted strenuously by Jensen. The Circuit Court, however, sitting at Portland, Oregon, following the construction of the Norton patent given by the Court of Appeals, held that Jensen's new machine was a palpable infringement, and granted a preliminary injunction against him. He then appealed from the order granting the injunction to the Circuit Court of Appeals for the Ninth Circuit, and upon a hearing of that appeal the order was affirmed, the Court following the construction already given to the Norton patent in the first Jensen case.

At this time the Court of Appeals consisted of Judges Ross, Hanford and Morrow, and the opinion of the Court was delivered by Judge Hanford on November 1st, 1894, and is reported in 64 Federal Reporter at page 662, and also in 12 C. C. A., 608.

Thus we see that Mr. Jensen was twice enjoined from infringing this Norton patent, and he is still under such injunctions to the present day, by virtue of the adjudications of the Court of Appeals for the Ninth Circuit that the Norton patent is one of a primary character standing at the head of the art, entitled to a broad construction, and that the two Jensen machines infringed the same.

The next suit to be brought was that of *Norton* vs. *Wheaton*, the suit at bar, in which Norton brought suit in the Circuit Court for the Northern District of California against Milton A. Wheaton for infringement of this Norton patent.

The case was tried in the lower Court upon full proofs before his Honor Judge Joseph McKenna, Circuit Judge, and resulted in a decree in favor of the Nortons against Wheaton, sustaining the validity of the patent and giving it a broad and liberal construction. In and by the decision in that case Judge McKenna said:

> "The defendant's machine differs in some particulars from the Jensen machine, and is probably an improvement, and being so, properly patented; but I do not think the difference is great enough to avoid the comprehensive construction given by the Court of Appeals."

That decision was rendered July 10th, 1893, and is reported in 57 Federal Reporter, 927.

Thereupon Mr. Wheaton, the defendant, prosecuted an appeal from the interlocutory decree against him to the Circuit Court of Appeals for the Ninth Circuit, and after a full hearing on the merits, the Court of Appeals, consisting of Judges Ross, Hanford and Morrow, in an opinion given January 28th, 1895, by Judge Hanford, affirmed the decree of the lower Court, adopting and following the broad construction that had theretofore been given to the patent in the original case of *Jensen* vs. *Norton*.

This decision of the Court of Appeals, to which we are now referring, does not appear to have been published in the Federal Reporter, but it has been published in the bound volumes of the Decisions of the Circuit Court of Appeals for the Ninth Circuit (Vol. 3, p. 281.) In and by that opinion, which was rendered by Judge Hanford, it is said:

" Although in the preceding statement of this case, " which is taken from the appellant's brief, it appears " that many issues were raised by the pleadings, the " controversy in this Court has been narrowed to two " principal questions. These questions, as propounded " in the same brief, detached from the strong asser- " tions placed as riders thereon, are as follows: First: " What is the scope of the patent sued on, under a " proper construction to be given to it in view of the " evidence in this case, including the contents of the " file-wrapper, which has not been previously con- " sidered by this Court? Second: Does the machine " devised by the defendant infringe all or either of " the claims of said patent?

" The evidence and arguments disclose no ground " for discrediting Mr. Norton's claim as an original " inventor, nor for the allegation of the answer to the " effect that his invention was anticipated by the " patents previously granted to others and that it is " impracticable and void for lack of utility.

" These grounds have been wisely, as we think, " abandoned by submitting the case on the grounds " stated above.

" The Court has heretofore in the case of *Jensen* vs. " *Norton* (7. U. S., App. 103, 1 C. C. A., 452, 49 Fed. " Rep., 859) had occasion to pass upon the validity " of this patent, and construe it. We then gave it " a broad construction, as we held that it covered the " first invention of a machine for automatically " putting tight-fitting exterior heads on tin cans. In " view of the evidence now before us, we regard Nor- " ton's invention as but one step in the evolution of " can-making machinery.

" The Clark patent, No. 238,351, for a can-heading " machine, issued more than a year previous to the " filing of Norton's application in the Patent Office, " was not an anticipation of the combinations of de- " vices claimed by Norton as constituting his inven- " tion, but it was ahead of him as to the particular " device having two diameters adapted to hold the can- " head in the larger space, centered and lined to re- " ceive the can-body, and to compress and shape the

" can-body within the lesser space and guide it to
" center the can-head, and by an enlargement at the
" proper time to release the headed can. This Clark
" machine and the mold of Norton's machine may be
" regarded as equivalents for each other. The former,
" however, was but a tool intended to aid a workman
" in making cans by hand, while the latter is useful
" only as one part of a machine. While Norton was
" not the inventor of the means for connecting his
" device with motive power to make it operate, nor of
" the framework upon which it was to be mounted,
" still he invented a machine, and his claims cover
" combinations of parts, which, when combined so as
" to co-operate together, constitute a machine. He
" did not have to include in his claims combinations
" with means for connecting his devices with motive
" power, nor supporting-frames which could be sup-
" plied from any machine shop. WE REAFFIRM THE
" DECISION OF THIS COURT IN THE JENSEN CASE,
" THAT NORTON'S WAS THE FIRST MACHINE EVER
" CONSTRUCTED FOR AUTOMATICALLY PUTTING EX-
" TERIOR TIGHT-FITTING HEADS ON TIN CANS. THE
" PATENT SHOULD HAVE A LIBERAL CONSTRUCTION, but
" its several claims are for combinations, and, in de-
" termining the question as to infringement, full force
" must be given to the rules applicable to all patents
" on combinations. * * * Every part of the
" mechanism referred to in these claims, or equiva-
" lents therefor, are in the Wheaton machine, and
" they cooperate as in the Norton machine to produce
" the same results by substantially the same mode of
" operation. The encircling can-body compressor
" adapted to round and size the ends of the can-
" bodies so that they will enter the flanged can heads
" and to hold them so centered and lined during the
" endwise movement of the heads and bodies towards
" each other, as to enter with unfailing accuracy; the
" can head holder, having the larger diameter to con-
" form to the exterior diameter of the can heads and
" adapted to hold the latter in position to receive the
" ends of the can-bodies when the two parts are
" pressed together, are in the Wheaton machine called

"a set of jaws, but they correspond to the mold of "the Norton invention. They open and close to re- "ceive and discharge the cans and have every feature "of the Norton mold. In both machines the heads "are put on by pressing the heads and bodies together "endwise, and in Wheaton's machine the mechanism "for supplying the requisite force is equivalent to the "piston of the Norton machine. The argument that "Norton only claimed a device for forcing the can- "head into the annular space at the end of the mold "is a mere play on words. The real function of the "piston in his machine as explained in his specifica- "tion is to force the can head and body together. In "the operation of the Wheaton machine the can-body "and heads are delivered to the jaws by chutes simi- "lar to the chute specified in the claims of the Norton "patent. The Wheaton machine embraces a series "of jaws adapted to work rapidly by rotation, and "this is one feature of Norton's claims. Wheaton's "machine has new and additional features, but these "we do not have to consider, for they do not entitle "the defendant to appropriate Norton's invention. "THE FORMAL DIFFERENCES ARE NOT GREATER THAN "ANY INTELLIGENT MACHINIST DESIGNING TO INFRINGE "THE PATENT COULD CONTRIVE AFTER BECOMING AC- "QUAINTED WITH THE PRINCIPLE OF THE INVENTION. "The decree of the Circuit Court is affirmed with "costs."

Thereafter Mr. Wheaton petitioned the Court of Appeals for a rehearing, and a rehearing was granted him, upon which rehearing the case was again argued, the Court consisting at that time of Judges Ross, Hawley and Morrow; Judge Hanford was not present. The decision was rendered October 31st, 1895, and is reported in 70 Federal Reporter, p. 833 and 17 C. C. A., 447. The opinion was rendered by Judge Ross.

In and by this last decision the Court of Appeals, with its personnel changed as above indicated, reversed its former decision, which we have heretofore quoted at length, *and took a directly contrary and opposite view of the subject-matter, and reversed the decree against Wheaton and ordered the bill to be dismissed.* In and by this last decision the Court of Appeals discarded the broad and liberal construction of the Norton patent, which had theretofore been given to to it by Judge Sawyer in the first Jensen case at Portland, by the Court of Appeals in the first Jensen case, by the Circuit Court through Judge Hawley at Portland in the second Jensen case, by the Court of Appeals on appeal in the second Jensen case, by the Circuit Court through Judge McKenna at San Francisco, and by the Court of Appeals in its first decision on appeal in the Wheaton case; and instead of this broad and liberal construction, adopted the narrow and limited construction of the Norton claims set forth in the decision of Judge Ross.

It would be an interesting commentary upon the mutability of judicial opinion to place in one column the epigrammatic sentences of this Court of Appeals rendered on the first appeal in this Wheaton case, which placed the Norton invention *at the head of the art and gave his claims a broad and liberal construction,* and then to place in a parallel column sentences from the last decision of this same Court of Appeals in this same Wheaton case holding that Norton's invention *is not of a primary character nor at the head of the art, but that it is a mere improvement in minor details, and that its claims are not entitled to a broad or liberal construction but must receive a narrow and*

restricted one. It would subserve, however, no purpose of utility for us to do this, and we merely call your Honor's attention to the fact that there is this irreconcilable conflict and that it alone is sufficient, in our judgment, to justify us in asking for this writ in order that this Court, the one of last resort and the highest judicial tribunal in the land, may finally determine this disputed matter and inform the Circuit Court of Appeals for the Ninth District whether they were right in their first decision or in their second decision.

And again we call your Honors' attention to the following curious anomaly of facts; Mathias Jensen is under a perpetual injunction against infringement of this Norton patent, and as against him the Norton invention is one of a primary character standing at the head of the art, and the claims of his patent must receive a broad and liberal construction. There are two decisions against Mr. Jensen to that effect, and they are final and perpetual. Mr. Wheaton on the other hand goes free. No such rule of construction of the Norton patent holds as to him, and notwithstanding the fact that his machine does not essentially differ from Jensen's, he is entitled to make and use it to any extent he desires. In other words, there is on the Pacific Coast one rule of law as to the unfortunate Jensen, and a different rule of law as to the more fortunate Wheaton, notwithstanding the fact that the acts of both of them with regard to the subject matter of litigation are substantially one and the same. Is it possible that our judicial system shall be liable to such reproach as this? We submit that no more appropriate case could be made

for the issuance of the writ of *certiorari* than the anomalous case presented by the facts which we have stated. The law should not be one thing at one day and another thing at another day, not one thing at Rome and a different thing at Athens, any more than in the time of the Roman orator who uttered these words. Wisely, therefore, have our law makers provided in the Circuit Court of Appeals Act that the decrees of those Courts are liable to be reviewed on writs of *certiorari* issued by this Court.

At this point we venture to remind the Court that there is now pending in this Court, on the present calendar, a case involving the precise question at issue here. We refer to the case of *Vulcan Iron Works* vs. *Smith et al.* That was a suit in equity for the infringement of a patent, brought in the Circuit Court for the Northern District of California. An interlocutory decree for an injunction, accounting, etc., was entered in favor of the complainant. An appeal therefrom was taken by the defendant to the Circuit Court of Appeals for the Ninth Circuit. Upon a hearing on the merits the decree was reversed and the cause remanded with instructions to the lower Court to dismiss the bill. Upon application being made to this Court for the issuance of a writ of *certiorari* on the grounds of conflict of decision and great public importance of the question involved, the writ was granted, and the case is now on the present term calendar of the Court for argument. The reasons for issuing the writ in that case were practically the same reasons which should induce the Court to issue the writ herein. The questions involved in the two cases are practically identical, and we submit that our

clients, Norton Bros., of Chicago, are entitled to the same relief as were our clients, Smith, Myers & Schnier, of Cincinnati.

All of which is respectfully submitted.

JOHN H. MILLER,
(San Francisco),
Edward S. Evarts Attorney for Petitioners.

JOHN W. MUNDAY,
EDMUND ADCOCK,
(Chicago),
Of Counsel.

165-518

Office Supreme Court, U. S.
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JAMES H. MCKENNEY,
Clerk.

165-578

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1896.

EDWIN and OLIVER W. NORTON.
Appellants and Petitioners,

vs.

MILTON A. WHEATON.
Appellee.

63

POINTS AND AUTHORITIES OF MILTON A. WHEATON

Opposing the issuance of a Writ of Certiorari herein.

MILTON A. WHEATON,
In Propria Persona.

GEO. SPAULDING & CO., PRS., 414 CLAY ST., SAN FRANCISCO.

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GEO. SPAULDING & CO., PRS., 414 CLAY ST., SAN FRANCISCO.

IN THE SUPREME COURT

OF THE

UNITED STATES.

EDWIN NORTON AND OLIVER W. NORTON,
APPELLANTS AND PETITIONERS,

vs.

MILTON A. WHEATON,
APPELLEE AND OPPONENT.

In the Matter of Appellants' Petition for a Writ of Certiorari.

Notice has been served upon the undersigned Milton A. Wheaton that the said Edwin and Oliver W. Norton will, on the sixth day of November, 1896, apply to this Supreme Court for a writ of *certiorari* directed to the United States Circuit Court of Appeals for the Ninth Circuit, commanding that Court to certify and send to this Court, by a day certain, a transcript of the record and proceedings of the said Circuit Court of Appeals in the case wherein said Edwin and Oliver W. Norton are appellants and the said Milton A. Wheaton is appellee, in order that said case may be reviewed and determined by this Court.

In response to said notice the said Milton A. Wheaton now appears and files these printed points and authorities, furnishing reasons why said writ of *certiorari* should not be granted.

Points and Authorities.

As shown by the verified petition filed upon this application the said case of Edwin and Oliver W. Norton is before the said Court of Appeals for the second time. On the first appeal of the case said Wheaton was the appellant. On that appeal the

said Court of Appeals reversed the interlocutory decree of the Court below, and directed that Court to dismiss the complainants' bill. The said Nortons did *not* on that appeal apply for any writ of certiorari to our knowledge. If such application was made it must have been denied as no *certiorari* was issued. The mandate went down from the said Court of Appeals to the Circuit Court and that Court obeyed the decree of the Court of Appeals and dismissed the complainants' bill, and from that decree of dismissal the present appeal was taken by the said Nortons.

The said Wheaton, in due form and upon proper notice, moved for the dismissal of that appeal upon the ground that the Circuit Court having simply obeyed the decree of the Court of Appeals, its judgment was correct and the Circuit Court of Appeals should not entertain the appeal.

This was a good and sufficient ground for dismissing the appeal.

Aspen Mining and Smelting Co. vs. *Billings*, 150 U. S., 31. See page 37, near bottom.
Stewart vs. *Salamon*. 97 U. S., 361.
Humphrey vs. *Baker*, 103 U. S., 736.
Kingsbury vs. *Buckner*, 134 U. S., last half page, 671.
Southard vs. *Russell*, 16 Howard, 547, last half page, 570.
Gains vs. *Rugg*, 148 U. S., 228, pages 239, 242, 243, and 244.
Washington Bridge Co. vs. *Stewart*, 3 Howard, 413.

The foregoing authorities also establish the proposition that when a case has gone to highest Court of Appeals and its decision obtained that decision becomes the law of that case so long as the facts remain the same.

See also *ex parte Sibbald* vs. *United States*, 12 Peters, 488, pages 491 and 492.

Another proposition is this:

As the decree of the Court of Appeals became final, and was a decision upon the merits of the case, the mandate of the Court of Appeals having regularly gone down to the Circuit Court, the decree of the Court of Appeals became forever final and its judgment was conclusive upon the parties to the suit, and it is therefore too late for this Court to interpose, and, by *certiorari* or otherwise, disturb that adjudication. The *certiorari* should have been applied for while the case of *Wheaton* vs. *Norton* was

before the Court of Appeals. After the mandate went down to the Circuit Court it was too late to open that decree.

Aspen Mining and Smelting Co. vs. *Billings*, 150 U. S., last half page 37.

Stout vs. *Lye*, 103 U. S., 66, first half page 71.

Last Chance Mining Co. vs. *Tyler Mining Co.*, 157 U. S. 683.

Cromwell vs. *County of Sac.*, 94 U. S., 351, last half page 352.

Lessee of Parrish vs. *Ferris*, 2 Black, 606, last part pages 608 and first part page 609.

Johnson Company vs. *Wharton*, 152 U. S., 252, last lines on page 257 and first line on page 258, also last six lines of the decision on page 261.

The decision of the Court of Appeals in the case of *Wheaton* vs. *Norton* is reported in 70 Fed. Rep., from pages 833 to 853. The opinion and decision *goes entirely to the merits of the case*, and the decree was that there was no infringement. It was an undisputed fact that the machine made and sold by Wheaton was made under the patent granted to him in 1892, and if that machine did not infringe the complainant's patent then there was no infringement. The decision is lengthy and exhaustive. On pages 851, 852 and 853, 70 Fed. Rep., the Court of Appeals makes a comparison of the Wheaton machine with the complainants' patent, going entirely through the mechanism, part by part, of the two machines, and, as there shown, there are no parts of the Wheaton machine that correspond to any parts of the complainants' patent. The central device of the patent is a *stationary* shaft that never moves, and the construction and plan of the machine is such that its central shaft *must be stationary*. In the Wheaton machine the central shaft is a *revolving driving* shaft, and the plan and construction of the machine is such that this central shaft *must be a moving driving* shaft. From these first initial central devices to the last moving devices of the two machines the mechanisms are entirely unlike and operate upon entirely different mechanical principles.

The comparison made by the Court of Appeals as shown in its said decision proves that there was not a shadow of infringement, no matter how broadly the claims of the patent may be construed. There is not a single feature that is covered by a single claim of the patent that can be found in the Wheaton machine.

Because the judgment of the Court of Appeals in the said case of *Wheaton* vs *Norton* became the law of the case and *forever final*, and because also that judgment was eminently correct, we submit that the *certiorari* prayed for should not be granted.

MILTON A. WHEATON,
In propria persona.

165-578

JAN 12 1897
JAMES H. MCKENNEY

No. 639.

United States Supreme Court

October Term 1896.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants.

vs.

MILTON A. WHEATON,
Appellee.

In the matter of the application of the above named appellants for a Writ of Certiorari.

Answer of MILTON A. WHEATON, to the order to show cause herein, including

Affidavit, Copies of Pleadings, and Copy of the Decision of the United States Circuit Court of Appeals, in the case of WHEATON vs. EDWIN and OLIVER W. NORTON.

Because the judgment of the Court of Appeals in the said case of *Wheaton* vs *Norton* became the law of the case and *forever final*, and because also that judgment was eminently correct, we submit that the *certiorari* prayed for should not be granted.

MILTON A. WHEATON,
In propria persona.

165-518

Office Supreme Court, U. S.
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IN THE SUPREME COURT OF THE UNITED STATES

No. 639, October Term, 1896.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants,

vs.

MILTON A. WHEATON, *Appellee.*

In the matter of the application of Edwin Norton and Oliver W. Norton for a writ of certiorari.

STATE OF CALIFORNIA, }
City and County of San Francisco. } ss.

Milton A. Wheaton being first duly sworn on his oath deposes and says that he is the person of that name mentioned in the petition for a writ of certiorari herein filed. That he has read a copy of said petition and knows the contents thereof. That most of the allegations of fact therein contained are true. That an action was commenced against this affiant by the said Edwin and Oliver W. Norton and a decree was entered against him by His Honor Judge McKenna, and an appeal was taken from such decree to the United States Circuit Court of Appeals of the Ninth Judicial Circuit, and a decision was at first made by that Court affirming the said decree, and said decision was afterwards set aside and rehearing granted, and a further decision was made in said Court of Appeals which reversed the interlocutory decree appealed from and directed the lower court to dismiss the action as set forth in said petition. Affiant further says that he has attached hereto and makes a part of this affidavit a copy of the bill of complaint on which the said action of Edwin Norton and Oliver W. Norton was commenced, excepting only that in the said copy there is omitted the drawings of the complainants' patent, a copy of the specifications and drawings of which was made a part of said bill of complaint.

That he has also attached hereto and makes apart of this affidavit a copy of his answer to said complaint which was filed in said action.

That he has also attached hereto and makes apart of this affidavit a copy of the decision of said United States Circuit Court of Appeals of the Ninth Circuit which was rendered on the 31st day of October, 1895, and which reversed the interlocutory decree of the lower Court, and directed it to enter a decree dismissing the bill at complainants' cost.

That after said final decree was rendered by said Court of Appeals on the thirty-first day of October, 1895, the said Norton filed a petition for a rehearing in said case and the same was denied on the fourteenth day of January, 1896, and afterwards on the nineteenth day of March, 1896, the mandate from said Court of Appeals was sent down to said Circuit Court and that Court duly entered a final decree dismissing said action in accordance with the said direction of said Court of Appeals. But affiant avers that said Judge McKenna did not decide the case upon its merits but announced that he considered that the decision of the Court of Appeals in the former Jensen case decided the case for him. That he considered that the defendant's machine was so much like the Jensen machine that it fell within the said former decision and he made his decree accordingly. Affiant avers that the said decision of Judge McKenna is reported in 57 Fed. Rep. at pages 927 to 929 and in making his said decision said Judge McKenna did not make any comparison whatever between the claims of the complainants' said patent and the defendant's machine. In said decision the learned Judge says in reference to the similarity between the said Jensen machine and said Wheaton's machine: "I do not mean *structural similarity*, but similarity which *in legal effect* brings it within the scope of the decision." See page 928 of said decision.

Affiant further avers that the statements made to the effect that his machine is in any respect like the said Jensen machine are incorrect. He avers that the said Jensen machine was especially designed and constructed for use in putting the second head upon filled fish cans. That in order to do this work it was necessary that the said second head should be put upon the can while it was standing in an upright position, since the fish was liable to spill out of the can to a greater or less extent if the can should be headed after it was filled, and should be placed in a horizontal position while the second head was being applied. That the said Jensen machine did in fact head its cans while they were in a vertical position and it could not head them in any other position. He also avers that in the said Jensen machine only one head could be placed upon the can at one and the same time. Affiant further avers that he believes he knows all of the can-heading machines that have been in use or patented since the year 1886 and that of all those machines the said Jensen machine was and is the only automatic machine that is used or ever

has been used or that can be used for the putting of said second head upon filled fish cans and do good practicable work. That for said use and purpose the said Jensen machine was a practicable and successful machine and went at once into practical and successful general use.

Affiant further avers that his own said machine cannot do, or be made to do, the said work that is done by the said Jensen machine. That the said machine of this affiant in doing its ordinary work puts both of the heads upon the can body at one and the same time, and that it so puts the heads on the can bodies while the said bodies are in a horizontal position. That in its ordinary work it will put, and does put, both heads upon as many as six thousand can bodies in an hour, and has headed cans at the rate of over ten thousand cans per hour, doing perfect work. That the said Jensen had a patent for his machine, and for years was well acquainted with this affiant's said machines, and always admitted that there was nothing in this affiant's machine that was to be found in his, Jensen's, said patent. Affiant avers that the mechanical devices of which said machines were made up were entirely different in kind and were differently arranged and combined, and there was no similarity in mechanism or in the work which the several devices of each respective machine performed. That the machines were so much unlike that no parts whatever could be found in the two machines that corresponded to or with each other.

Affiant further says that in its decision of the case on the said appeal of *Wheaton* vs. *Nortons* the said Circuit Court of Appeals specified differences that existed between the machines made by the said Wheaton and the machines that were described in the said complainants' patent. That the said decision of said Court of Appeals is reported in volume 70 of the Federal Reporter from page 833 to page 853. That the said differences are mentioned in that part of the said decision which begins with the last paragraph on page 851 of said volume and extends from that point nearly to the end of the decision. It also appears in the copy of said decision that is made a part of this affidavit beginning on page And affiant further avers that the said differences as recited in said decision of said Unitd States Court of Appeals actually and in fact did exist between the said machines that were made by the said Wheaton and the machine that was described in the said patent of the said complainants. That certain drawings of the material parts of the machine described in the said

patent of said Nortons appear on page 834 of said volume 70 of said Fed. Rep. and certain drawings of material parts of the said Wheaton's machine appear on page 835 thereof.

Affiant further avers that his said patent was put in evidence on the trial of said action of *Nortons* vs. *Wheaton* in said Circuit Court and was a part of the record on appeal that was before the said Court of Appeals when it made each one of its said decisions in the two appeals that were taken in said action.

MILTON A. WHEATON.

Subscribed and sworn to before me on this the 2nd day of January, 1897.

[SEAL] F. D. MONCKTON,

Clerk U. S. Circuit Court, Ninth Circuit.

Bill of Complaint.

To the Judges of the Circuit Court of the United States for the Northern District of California. In Equity.

Edwin Norton, of Maywood, and Oliver W. Norton, of Chicago, both in the County of Cook, and State of Illinois, and citizens of the State of Illinois, bring this their bill of complaint against Milton A. Wheaton, of San Francisco, in the State of California, and an inhabitant of said State and of said District.

And thereupon your orators complain and say:

That heretofore, and before the seventh day of November, A. D., 1882, your orator, Edwin Norton, became and was the original and first inventor of certain improvements in machines for putting on the ends of fruit and other cans, not known or used by others before his said invention thereof, and not in public use or on sale for more than two years before his application for a patent therefor, and being such first and original inventor, the said Edwin Norton made application by proper petition to the Commissioner of Patents for letters patent upon said invention, and paid the fees required by law therefor; whereupon the said inventor having complied with all the requirements of the statute in that case made and provided, certain letters patent of the United States, dated the seventh day of November, A. D., 1882, numbered 267,014, duly signed, sealed and executed, and in due form of law, were issued and delivered to said Edwin Norton for the said invention. And thereby there was granted to said Edwin Norton, his heirs and assigns, the full and exclusive right and liberty of making, using and vending the said invention for the term of seventeen years from and after the date thereof, a description of the said invention being contained in the specifications, a copy whereof was annexed to said letters patent and made a part thereof, as by the said letters patent or a duly certified copy thereof here in Court to be produced, will more fully appear.

And your orators attach hereto and make a part of their bill of complaint, a copy of the specification so annexed to said letters patent and mark the same "Exhibit A."

Your orators further show that a certain assignment in writing of said letters patent has been made and duly recorded in the Patent Office of the United States, whereby your orators prior to the infringements hereinafter complained of, became and now are the sole owners of said letters patent, as in and

by said assignment, or a certified copy thereof here in Court to be produced, will more fully and certainly appear.

Your orators also show that they are the sole owners of all rights and privileges granted or intended so to be in and by said letters patent; that such rights and privileges have been and are of great pecuniary benefit and advantage to your orators, who, together with their grantor, have heretofore been in the exclusive possession and enjoyment thereof, and would now be in such exclusive possession and enjoyment but for the infringement by the defendant hereinafter complained of; that the said invention has been extensively used by the public, and that the public have generally acquiesced in your orators' said exclusive property therein, as well as in the validity of said letters patent.

Your orators further show that the defendant well knowing the premises, and sometimes confederating with others, to your orators unknown, but contriving to injure your orators and deprive them of the benefits and advantages which might and otherwise would accrue to them, after the date of said letters patent, and previous to the commencement of this suit, at San Francisco, in said district and elsewhere, without the license of your orators, and against their will and protest, and in violation of right, and in infringement of said letters patent did, together, unlawfully and wrongfully make, or caused to be made, use or caused to be used, vend, or cause to be vended, can-ending machines, embodying the invention and improvements patented by said letters patent, and still continue, and threaten to continue so to do, in violation of your orator's rights as aforesaid.

Your orator further shows that the can-ending machines so made, used and sold by said defendant, were and are constructed by him substantially in accordance with the specification and drawings of Letters Patent of the United States No. 477,584, granted June 21, A. D. 1892, to said defendant, Milton A. Wheaton; your orators show that said machine is a mere subsequent improvement or colorable change upon the invention set forth in your orator's said Letters Patent No. 267,014. Your orators further show that the defendant has had notice of your orator's rights in the premises, and that he was infringing thereon, and has been requested to desist therefrom, but not withstanding such notice and request, the defendant still continues such unlawful acts of infringement.

Your orators further show that said Letters Patent No. 267,014 have been in controversy before the Circuit Court of United States for the District of Oregon, in a suit instituted by your orators against Mathias Jensen and John Fox, on or about the 3rd day of August, A. D. 1888; that the defendants in said suit answered, denying the infringement by them of said letters patent, and also denying the novelty of the invention therein described, and setting up various defenses thereto. That testimony in said defenses was duly taken by said defendants, and the cause came on for hearing and was heard by his Honor Judge Sawyer, on October 7th, 1889, said defendants being represented by counsel at such hearing; that on the 30th day of October, 1889, a decree was rendered by said Court holding that said letters patent, among others, was and is good and valid and had been infringed by said Mathias Jensen and John Fox, and ordering a perpetual injunction to be issued against said defendants, Mathias Jensen and John Fox, and that they account for profits and damages.

That thereafter said suit was appealed by the defendants, Mathias Jensen and John Fox, to the United States Circuit Court of Appeals for the Ninth Circuit at San Francisco, California, and said appeal came on for hearing and was heard by their Honors Judges Hanford, Hawley and Morrow, on the ____ day of January, A. D. 1892, and the cause was fully argued before said Court, both orally and by printed briefs, said defendants, Mathias Jensen and John Fox, being represented at such hearing by counsel, among others by Milton A. Wheaton, Esq., and that thereafter said Court of Appeals rendered its decision affirming said decree as to said patent No. 267,014, and holding that said patent was and is good and valid and had been infringed by said Mathias Jensen and John Fox.

Your orators further show that the machine manufactured by said Mathias Jensen and John Fox and so decreed and held to be an infringement of said Letters Patent No. 267,014 by said Circuit Court and by said Circuit Court of Appeals, was constructed substantially in accordance with the specification and drawing of Letter Patent No. 376,804, granted to Mathias Jensen, January 24, 1888.

Your orators further show that said can-ending machine so constructed by said defendant Milton A. Wheaton, is, in respect to its mechanism for sizing and rounding the can-body and forcing the can-head upon the body,

substantially identical in construction and operation with the mechanism for sizing and rounding the can-body and forcing the head upon the body of said Jensen patent machine so decreed and held to be an infringement of your orator's said patent No. 267,014 by said Circuit Court and by said Circuit Court of Appeals.

And your orators further show that it is contrary to equity and good conscience and to the orderly administration of justice that an officer of this Court, said defendant Milton A. Wheaton, should be permitted to manufacture and sell a can-heading machine, substantially the same in construction and mode of operation as that which his clients, the said Mathias Jensen and John Fox have heretofore been enjoined from making, as before mentioned, and for whom he appeared and acted as counsel in said prior suit.

All of which acts and doings of the defendant are contrary to equity and good conscience, and tend to the great loss and injury to your orators, and have caused them great damage, and deprived them, and are still depriving them, of great gains and profits which they might and otherwise would have obtained and received.

Your orators further show, upon information and belief that the defendant has made and realized large profits and advantages from the using, making and vending said patented invention to which your orators are entitled, and whereof they pray a discovery.

To the end, therefore, that the defendant may, if he can, show why your orators should not have the relief hereby prayed, and may, according to the best and utmost of his knowledge, remembrance, information and belief, true, direct and perfect answer make to all and singular the matters aforesaid (your orators hereby waiving, pursuant to the statute, the necessity of the answer of the defendant being put in under his oath) and that as fully and particularly as if the same were here repeated, and he was distinctly interrogated thereto.

That the defendant may be compelled to account for and pay over the profits by him acquired, and the damages by your orators sustained from the aforesaid unlawful acts of the defendant, and that the defendant, his agents, servants, workmen and attorneys, be perpetually enjoined from directly or indirectly making or causing to be made, using or causing to be used, vending or causing to be vended, or in any way counterfeiting or imitating the said invention, or any part thereof. Also, that the

defendant and the persons aforesaid, provisionally and pending this suit; also, that the defendant be decreed to pay the costs of this suit to be taxed, and that your orators may have such further or other relief in the premises as the nature of the circumstances of this case may require and to your Honors shall seem meet.

May it please your Honors to grant unto your orators a writ of injunction issuing out of and under the seal of this Honorable Court, to be directed to the said defendant and his attorneys, solicitors, agents and servants, commanding and restraining them, and each of them, as hereinbefore prayed.

May it please your Honors to grant unto your orators a writ of subpœna to be directed to the said defendant, Milton A. Wheaton, thereby commanding him, at a certain time and under a certain penalty therein to be limited, personally to appear before this honorable Court, and then and there to answer the premises; and further, to stand to, perform and abide such order and decree therein as to your Honors shall seem agreeable to equity and good conscience. And your orators will ever pray, etc.

EDWIN NORTON,
OLIVER W. NORTON,
By Edwin Norton.

HAVEN & HAVEN, AND
MUNDAY, EVARTS & ADCOCK,
Solis. for Complts.

EDMUND ADCOCK,
Of Counsel.

STATE OF ILLINOIS, }
County of Cook, } ss.

On this 8th day of August, A. D. 1892, before me personally appeared the above-named Edwin Norton, one of the above-named complaints, and made oath that he has read the above bill, by him subscribed, and knows the contents thereof, and that the same is true of his own knowledge, except as to matters and things which are therein stated on information and belief, and as to those matters he believes it to be true.

[Notarial Seal]

H. M. MUNDAY, Notary Public,
Cook County, Illinois.

Exhibit A.

UNITED STATES PATENT OFFICE.

Edwin Norton, of Chicago, Illinois.

Machine for Putting on the Ends of Fruit and Other Cans.

Specifications forming part of Letters Patent No. 267,014, dated November 7, 1882. Application filed June 24, 1882. (No model.)

To all whom it may concern;

Be it known that I, Edwin Norton, of Chicago, County of Cook, and State of Illinois, have invented certain new and useful Improvements in Machines for Putting on the ends of Fruit and other Cans, of which the following is a specification.

This invention relates to a machine for putting on the ends of fruit and other cans, wherein the joint by which the ends are secured to the body is of the variety commonly called the "slip-joint," in contradistinction from a seamed or turned joint. The objects sought are the performance of this operation automatically and with speed and efficiency.

Heretofore machines have been constructed for applying the heads to that class of cans where the flange of the head is inserted inside the can-body, or where the head is crimped on the can-body. In such machines the interior of the can-body is ordinarily sized so as to fit and receive within it the can-head by means of an interior mandrel or former, which is forced inside the can-body while it is secured within a mold or holder, and then the can-head is dropped or pressed into place inside the can-body, as illustrated in Letters Patent No. 235,700, granted to George H. Pierce, December 21, 1880. As the can-bodies are originally formed around an inside mandrel, the interior diameter of the cans varies, if at all, very slightly, and the side seam also ordinarily forms no projection on the inside of the can, as it does on the outside, so that the operation of applying the heads to this class of cans would be comparatively simple and easy, even if the heads were required to fit the can-bodies tightly, which, however, is not the case. But heretofore no successful method has yet been devised for automatically applying the heads or covers to that class of cans wherein the flange of the cover slips or fits over the body of the can, forming the ordinary slip-joint. In that class of cans it is essential that the heads or covers, when snapped on the can-body, should fit the same very tightly and accurately; and as the exterior diameters of the

can-bodies always vary somewhat, owing to the varying thickness of the different parts of the stock from which they are made, the operation of snapping or fitting the heads on the can-bodies is one of considerable difficulty, and when done by hand, as it heretofore always has been done, it requires skilled labor, and is a slow and tedious operation. The heads or covers for the cans are formed by a stamp, so that their interior diameters are always precisely the same, and in my machine the can-bodies are placed within a can sizing and clamping mold and compressed thereby until the exterior diameter of the can-body is made to conform accurately to the interior diameter of the head, and so held while the head is forced upon the can-body, the mold or holder being cut away or enlarged at each end to conform to the exterior diameter of the head, thus leaving an annular space between the can-body and mold conforming to the thickness and width of the flange on the can-head or end, into which annular space the head is forced, and then the mold is opened and the headed can discharged.

In this invention the can-body is first placed within a clamping-mold conforming accurately in shape and dimension to the exterior of the can-body, and while confined in this mold the end of the can is forced upon the body by a piston entering the mouth of the mold, room being provided for the entrance between the mold and can-body of the flange borne upon the end of the can by chamfering away the interior of the mold slightly as far as said flange extends. The mold is also preferably made tapering at the mouth, where the cam end is received, so as to guide the end accurately to the body and insure the registering of one with the other. In the furtherance of speed, I place a series of these molds, accompanied by pistons, upon arms radiating from and revolving around a common center or upon a wheel, and at proper times actuate the molds to clamp and release the cans and the pistons to put on the ends by means of suitable devices with which they are connected or come in contact during the rotation of the arms or wheel. All these and other features of invention I will proceed to describe with the aid of the drawings, in which---

Figure 1 is a side view of my machine. Fig. 2 is a front view, partly in section. Fig. 3 is a detail longitudinal section through one of the molds and its pistons.

In said drawings, A represents the frame of the machine, and B a stationary or non-revolving shaft mounted thereon.

Secured upon this shaft so as to rotate around the same as a common center are a series of pairs of arms, C C, each pair whereof supports one of the clamping-molds and its piston or pistons. The inner half, D, of the mold is fixed upon the arms; but the outer half is divided into two parts, D^1 D^1, which are made capable of opening to receive the can body and of closing in clamping it by hinging them at d to projections from the under half, D.

The actuating power in operating the moving parts is obtained through the jointed levers d^1 d^2, of which there is one for each part D,[1] from an angular grooved cam, E, and a pin, d^3, engaging therewith and secured in a crosspiece, d^4, connecting the two levers d^2. A transverse slot, d^5, in the inner half, D, permits the entrance within the same of the levers d^1 d^2 when the mold is opened, as clearly illustrated.

The annular cam is preferably made in two parts, each the counterpart of the other, and the pin d^3 to extend both ways so as to enter both such parts. The cam is fixed upon the shaft B, and is shaped and positioned so as to close the mold immediately after the can body has been received therein, and to discharge it as soon as the end has been forced on. Thus in the machine illustrated the can body is fed from the trough F, the mold being open when it reaches that point. It is then immediately closed, as shown, by the mold at the top of Fig. 1, and remains closed until the mold reaches the discharge trough F^1.

Between the parts of the cam is a ring, G, loosely encircling the main shaft. This ring is provided with radial recesse g, into which extensions g^1 of the crosspieces d^4 are fitted and slide, serving as guides to the parts operating the moving sides of the molds and insuring a perfectly true push or movement thereof by the cam.

Accompanying each mold is a feed passage or chute, H, through which the can ends are fed into position at the open mouths of the molds, and a piston, I, having a head, i, corresponding in form and dimension as nearly as may be with the can end. These pistons are actuated to their duty of forcing the ends upon the can bodies by the contact of their outer ends with the stationary cams I^1 upon the bed of the frame A, such contact taking place before the mold has reached the discharge chute F^1. After the pistons have been thus actuated they are retracted by springs i^1, inserted in the interior thereof, and confined between the close end of the same and a pin, i^2, passing through longitudinal slots, i^3, in

the sides of the piston (see dotted lines, Fig. 3) and secured in the encircling barrel I^2, wherein the piston slides. This barrel is secured upon an arm C, in any appropriate manner. After the can has been capped or ended thus the annular cam forces the mold open, and in so doing the parts which enter the transverse slot d^5 eject the can into the chute F^1.

As shown in Figs. 2 and 3, the end of the mold is chamfered away interiorly to give room to the flange of the cap or can end to pass outside the can-body. This is a very essential feature, and I also give the mold a slightly flaring opening, terminating at the point where the cap and body first meet, so the former may be deflected to the right position if it is not accurately positioned at the time the piston begins to move it.

Power is communicated to the mechanism from the shaft J through the bevel-gears J^1 J^2, the latter being keyed to the hub C, from which one of each pair of the arms C radiates, and the power so given to the arms upon one side is carried to those upon the other side through the molds which connect them together.

I have shown duplicate chutes for the can caps and pistons at each end of the molds.

It will be understood that the invention may be used to cap one end at a time or both ends, as desired. Nor do I wish to be limited to arms C, arranged in pairs, nor to the precise manner of opening the molds, nor to the precise operating mechanism therefor, because these features may obviously be varied in many respects.

A mold constructed after my invention—that is, so as to conform to the exterior of the can-body—fits the body accurately and presses with equal clamping force upon every part thereof. The body is thus made strong to resist collapse, and is presented for the application of the cap or end in perfectly true form and without the aid of an interior mandrel or forming device The chutes through which the ends are fed to the molds serve the additional function of guiding the can-body in its entrance to the mold.

Instead of providing a separate piston for each one of the molds, as shown in the drawings, if preferred, a single pair of non-revolving pistons may be used; but in this case obviously the pistons must be operated by other devices than the stationary cams shown, and the carriage upon which the molds are mounted would require an intermittent instead of a continuous motion; and in this case, also, instead of providing a

series of chutes for the can ends, a single stationary pair will suffice, and I do not wish to limit myself to any particular form or construction of can-mold or means of operating said mold to clamp or release the can, nor to any particular devices for forcing the can end upon the can-body when secured in said mold, as all these features or devices may be greatly varied without departing from the principle or essential characteristic of my invention.

It may also be observed that the molds may be mounted upon a reciprocating slide or an endless belt or other device instead of the revolving wheel shown in the drawings.

I claim—

1. In a machine for applying to can-bodies heads fitting outside the same, the combination of a device for sizing the exterior diameter of the can-body to conform to the interior diameter of the can-head and holding the same so sized while the head is applied, said sizing and holding device having its end enlarged to fit the exterior diameter of the can-head, so as to leave an annular space between it and the can-body for the reception of the flange of the can-head, with a device for forcing the can-head into said annular space, and thereby applying the head outside the can-body, substantially as specified.

2. In a machine for applying to can-bodies heads fitting outside the same, the combination of a chute or device for delivering the can-bodies to the machine, with a movable device for clamping the can-body and sizing its exterior diameter to conform to the interior diameter of the can-head, said clamping and sizing device having its end or mouth enlarged to leave an annular space between the same and the can-body clamped therein for the reception of the flange of the head, a chute or device for delivering the can-heads to the machine, and a device for forcing the can-head into said annular space at the end of said clamping and sizing device, substantially as specified.

3. In a machine for simultaneously applying the heads to both ends of a can, the combination of a series of movable devices for clamping the can-body and sizing its exterior diameter to conform to the interior diameter of the can-heads, said clamping and sizing devices having enlargements at each end or mouth for the reception of the can-heads outside the can-body, with devices for simultaneously forcing the can-heads on each end of the can-body, into the annular spaces at

each end thereof between the can-body and said clamping and sizing device, substantially as specified.

EDWIN NORTON.

Witnesses:

EDMUND ADCOCK,

T. EVERETT BROWN,

(Endorsed:)

Filed August 16, 1892. L. S. B. Sawyer, Clerk.

Answer.

In the Circuit Court of the United States, Ninth Circuit, Northern District of California.

EDWIN NORTON AND OLIVER W. NORTON, Complainants,
vs.
MILTON A. WHEATON, Defendant.

The answer of Milton A. Wheaton, defendant, to the bill of complaint of Edwin Norton and Oliver W. Norton.

This defendant now, and at all times hereafter, saving and reserving unto himself all benefit and advantage of exception which can or may be had or taken to the many errors, uncertainties and other imperfections in the said complainant's said bill of complaint contained, for answer thereto, or unto so much and such parts thereof, as this defendant is advised, is or are material or necessary for him to make answer unto, this defendant for answering, saith:

That it is not true and he denies that prior to the seventh day of November, or at any other time, Edwin Norton was the original inventor, or the first inventor, or any inventor of the alleged improvements in machines for putting on the ends of fruit and other cans which are described in the Letters Patent Number 267,014, bearing date November seventh, 1882, and granted to the said Edwin Norton, as recited in said bill. Defendant admits that the said letters patent were granted to the said Edwin Norton as stated in said bill, but he denies that the machine described in said letters patent was invented by the said Edwin Norton, and denies that it constituted any invention whatever. Defendant avers that what is described as an invention in said letters patent is but an impracticable, worthless affair, utterly incapable of action, and that it will not do the work of putting the ends upon cans, and will not accomplish the results which the said letters patent state that it will accomplish. That the said letters patent were applied for by the said Edwin Norton without his ever having made or tested any machine made according to the description contained in said letters patent. That the alleged invention was merely an idea represented on paper only and no attempt was made by the said Edwin Norton to make a machine of that kind or to test the same in any practical manner whatever until many years after he applied for and obtained the said letters patent. That at some time, which this defendant is unable to definitely fix, but which he

believes was about the year 1890, the complainants herein undertook to make a can-heading machine in accordance with the description contained in the said letters patent, but found, after expending a very large amount of money in the effort, that such a machine was worthless and incapable of operation. The said machine last mentioned was made by said complainants while their litigation against Mathias Jensen mentioned in the bill was pending, and it was made with the intention of introducing it in evidence in that action for the purpose of proving the value of the alleged invention, but on account of the total failure of the machine, and the impossibility of making it operate, it was not so introduced in evidence in the said suit.

Defendant further avers that after the said letters patent had been applied for, the said Edwin Norton abandoned the said invention and made a different kind of can-heading machine, which was invented by himself and one John G. Hodgson, and for which the said Edwin Norton and John G. Hodgson were granted United States Letters Patent Number 274,363, on the 20th day of March, 1883. Defendant avers that the complainants have been manufacturing and furnishing to other parties to use can-heading machines since about the year 1883, and that all the can-heading machines that have been made by them, or either of them, have been made in accordance with the description contained in said Letters Patent Number 274,363, and that neither of the complainants ever made or assisted in making, or causing to be made, any can-heading machine such as is described in said Letters Patent Number 267,014, excepting the one single machine which has made during the pendency of the suit against Mathias Jensen and John Fox, as hereinbefore stated.

Defendant avers that because of the facts that the said contrivance described in said last-mentioned letters patent was incapable of effecting the results which were therein represented to be the usual results that it would accomplish, and also for the reason that the said contrivance was abandoned by the said complainants, and each of them, the said Letters Patent Number 267,014 are invalid and void.

Defendant denies that the said letters patent conferred upon the said complainants, or upon any one, the exclusive right and liberty, or any right or any liberty of either making, or using, or vending the said contrivance, which is

alleged to be an invention in the said letters patent, either for the term of seventeen years, or at all.

Defendant admits that said letters patent were assigned, so far as void letters patent could be assigned, to the complainants, as stated in the complainant's said bill. But defendant denies that any rights or any privileges that were granted, or that purported to be granted, by said letters patent, either have been, or are, of great pecuniary benefit or advantage, or of any benefit, or any advantage, either pecuniary or otherwise, to the complainants, or to either of them, and denies that the complainants or their grantor have been either in any possession, or in any enjoyment thereof, and denies that the public have ever acquiesced in any validity of said letters patent, or in any property therein being the exclusive, or any, property of the complainants, or of either of them. Defendant denies that he ever has, either alone or together with others, either made or caused to be made, or used or caused to be used, or vended or caused to be vended, any can-ending machines that are patented, or that purport to be patented, by said Letters Patent Number 267,014. Defendant denies that he has ever made or assisted in making, or in using or in selling, any can-ending machine or machines that contained, in whole or in part, any of the mechanism, apparatus or contrivances that are described in said letters patent and claimed therein as any invention. Defendant denies that he has in any manner or form whatever, ever infringed upon said letters patent, and denies that he has ever threatened to do so, and denies that he now threatens or intends to do so. Defendant avers that if he were now the full owner of said letters patent, he would no more think of making or using the machine therein described than have the complainants thought of making or using it. Defendant avers that he never has made or used or sold it; that he never has desired to make or use or sell it; that he never has made or used or sold it, and that he does not now desire or intend to make or use or sell it. Defendant denies that he has ever committed, or that he now continues to commit, any acts of infringement of the said letters patent, either unlawful or otherwise.

Defendant admits that he has made can-ending machines in said City and County of San Francisco that were substantially in accordance with the specifications and drawings of United States Letters Patent Number 477,584, granted to this defendant June 21, 1892, as alleged in said bill. But defen-

dant denies that the said machines were mere subsequent improvements or colorable changes upon the invention set forth in said Letters Patent Number 267,014. On the contrary, this defendant avers that the initial moving mechanism in each of his machines is a revolving central shaft. That the machine described in said patent does not have any revolving central shaft. That from this initial moving device of the defendant's machine to the last moving device therein, there is not a single device, nor any combination of devices, that is like or that imitates any single device or any combination of devices that is described in the complainant's said Letters Patent Number 267,014. Defendant avers that his machines are new machines, and are constructed throughout upon entirely new plans, both as to the general plan of their construction and operation, and as to all the various details of mechanical devices that are incorporated in the machines.

Defendant admits that the litigation between the complainants and Mathias Jensen and John Fox took place as stated in said bill. But defendant denies that any machine which this defendant has made is, in respect to any of its parts, substantially or at all identical, either in construction or operation, with any parts of the machine that was held to be an infringement in the said litigation with said Jensen and Fox.

Defendant denies that he has made or realized large profits and advantages, or any profits, or any advantages, from either the making or the using or the selling of the said patented invention, and denies that if he had made any profits or gains or advantages in selling his own patented inventions that the complainants would be entitled thereto.

And further answering, this defendant avers that long prior to the time that the pretended invention described in said Letters Patent Number 267,014 was made by the said Edwin Norton, that other parties had invented and patented many of the principal features and mechanical contrivances which the said complianants now claim are covered by their said Letters Patent. That among the patents which were prior to said Edwin Norton's said invention, and which this defendant will introduce in evidence for the purpose of showing prior invention and also the state of the art in canending mechanism at the time of said alleged invention on the part of said Edwin Norton, are the following, viz.:

United States Letters Patent Number 152,757, bearing date July seventh, 1874, and granted to George A. Marsh for "Improvement in devices for Heading Cans."

Also,

United States Letters Patent Number 233,079. bearing date October twelfth, 1880, and granted to Peter Dillon and John Cleary for a "Machine for Placing Heads upon Cans."

Also,

United Staies Letters Patent Number 238,351, bearing date March first, 1881, and granted to William J. Clark, assignor to Charles E. Hull and Jonathan Q. Rand, for a "Can-Heading Machine."

Also,

United States Letters Patent Number 235,700, bearing date December twenty-first, 1880, and granted to George H. Pierce, assignor of interests in the patent to Charles E. Butters and William N. Conner and Royal H. Wadleigh, for "Mechanism for Placing and Soldering Heads in Cans."

Also,

United States Letters Patent Number 225,685, bearing date March 23rd, 1880, and granted to George D. Brooks for a "Sheet Metal Seaming Machine."

Also,

English Letters Patent Number 4237, issued in the year 1873.

Defendant avers that when the application of Edwin Norton for Patent Number 267,014 was made to the United States Commissioner of Patents, the said application contained six claims. That the United States Patent officers rejected the claims as thus made, and referred the applicant to each and every one of the foregoing described patents, except the one to Marsh and the one to Clark, as being anticipations of the claims thus made. That, thereupon, the said applicant amended his application by striking out his six claims and inserting in lieu thereof the one single claim with which the patent was issued, and which claim is, in its terms, a very narrow and limited one. And defendant avers that the said applicant, after amending his application by striking out the said six claims and inserting in place of them a single claim, drawn so as to be very narrow and limited, in order to obtain the patent by avoiding the inventions shown in the prior patents to which the applicant was referred by the Patent Office as above stated, is by law estopped from asserting that his patent should be construed to cover what was shown in such prior patents. Yet defendant avers that unless the

Court shall give the complainants' said patent a very broad construction, so as to go beyond what it claims and make it cover what is shown in the said prior patents, the complainants will have no hope of recovery in this case.

And further answering, the said defendant denies that the said complainants are entitled to the relief or any part thereof in the said bill of complaint demanded. And this defendant prays the same advantage of his aforesaid answer, as if he had pleaded or demurred to the said bill of complaint, and this defendant prays leave to be dismissed with his reasonable costs and charges in this behalf most wrongfully sustained.

WHEATON, KALLOCH & KIERCE,
Solicitors for Defendant.

I. M. KALLOCH &
F. J. KIERCE,
Of Counsel for Defendant.

Service of the within answer and receipt of a copy thereof admitted this 6th day of October, 1892.

MUNDAY, EVARTS & ADCOCK,
HAVEN & HAVEN,
Solicitors for Plaintiff.

(Endorsed:) Filed 6th day of October, A. D. 1892. L. S. B. Sawyer, Clerk.

Repliation.

In the Circuit Court of the United States, Ninth Circuit, Northern District of California.

EDWIN NORTON AND OLIVER W. NORTON, Complainants,
vs.
MILTON A. WHEATON, Defendant.

The replication of Edwin Norton and Oliver W. Norton, complainants, to the answer of Milton A. Wheaton, defendant.

These repliants, saving and reserving to themselves, now and all times hereafter, all and all manner of benefit and advantage of exception, which may be had or taken to the manifold insufficiencies of the said answer, for replication thereto, say that they will aver, maintain and prove their bill of complaint to be true, certain, sufficient in the law; and that the said answer of Milton A. Wheaton, the defendant therein, is uncertain, untrue, and insufficient to be replied unto by these repliants; that any other matter or thing whatsoever in the said answer contained, material or effectual in the law, to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed and avoided, traversed or denied, is not true; all which matters and things these repliants are and will be ready to aver, maintain, and prove, as this Honorable Court shall direct, and humbly pray as in and by their said bill of complaint they have already prayed.

MUNDAY, EVARTS & ADCOCK AND
HAVEN & HAVEN,
Solicitors for said Complainants.

EDMUND ADCOCK,
Of Counsel.

Service of within replication by copy is hereby admitted this 7th day of November, 1892.

WHEATON, KALLOCH & KIERCE,
Solicitors for Defendant.

(Endorsed:) Filed Nov, 7, 1892. L. S. B. Sawyer, Clerk. By W. B. Beaizley, Deputy Clerk.

DECISION OF THE CIRCUIT COURT OF APPEALS.

IN THE UNITED STATES CIRCUIT COURT OF APPEALS, FOR THE NINTH CIRCUIT.

MILTON A. WHEATON,
Appellant,
vs.
EDWIN NORTON, ET AL.,
Appellees
No. 141.

Appeal from the Circuit Court of the United States for the Northern District of California.

WHEATON, KALLOCH & KIERCE for Appellant, and JOHN W. MUNDAY and EDMUND ADCOCK for Apellees.

Before Ross, Circuit Judge, and HAWLEY and MORROW, District Judges.

Ross, Circuit Judge, delivered the opinion of the Court:

In sheet metal can manufacture, where the heads are applied to the outside of the body, the heads are struck from circular sheets of metal by means of dies, one of which is a plunger of the shape and size of the inner diameter of the can-head flange, and the other of which is a matrix or raised die of the depth of the flange and of the diameter of the exterior of the flange. The circular disk of sheet metal being laid on this matrix, and the plunger depressed to force the sheet into it, the result is that the flange is upturned around the margin of the sheet metal disk, and is of definite dimensions, both as to its thickness and as to its exterior and interior diameter. Can-heads made by the same dies are, therefore, always of the same size. Can-bodies are, however, not always of the same size, whether they be made by hand or by machinery. They are formed over a horn or mandril, which at best can only give them uniform interior diameter, even if it were possible to press the blank sheets around the mandril with uniform force or to make the joint forming the side seam with uniform accuracy. Besides this the can bodies thus made are liable to vary in both internal and external diameter. They are also subject to variation in external diameter even if of uniform size inside, because of the varying thickness of the sheet metal of which they are made, such variation sometimes occurring in the same sheet and in different parts of the form of the can body. As it is necessary that the can-

heads which are of uniform diameter, shall in all cases closely fit against the exterior surface of the end of the can body, it is therefore requisite that an external compressing means shall be employed to compress or reduce can bodies which are slightly too large for the proper size to enter the can-head. This externally applied compressive force must be in action at the time the can-head is applied to the can body, because the relaxation of such force would allow the can body to expand to its original size and to assume any irregularity of shape which it previously possessed, and thus unfit it to receive the head. Therefore the compressive force applied to the can body must continue to hold the can to its form and size while the head is being put thereon. As the head is to closely fit the exterior of the can body, and the two are to be applied simultaneously to each other at all points in their circumference it is essential that both the head and the body be held in exact alignment with each other while the two parts are being brought together. It is therefore essential that whatever device be constructed to carry into effect this purpose must be so constructed as, first, to bring the ends of the can-body to the necessary size and diameter to receive the can-head; secondly, the head and body must be accurately held in proper alignment so that in the act of bringing them together the flange of the head may closely fit the outside of the body; thirdly, there must be a direct and uniform movement of either the can-head or can-body simultaneously at all potnts in the circumference upon the can-body, and to carry forward the operation of heading to its completion; and, fourthly, the means for sizing the can and for shaping it to a perfect circle and size must be external to the can, and so adapted as to open to release the can after the heads shall have been applied.

When one claims to be the owner of such a patented device, which has been infringed by another, the first important thing to do is to see what is the invention covered by the patent that is claimed to have been infringed. Accordingly, we turn to the record to see for what the complainants' patent was awarded. It is there seen that the inventor, Norton, asked for more than the patent office granted. The contents of the file wrapper, which was not in evidence in the case of Norton vs. Jensen (49 Fed. Rep. 859), show that Norton, in his application for the patent, claimed to have invented, not an automatic or any other kind of machine for putting ends on fruit or other cans, but to have invented "certain new and useful *improvements in machines* for putting on" such ends. And, in

his original application, he thus specified his invention:

"This invention relates to a machine for putting on the ends of fruit and other cans wherein the joint by which the ends are secured to the body is of the variety commonly called the slip-joint, in contradistinction from a seamed or turned joint. The objects sought are the performance of this operation automatically, and with speed and efficiency. The invention consists in a clamping mold, the interior dimensions and form whereof correspond with the exterior dimensions and form of the can-body, and the end whereof is chamfered away. In this invention the can-body is first placed within a clamping mold, conforming accurately in shape and dimension to the exterior of the can-body; and, while confined in this mold, the end of the can is forced upon the body by a piston entering the mouth of the mold, room being provided for the entrance between the mold and can-body of the flange borne upon the end of the can by chamfering away the interior of the mold slightly as far as said flange extends. The mold is also preferably made tapering at the mouth where the can-end is received, so as to guide the end accurately to the body and insure the registering of one with the other. In the furtherance of speed, I place a series of these molds, accompanied by pistons, upon arms radiating from and revolving around a common center or upon a wheel, and at proper times actuate the molds to clamp and release the cans and the pistons to put on the ends by means of suitable devices with which they are connected or come in contact during the rotation of the arms or wheels."

All these, and other features of the invention, Norton proceeded to describe in his application, with the aid of the accompanying drawings, and his claims were therein thus stated:

"1. In a can-ending machine, the combination of a clamping mold conforming to the exterior of the can body, a piston for forcing the cap or end piece upon the body, and devices for operating said mold and piston, substantially as specified.

"2. In a can-ending machine, the combination of a clamping mold conforming to the exterior of the can body, and chamfered away at the end so as to give room for flange of the cap or end piece, a piston for forcing the end piece upon the body, and devices for operating both mold and piston, substantially as specified.

"3. In a can-ending machine, the combination of a clamping mold, conforming to the exterior of the can body, a chute

for admitting the can ends, a piston for applying the ends to the body, and devices for operating both mold and piston, substantially as specified.

"4. In a can-ending machine, the combination of a series of clamping molds, mounted and rotating about a common center, devices for opening and closing said molds, a piston or pistons for each mold, and a device or devices for operating said pistons, substantially as specified.

"5. The combination, with a movable can-clamping and discharging mold of a device for forcing the can end upon the can body while clamped in said mold, substantially as specified.

"6. The combination, with a clamping mold for the can body of a chute or device for delivering the can bodies to said mold, a device for presenting and retaining the can end in position at the mouth of the mold, and means for forcing the can end upon the can body, substantially as specified."

All of these claims were rejected by the Patent Office—claims 1, 2 and 5 because of patents theretofore issued, namely, patent No. 235,700, to Pierce, on December 21, 1880; patent numbered 233,079, to Dillon & Cleary, on October 12, 1880; patent numbered 225,635, to Brooks, on March 23, 1880, and an English patent, numbered 4,237, issued in 1873.

The examiner of the Patent Office thus stated the objections to claims 3, 4 and 6, made by Norton:

"Claims 3 and 6 are rejected on Pierce; and, since the chute which he shows may be applied to any one of the other references, the claims are rejected on all the other references taken in connection with Pierce. Claim 4 is rejected on Pierce and on the English patent, each showing a series of clamps and a stationary piston for inserting the head into each mold and its contained can as it comes opposite the piston. In view of the broad description, including various modifications of applicant's machine, these patents meet the fourth claim."

To meet and avoid these references and objections made by the Patent Office, Norton amended his application by inserting, after the word "efficiency" in his original application, the following:

"Heretofore, machines have been constructed for applying the heads to that class of cans where the flange of the head is inserted inside the can-body, or where the head is crimped on the can-body. In such machines, the interior of the can-body is ordinarily sized so as to fit and

receive within it the can head by means of an interior mandril or former, which is forced inside the can body while it is secured within a mold or holder, and then the can head is dropped or pressed into place inside the can body, as illustrated in letters patent No. 235,700, granted to George H. Pierce December 21, 1880. As the can bodies are originally formed around an inside mandril, the interior diameter of the can varies, if at all, very slightly, and the side seam also ordinarily forms no projection on the inside of the can, as it does on the outside, so that the operation of applying the heads to this class of cans would be comparatively simple and easy, even if the heads were required to fit the can bodies tightly, which, however, is not the case. But heretofore no successful method has yet been devised for automatically applying the heads or covers to that class of cans wherein the flange of the cover slips or fits over the body of the can, forming the ordinary slip joint. In that class of cans it is essential that the heads or covers when snapped on the can body should fit the same very tightly and accurately, and, as the exterior diameters of the can bodies always vary somewhat, owing to the varying thickness of the different parts of the stock from which they are made, the operation of snapping or fitting the heads on the can bodies is one of considerable difficulty, and, when done by hand, as it heretofore always has been done, it requires skilled labor, and is a slow and tedious operation. The heads or covers of the cans are formed by a stamp, so that their interior diameters are always precisely the same, and, in my machine, the can bodies are placed within a can-sizing and clamping mold, and compressed thereby until the exterior diameter of the can body is made to conform accurately to the interior diameter of the head, and so held while the head is forced upon the can body, the mold or holder being cut away or enlarged at each end to conform to the exterior diameter of the head, thus leaving an annular space between the can body and mold conforming to the thickness and width of the flange on the can head or end, into which annular space the head is forced, and then the mold is opened and the headed can discharged."

And he further amended his original application by striking out all of the claims therein contained, and substituting in lieu of them the following:

"1. In a machine for applying to can-bodies heads fitting outside the same, the combination of a device for sizing the exterior diameter of the can-body to conform to the interior

diameter of the can-head, and holding the same so sized while the head is applied, said sizing and holding device having its end enlarged to fit the exterior diameter of the can-head, so as to leave an annular space between it and the can-body for the reception of the flange of the can-head, and with a device for forcing the can-head into said annular space, and thereby applying the head outside the can-body, substantially as specified.

"2. In a machine for applying to can-bodies heads fitting outside the same, the combination, with a chute or device for delivering the can-bodies to the machine with a movable device for clamping the can-body and sizing its exterior diameter to conform to the interior diameter of the can-head, said clamping and sizing device having its end or mouth enlarged to leave an annular space between the same and the can-body clamped therein for the reception of the flange of the head, a chute or device for delivering the can-heads to the machine, and a device for forcing the can-head into said annular space at the end of said clamping and sizing device substantially as specified.

"3. In a machine for simultaneously applying the heads to both ends of a can, the combination of a series of movable devices for clamping the can-body and sizing its exterior diameter to conform to the interior diameter of the can-heads, said clamping and sizing devices having enlargements at each end or mouth for the reception of the can-heads outside the can-body, with devices for simultaneously forcing the can-heads on each end of the can-body into the annular space at each end thereof between the can-body and said clamping and sizing device, substantially as specified.

"4. The process herein described of applying heads to can-bodies consisting in first sizing the exterior diameter of the can-body to conform to the interior diameter of the can-head, and clamping it in a suitable mold or holding device, and then forcing the heads on the can-body into an annular space at the end of the mold or holding device, between it and the can-body, substantially as specified."

In a note to the amendments thus made by Norton to his original application, he said: "The principle and mode of operation of the present invention is entirely different from that of the machine shown in the references, and is designed to effect a very different result or purpose. The references all show devices for putting the heads inside of the cans. Instead of the inside mandril shown in the Pierce patents for

sizing and flaring the interior of the can, in applicant's invention no such method of operation is or could be adopted. In applicant's invention the can is sized from the outside. None of the references show a mold or clamp for the can-body having an annular space between the can-body and the mold into which the head is forced, nor do any of the references show sizing the exterior of the can from the outside, both of which are essential features of applicant's invention.

"By the amended claims, as well as by the amendment to the specification, it will be seen, we think, that applicant's invention is properly limited and distinguished from the prior art as disclosed by the references."

Claim 4 of the amended claims was rejected by the Patent Office; and, upon objection there made that the statement made in the applicant's specification that his invention consists in "a clamping mold, the interior dimensions and form whereof correspond with the exterior dimensions and form of the can-body, and the end whereof is chamfered away," is not in accord with the three claims allowed, the applicant further amended his application by striking from his specifications the clause last quoted, and, as thus altered, the application was allowed, and the patent, numbered 267,014, was issued to Norton.

In defense of the suit, the defendant, among other things, set up in his answer, and also introduced in evidence, the patents to which Norton was referred by the Patent Office when rejecting his claims as originally made, and also letters patent No. 152,757, issued July 7, 1874, to George A. Marsh, for "improvement in devices for heading cans," and letters patent No. 238,351, issued March 1, 1881, to William J. Clark, for a "can-heading machine."

As already said, none of the proceedings in the Patent Office disclosed by the contents of the file wrapper were in evidence in the case of *Norton* vs. *Jensen*, 49 Fed. Rep., 859, nor were any of the prior patents here set up as anticipations of the complainants' patent there shown, except that of Pierce, in respect to which the Court said the testimony showed that Norton's invention was prior in point of time, for which reason the Court concluded that the Pierce patent had "no particular bearing upon any of the inventions or machines in controversy." (49 Fed. Rep., 862.) As there presented, Norton's invention undoubtedly appeared to be of a primary character, standing at the head of the art, and its owners

were, therefore, properly held to be entitled to a broad and liberal construction of its claims.

Whether the same broad and liberal construction should be applied in the present case remains to be considered.

That the complainant's patent is, by the record in this case, placed in a different position from that occupied by it in the case of *Norton* vs. *Jensen*, is very clear. Although the application for the Clark patent was filed January 7, 1881, and that patent issued March 1, 1881, and although the application for the Pierce patent was filed August 13, 1880, and that patent issued December 21, 1880, whereas Norton did not file his application for his patent until June 24, 1882, yet he testified that he made his invention and made a small experimental machine to demonstrate its practicability as early as July 15, 1880—nearly one month before the application for the Pierce patent was filed.

Nevertheless, the fact is beyond dispute, for it is a part of the record evidence, that all of the claims asked for in Norton's original application were rejected by the Patent Office based largely upon the suggestion that they were covered by the patent theretofore issued to Pierce, whereupon Norton, so far from then claiming that his invention was prior in point of time to Pierce's, amended his specifications by stating that he knew that machines had heretofore been constructed for applying heads to the same class of cans, where the flange of the head is inserted inside the can-body, or where the head is crimped on the can-body, and, for the purpose of showing that such machines were unlike his invention, he proceeded to say, in his ammendment to his specifications: "In such machines, the interior of the can body is ordinarily sized so as to fit and receive within it the can-head by means of an interior mandril or form which is forced inside the can-body while it is secured with a mold or holder, and then the can-head is dropped or pressed into place inside the can body, as illustrated in letters patent granted to George H. Pierce, December 21, 1880."

Following this, he amended his application by substituting for his original six claims which the Patent Office rejected, four other claims, the first three of which were allowed, and are embodied in the patent.

In addition to the Pierce and Clark patents, the record shows that on June 26, 1880, Dillon & Cleary applied for, and, on October 12, 1880, were granted, a patent for "an improvement in mechanism for placing heads in cans," and, in

1874, Marsh was granted a patent for "certain new and useful improvements in devices for heading cans."

The Dillon & Cleary patent was, like that to Pierce, for a device for putting heads in cans, and the Marsh patent, while for a device for putting tight fitting can heads on the outside of can bodies, was designed to be used by hand. It consists of a solid die with a cavity to receive the can head, secured rigidly to which at one side is a semi-circular bevel-faced guide, slightly overlapping, at its middle portion, the cavity, but the two extremities of which do not overlap it. Those extremities are, however, tilted slightly upward, to enable the headed can to be tipped out of the die. To use this device the operator first fits a head into the die by slipping one side under the guide. He then takes the can body in his hands and places one side under the guide into the uncovered half of the can-head flange; he then, by tilting the can body, forces it into the head, the overhanging portion of the guide serving to crowd the last portion of the circumference of the can body into the can-head flange. The headed can is then tilted out of the die.

This device for putting tight-fitting heads on the outside of can bodies, as well as the device of Pierce for putting such heads in cans, was in existence at the time Norton made the amendments to the specifications descriptive of his invention, and at the time he made the amended claims under the objections raised in the Patent Office.

It is perfectly clear that the claims first made by Norton were much broader than those finally made in his application for the patent and that were allowed and embodied in the patent issued to him, and it is equally as clear that this narrowing of his claims was compelled by the objections raised by the examiner of the Patent Office. Under such circumstances, the rule is well settled that the patentee cannot, after the issuance of the patent, broaden his claims by dropping any element which he was compelled to include in order to secure the patent. In *Fay* vs. *Cordesman*, 109 U. S., 408, the Court said: "The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination, and the Court cannot declare it to be immaterial. It is his province to make his own claim, and his privi-

lege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality." In *Sargent* vs. *Hall's Safe & Lock Co.*, 114 U. S., 63, it was said: "In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it has been persistently rejected, must be strictly construed against the inventor, and in favor of the public, and looked upon as in the nature of disclaimers." To the same effect are the cases of *Shepard* vs. *Carrigan*, 116 U. S., 593; *Leggett* vs. *Avery*, 101 U. S., 256; *Goodyear Dental Vulcanite Co.* vs. *Davis*, 102 U. S., 222-228; *Mahn* vs. *Harwood*, 112 U. S., 624-644.

And concerning the general rule by which claims are to be construed, the Court said, in *Howe Machine Co.* vs. *National Needle Co.*, 134 U. S., 394:

"Doubtless a claim is to be construed in connection with the explanation contained in the specification and it may be so drawn as in effect to make the specification an essential part of it; but since the inventor must particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery, the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim; and certainly not for the purpose of changing it and making it different from what it is. As remarked by Mr. Justice Bradley, in *White* vs. *Dunbar*, 119 U. S., 47, 52; 'The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms'."

Now, comparing the original with the amended claims of Norton, it is not difficult to see the difference between what he sought to have allowed him, and what he was compelled to accept in order to get his patent. Take claim 1: As originally made, it read: "In a can-ending machine, the combination of a clamping mold conforming to the exterior of the can-body, a piston for forcing the cap or end-piece upon the body, and devices for operating said mold and piston, substantially as specified."

Here, as will be observed, nothing whatever is said about any annular space in the end of the mold, but the claim is simply for the combination of a clamping mold conforming to

the exterior of the can-body, and a piston for forcing the cap or end-piece upon the body, with the operating devices.

As here made, claim 1 was clearly anticipated, as held by the Patent Office, by the patent of Pierce, the device of which consisted, in part of an opening and closing mold or clamp, the upper end of which is chamfered away to enable the end of the can-body to be expanded after the reception of the can-head which is forced to its place in the can by means of a piston while the can-body is tightly held by the mold.

Claim 1, as thus originally made, was, therefore, rejected by the Patent Office, and the applicant substituted in lieu of it this claim, which was allowed: "In a machine for applying to can-bodies heads fitting outside the same, the combination of a device for sizing the exterior diameter of the can-body to conform to the interior diameter of the can-head, and holding the same so sized while the head is applied, said sizing and holding device having its end enlarged to fit the exterior diameter of the can-head, so as to leave an annular space between it and the can-body for the reception of the flange of the can-head, with a device for forcing the can-head into said annular space, and thereby applying the head outside the can-body, substantially as specified."

Now, here was an element inserted in claim 1 by the applicant which the original claim did not contain, namely, a mold so constructed as to leave at its ends an annular space between the mold and can-body for the reception of the flange of the can-head, with a device for forcing the can-head into the annular space, and thereby applying the head outside the can-body.

That the annular space so introduced is an important and essential element of Norton's invention was expressly declared by himself in the note to his amended specifications and claims, where he said: "None of the references (that is to say, none of the patents to which his attention had been called by the Patent Office) show a mold or clamp for the can-body having an annular space between the can-body and the mold into which the head is forced, nor do any of the references show sizing the exterior of the can from the outside, *both of which are essential features of applicant's invention.*" And, in his specifications, the applicant also expressly asserted the essential nature of the annular space of the mold, for he there says: "As shown in figs. 2 and 3, the end of the mold is chamfered away interiorly to give room to the flange of the cap or can-

end to pass outside the can-body. *This is a very essential feature* * * *."

Thus, the inventor himself, when seeking the patent, declared that one of the essential elements of his invention is the annular space between the can-body and mold into which the can-head is forced, *thereby*, as in terms declared in claim 1, applying the head to the outside of the can; in which respect, the inventor further declared, his invention differs from any of the patents to which he was referred by the Patent Office.

Another essential element common to all of the complainants' claims, as finally made, allowed and embodied in their patent, is the piston or device for forcing the can-head into the annular space.

Both the annular space and the piston or device for forcing the can-head into that space were also made essential elements of each of the other claims as finally made and allowed and embodied in the patent, and as each of the claims of the complainant's patent is for a combination, unless the defendant's device contains that annular space and piston or device for forcing the can-head therein, or their mechanical equivalents, it is clear that the charge of infringement is not made out. (*McCormick* vs. *Talcott*, 61 U. S., 402; *Vance* vs. *Campbell*, 66 U. S., 427; *Schumacher* vs. *Cornell*, 96 U. S., 554.)

Claim 2 of the complainant's patent, in addition to the elements in claim 1 thereof, embraces a chute or device for delivering the can-bodies and a chute or device for delivering the can-heads to the machine, and claim 3 is "for simultaneously applying the heads to both ends of a can, the combination of a series of movable devices," such as is claimed in claim 1, to-wit, the mold for clamping the can-body and sizing its exterior diameter to conform to the interior diameter of the can-heads with an annular space at its ends for the reception of the flange of the can-heads with devices for simultaneously forcing the can-heads into the annular space and on each end of the can-body.

An annular space is a space existing between the circumferences of two concentric circles having different diameters. It exists in the mold of complainant's device with its two diameters, the smaller of which is equal to the diameter of the exterior of the can-body and to that of the interior of the flange of the can-head, and the larger of which is equal to the diameter of the exterior of the can-head flange. The function of the smaller diameter of the complainant's mold is to size

and round the can-body by external pressure, and that of its larger diameter, constituting the annular space, is the reception and guiding in line with and upon the can-body of the flange of the can-head when forced therein by the piston—thus tightly applying with precision and at the same time, all of the parts of the interior of the flange of the can-head to the outside of the can-body, while the latter is during all of the time of the heading process firmly held by the mold in an immovable position.

In the complainant's device, two wheels are employed to rotate on a common stationary axis, and to carry at their peripheries molds in a circumferential series. Each of these molds consists of a fixed inner semi-circular jaw, and two quarter-circular jaws, the latter being hinged to the former and adapted to open and close the mold like the two halves of a double lidded vessel wherein the half lids open outwardly. Means are provided for opening and closing these hinged parts of the mold, consisting of crank arms or levers, a slide connected by links with the lever, and a fixed cam provided with a groove or grooves which receive a pin that projects laterally from the slide and causes the slide to move radially inwardly and outwardly as the wheels revolve. At one point in the revolution of the wheels, and at a point where the hinged parts of a mold will open, a chute for can-bodies is arranged to deliver a can-body into the mold. The mold for receiving the can-body is closed in its further revolution by the fixed cam. To each mold are also applied two end chutes down which can-heads may descend into proper position opposite the ends of the can-body enclosed in the mold. Two piston heads on pistons or shanks are arranged to move inwardly toward the mold, one from each side, and to simultaneously push the can-heads into the annular spaces and thus upon the ends of the can-body. The desired movements of these pistons are obtained by springs and cams, springs being arranged to throw and hold the pistons in their retracted positions, and cams being employed to thrust the pistons inward in forcing the can-heads into the annular spaces and thereby upon the can-bodies. The mold is made in two parts, to open and receive the can body, and to discharge it after it is headed. In his specifications, the inventor said: "A model constructed after my invention, that is, so as to conform to the exterior of the can-body, fits the body accurately and presses with equal clamping force upon every part thereof." When closed upon the can body, the mold

holds it in an immovable position, the can-head being carried from the can-head chute by means of the piston or forcing device into the annular space of the mold, and thereby applied to the outside of the can-body. After the pistons have passed the cam they are retracted by the springs, and the mold is opened by the fixed cam so as to discharge the headed can from the mold.

The defendant's device consists of a main central shaft B, upon which is mounted a driving wheel E, to which power is applied in any convenient manner. Fixed upon the central shaft is a spool, upon the ends of which are two disks D D, perforated by a row of twenty holes, which pass through them near their peripheries in a circular line which is concentric with the main shaft. Metal rods F Fa pass through these holes, each rod passing through both disks and operating in pairs, one of which moves in one direction, while the other moves in the opposite direction, and each pair of which carry and operate two sets of jaws—a "set of jaws" being designated by the defendant is his specifications as "both of the two halves that form the entire circular ring that encloses a can-head and one end of the can-body." The half of this entire ring which is nearest to the rods F Fa he designates as the inside jaw L, and the other half, which pulls back from the inside jaw when the jaws open, is called the outside jaw N. Two screw bolts M M are made with a flange Ma near their middle part, and with screw threads cut both above and below the flange. These bolts are screwed down into the back La nearly to the flanges. Metal blocks O O are perforated so as to slide down over the upper ends of the bolts, and rest upon the flanges Ma. Nuts Mb on the upper ends of the bolts screw down tightly upon the blocks O O, and fasten them rigidly in place. The blocks O O may be raised or lowered to perfectly adjust the distance between the outside jaw N, which is carried by the blocks O O and hinge bolt *h*, and the inside jaw L, by loosening the nuts Mb and turning the bolts M M so as to screw them farther into or out of the back La, and then again tightening the nuts Mb upon the blocks O O. The outside jaw N is made with a shank g. This shank g fits in the space between the blocks O O, and a hinge bolt *h* passes through the blocks O O and the shank g of the outside jaw, and hinges the outside jaw in its place, so that it may stand open or be turned and closed. A latch *i* is pivoted to the edge of the back La, and is fixed normally in the position shown in the drawings

by a spring *j*, which is fixed at one of its ends to a small stud in the latch, and at its other end is fixed to a stud *k* that projects below the edge of the back La. A small stud *l* projects from the side of the outside jaw, and when the outside jaw is turned down and closed with the inside jaw, the stud *l*, in descending, will strike the upper edge of the latch *i*, and, pressing it downward, will pass into the notch shown in the latch, when the spring *j* will retract the latch and lock the two jaws together. A long metal pin P is fixed in the outside jaw or in its shank, and is used as a lever for the purpose of revolving the outside jaw on its hinge-bolt, so as to open and close the jaws as required. The pin P at the proper time strikes against bent cam-rods which are fixed in their several positions as hereinafter explained, and when the pin P comes in contact with either one of such cam-rods, it revolves the outside jaw to which it belongs around the hinge-bolt *h* in the direction which may then be required. A pin V passes through the inward extension of each inside jaw and one of the rods F or Fa, and thereby secures the set of jaws with their fastenings and connections to the rod, and compels them to move with it. Each pair of rods F and Fa carries two sets of these jaws with their fastenings and connections. The other set of jaws that are placed upon the rods F and Fa is fastened by a similar pin to the other rod Fa, so that one set of each companion sets of jaws is fastened to the rod F of each pair of rods, while the other set of jaws is fastened in the same manner to the other rod Fa. As these rods move in opposite directions, their movements cause the two sets of companion jaws which they carry to alternately approach toward and recede from each other when the machine is in operation. There are twenty sets of these jaws in the machine shown in the drawings, and they are all made precisely alike and all operate precisely alike. They all have the same kind of fastenings and connections, except that as ten sets of jaws stand facing the other ten sets, one-half of the latches *i* with their fastenings are fixed upon the right hand edges of the backs La, while the other half are fixed upon the left hand edges of such backs. This is done in order that the latches *i* may all be upon the back sides or edges of the jaws as they revolve forward around the central shaft. H is a collar that is perforated and both rods F, Fa pass thoough it. On the end of rod Fa a screw thread is cut long enough to permit a nut to be used on both sides of the collar with something to spare for adjustments. The rod Fa first has the inside nut screwed upon it,

then the collar H is placed upon it and the second or outside nut is screwed upon it. Upon the other end of its companion rod F another collar H is fastened in the same manner. The rods, either before or after the collars are fastened to them, are put in their places in the disks, the two sets of companion jaws being placed upon the rods as the rods are being placed in the disks. The sets of jaws are fastened to their respective rods by the pins V, V. The smooth end of each rod passes loosely through the collar that is fastened to the adjacent end of its companion rod. This is done only for the purpose of holding the collar better in its place, and is not necessary. In this manner one of the collars is attached rigidly to one end of one of the rods, and the other collar is attached rigidly to the other end of its companion rod, and one of the sets of jaws is attached to one of the rods, while the other set is attached to the other rod. One rod slides loosely through the inner extension of the inside jaw and through one end of the collar, and the other rod slides loosely through the corresponding extension of the other inside jaw and through one end of the other collar. Upon each one of the collars H is fixed a suitable stud *a* and a friction roller G. These friction rollers are moved in a direction that is lengthwise with the rods F and Fa by coming in contact with the inclines at the end of sectional cam rings K Ka. These cam rings K and Ka are placed concentric with the central shaft B. Only a limited movement of the friction rollers G and rods F and Fa are required, as each of the sets of jaws which they carry will not require to be moved more than one inch in either direction in ordinary machines. The sectional cam rings K and Ka are inclined near their ends, and are stationary, being fixed rigidly to the frame. As the friction rollers G are carried around by the revolving shaft, they come in contact with the inclined edges of the sectional cam rings, and are thereby forced to move crosswise with the machine until the inclines that are near the ends of the sectional cam rings are passed and the straight edges of the cam rings are reached by the rollers. The friction rollers draw with them the rods F and Fa and the two sets of jaws which they carry. In their movements crosswise with the machine, each friction roller belonging to the same companion pair of rods, with the collar and rod and set of jaws which it draws with it, moves in one direction, while the other friction roller belonging to the same pair of companion rods, and the collar and rod and set of jaws which it draws with it, moves in the opposite

direction. Each set of jaws is fixed nearest to the free-sliding end of the rod that carries it, and farthest from the end to which the collar H is attached. By means of this arrangement the two sets of jaws that face each other on the same pair of rods approach toward each other when the friction rollers that are attached to those rods are drawn in opposite directions from each other, and when the same friction rollers move toward each other the two sets of jaws will move farther apart from each other. By means of the screw thread on each one of the rods F and Fa, and the nuts *d* on each side of the collar H, the rods F and Fa can be moved and adjusted lengthwise, and the two sets of jaws which are fixed to them as described can be moved permanently nearer to each other or farther apart. The friction rollers G bearing against the sectional cam-rods K and Ka fix and control the relative positions of the opposing sets of jaws which stand facing each other in the machine, and by means of screw threads on the bolts C and the nuts *c*, by means of which the sectional cam-rings K and Ka are attached to the frame of the machine, the sectional cam-rings which are opposite to each other across the machine may be moved closer together or farther apart, and in this way the opposing sets of jaws may be moved permanently either nearer together or farther apart, as may be desired. At the inside edge of the jaws next to the back La is cut an annular channel W to receive the can-head. The front edge of the channel W forms an annular shoulder that covers the front edge of the rim of the can-head and forms an abutment against which it may bear. This annular shoulder reduces the open diameter within the jaws so that it is just small enough to surround the end of the can-body and guide it into the rim of the can-head when the can-head is forced forward. From this annular shoulder to the outward edge of the jaw the jaw flares outwardly, thus increasing the diameter of the ring formed by the closed jaws as it extends forward from the can-head channel W. By this arrangement the end of the can-body is received in the inside jaw L at a point where the diameter of the jaw is greater than the diameter of the can-body, and if the can-body is irregular or out of shape it will be enclosed by the jaws and headed the same as though it was exactly round when the jaw received it. In fig. 5 of the drawings is shown a bent lever *m*, which is pivoted at *n*. This lever is bent downward, so as to pass underneath the inside jaw L; after passing underneath the jaw the inner end of the lever rises up between the jaws. At the inner end of the lever *m* is fixed an attachment

that is shaped so as to fit the side of the can-body when one is in the jaws. A friction roller *t*, mounted on the end of a stationary stud *u* is permanently located at the proper point so that the shorter end of the lever *m* will come in contact with it and force the attachment at the inner perpendicular end of the lever against the can, and thereby force it out from its place in the jaws. This should occur after the heads have been forced upon the can-body and just when the jaws have opened and the two sets have slightly drawn apart so as to lossen their pressure on the can, and at the point at which it is desired to eject the headed can from the machine. Each of the outside jaws has fixed to it a long pin P. By means of these pins, and the two pairs of bent rods R R and S T, these outside jaws are opened and closed as explained. Another pair of short cam-rods *rr* are used for unlocking the outside jaws from the inside jaws so as to permit the outside jaws to open at the proper time. The cam-rods RR are bent in a partially spiral form, and located so that the pins PP of two opposite sets of jaws will come in contact with them and be turned by them in the direction desired. The pins PP always come in contact with the cam-rods RR when the outside jaws to which the pins belong are open and the pins are pointing downward. The pins follow along the cam-rods and are turned by them and make the jaws to which they are attached revolve around their hinge pins *h* and close with the inside jaws. A short cam-rod *r* is supported by metal straps attached to the stationary cross-rods 9 and 10 of the machine frame, and is so located that as the machine revolves around the main shaft the under side of the short end of the locking levers *i* will come in contact with the cam-rod *r* and be lifted up and made to unlock the jaws from each other so that they may be separated and opened after the heads have been forced upon the can that is held by them. A similar short cam-rod *r* operates in the same way to unlock the opposite set of jaws, and allow them to be opened also. S and T are two stationary cam-rods that are bent in a partially spiral form, and placed in the position shown in the drawings, so that as the machine revolves the pins PP will come in contact with them when the jaws are closed, and will follow along them lengthwise, and thereby the pins and the jaws to which they belong will be revolved around their hinge pins *hh* and the jaws opened. In forcing the can-heads upon the can-body, the two sets of jaws will advance so nearly together that there will not remain a sufficient amount

of room between them to allow the outside jaws to swing open at the same time without coming in contact with each other. For this reason it is necessary that one of the outside jaws should be partly opened in advance of the opening of the other. To accomplish this result, the cam-rod S extends further up in the machine than does the cam-rod T. One of the pins P, therefore, comes in contact with the cam-rod S before the other pin P comes in contact with the cam-rod T, and the pin P that comes in contact with the cam-rod S and the jaw belonging to it will be revolved and partly opened before the other pin P and the jaw belonging to it will have commenced to open. The cam-rod S is fastened to the cross-rod 9 of the machine above the point at which the pin P comes in contact with it. Q Q are used as guide rods to guard against accidents. After the can has been headed and ejected from the machine, the two sets of jaws in which the can was headed should remain open until they are carried around under the chute and receive another can-body with the heads that are to be placed upon it. While passing along this distance, the outside jaws of the two sets, if left unguarded, are liable to swing partly shut and not be in proper position to pass under the chute when they reach it. For this reason, the guide rods Q Q are so placed that the outside jaws will be prevented from closing as they ascend at the back of the machine, and will be guided so that they will pass under the chute in the proper open position to receive the can-heads and can-body. The upper parts of the rods Q Q above the points at which they cease to act as guide rods are spread apart and carried upward for the purpose of conveniently fastening them to the cross rod 7 of the machine frame. They are also secured lower down to the cross rod 8 of the frame. The ower ends of these guide rods Q Q are bent so their extreme lower ends will reach under and throw out from the machine any can or can body that may accidentally remain in the jaws instead of being ejected from them at the proper place. As shown in the drawings, the chute for the can bodies is made of four pieces of angle iron 2 2 and 3 3, fastened together with metal sheets or cross pieces. The lower end of the chute is made so as to confine the can body as closely as possible and not interfere with its freely passing through the chute. This is in order to prevent its getting wedged by bounding out of its proper position when it strikes the jaws in its downward passage. The chutes for the can heads are placed at the sides of the chute for the can

bodies. Vertical rods 12, 12 serve as the outsides of the head chutes. These vertical rods are held in their positions by suitable brackets 13, extending across the chute and secured to their vertical side pieces, 15. At the inside of their lower ends the rods 12 have fastened to them a thin metal sheet that extends nearly across the chute, to better guide the can heads into the jaws. The rods 12 are cut short so that no part of the jaws can come in contact with them. The thin metal sheets at the inside of the lower ends of the rods extend below the rods. They are hung so as to allow the backs La of the jaws to pass under them, and their inside faces should be in line both vertical and crosswise with the inside faces of the backs La, so that the latter will form a continuation of the front side of the chute, while the can head is passing from the chute into the jaw. In order to more certainly guide each can-head into its channel W in the inner jaw, the chute is divided into two parts; the upper part 14 is a straight sheet of metal fixed rigidly in its position. The lower part 16 of the back extends downward in front of the back La of each passing jaw as far as practicable, and allows the jaw L to pass under it. The can-head passes between this downward extension and the face of the back La. The lower part 16 is so arranged that its lower end may swing toward the back La of each passing jaw, but not far enough in the opposite direction to allow the edges of the can-heads in the chute to pass each other and thus get wedged therein. At each of the opposite corners of the swinging back 16 is fixed a lug 17, by means of which this swinging back is pivoted to the two vertical side pieces 15 of the chute. These pivots are placed at one side of the vertical line of the back so that the weight of the part will cause its lower end when unobstructed to swing toward the back La of the passing jaw. A frame 6 6 is rigidly attached to the cross-rod, as shown in the drawing. Two strong metal sheets 4 and 5 are fastened across the chutes as shown. Below their fastenings these metal sheets are each respectively bent far enough away from the chutes to allow the top of the frame 6 6 and the cross-rod 7 to respectively pass in between the sheets 4 and 5 and the chute. The sheets 4 and 5 are respectively hooked over the top of the frame 6 6 and the cross-rod 7, and hold the chutes in their proper positions. On the sides toward the back of the machine the lower ends of the chutes are curved a little forward for the purpose of delivering the heads and bodies of the cans from the chutes into

the jaws on a line that is radial with the circle in which the jaws revolve around the central shaft.

The operation of the machine is as follows: The chutes are kept filled with can-heads and can-bodies; these stand in columns, resting one upon the other, except the lower ones, which rest upon such part of the jaws as happens to be under them. The machine is set in motion, and as it revolves the jaws will pass under the chutes and each set of jaws will receive the lowest can-body and also the lowest can-head that is in each one of the can-head chutes. The can-heads will be at each end of the can-body in the jaws. The jaws will pass forward from under the chutes carrying can-heads and can-bodies with them, and will be followed with the next sets of jaws, which will in like manner receive the next can-body and next can-heads then in the bottom of the chutes. Each can-body and the can-heads belonging to it will be carried forward by the jaws as fast as they receive them, and the columns of can-bodies and can-heads will constantly descend and fill the places of those thus carried away in the jaws. As the jaws pass forward the pins P P in the outside jaws will strike against the cam-rods R R and those jaws will be turned over and closed with the lower jaws under them. The levers *i* will operate as before described and lock the jaws together with the can-body and can-heads fast enclosed within them. The friction rollers G G belonging to the rod F and Fa which carry that set of jaws will then come in contact with the inclines at the ends of the sectional cam-rings Ka at each side of the machine, and will be drawn further apart, thereby drawing the two sets of jaws toward each other and forcing the can-heads upon the can-bodies. The underside of the short ends of the levers *i* will next strike the upper sides of the cam-rods *rr* and unlock the outside jaws from the inside jaws. Before the short ends of the levers *i i* have passed the entire length of the cam-rods *r r* the pins P P will have struck the cam-rods S and T and opened the jaws far enough so that they cannot close together and be again locked before they shall have been fully opened. As the machine continues to rotate, the jaws will be fully opened, and the friction rollers G G will pass beyond the sectional cam-rings Ka Ka, and will strike the inclines reaching back from the ends of the sectional cam-rings K K. Just as the rollers strike the sectional cam-rings K K, and before the sets of jaws are drawn far enough apart to make it possible for either of the can-heads to be pulled off from the headed can

that is in then, the short end of the bent lever *m* will come in contact with the stationary friction roller *t* and the headed can will be thrown from the jaws. As the friction rollers G G pass along the inclines at the ends of the sectional cam-rings K K they will be pressed toward each other and the two sets of jaws to which they belong will be moved to their farthest limit from each other. They will continue in this position until they have again passed under the chutes ready to repeat their operation by heading another can. All the sets of jaws in the machine operate exactly alike, and each one of the sets repeats the operations above described.

Undoubtedly, this mechanism of Wheaton, like that of complainant's puts tight-fitting can-heads on the outside of can-bodies automatically, to do which there must, of necessity, be mechanism for centering and bringing into exact line with each other the can-body and can-head, and also mechanism for shaping and sizing the can-body and also for forcing the head and body together. Any device, in order to accomplish the desired result, must do these things. But the question is, whether the device of Wheaton, in centering and aligning the can-body and can-heads, and in shaping and sizing the ends of the can-body and in forcing the heads and body together, uses the elements of the claims patented to Norton, or their mechanical equivalents.

It is apparent that the mechanical construction of Wheaton's device is quite different from that of the Norton device, and, as a consequence, that the mode of operation of the two machines is, to some extent at least, different. Some of these differences stated by the appellant we find to be true; in the Wheaton machine the central shaft revolves, while that of the Norton machine is stationary. The devices that Wheaton connects with his central shaft are two disks which are made rigid, and, therefore, revolve with the shaft. The device which Norton attaches to his stationary central shaft is an annular cam made in two like parts, which cam is made stationary, and, therefore, does not revolve. Norton's machine does not have either the revolving central shaft of the Wheaton machine nor the revolving disks which are attached to it in the Wheaton machine. Neither does the Wheaton machine have the stationary shaft nor the annular stationary cams of the Norton machine. The Norton machine has mounted upon its central shaft several sets of arms which revolve around the shaft. The Wheaton machine has no such arms, but has cross-

rods which pass through holes in his disks, and which are parallel with the central shaft. Norton's machine has no such rods. The cross-rods in the Wheaton machine support and carry his sets of jaws crosswise of the machine, and the rods themselves move back and forth crosswise of the machine. Norton's machine has no rods or devices which carry any jaws or molds crosswise of his machine. Except his pistons, he has no devices that move crosswise of his machine, and the sole function of his pistons is to force the can-heads out of the can-head chute into the annular spaces of the molds and thereby on the ends of the can-bodies. The cross-rods of the Wheaton machine are not in the Norton machine, nor is the function which they perform, that of supporting the jaws and moving them forward and backward across the Wheaton machine, performed in the Norton machine at all. That machine does not do that kind of work. In the Norton machine, between the parts of his stationary annular cam there is a ring loosely encircling the main shaft. This ring is provided with radial recesses into which cross-pieces are fitted and slide, serving as guides to the parts operating and moving sides of the mold, and insuring a true movement thereof by the cam. The Wheaton machine does not contain this encircling cam ring with its recesses, nor the cross pieces. None of the work which they perform in the Norton machine is done in that of Wheaton. The molds of the Norton machine open in the direction of its periphery. They seize and hold in one immovable position the can-body directly in line with the heads that are in the body of the can-head chute. The jaws of the Wheaton machine do not open in the direction of its periphery, but open and close crosswise with the machine. The devices for opening and closing the molds of the Norton machine are different from those for opening and closing the jaws of the Wheaton machine. In the Wheaton machine there are two sets of jaws facing each other, which move back and forth crosswise of the machine, and, while moving towards each other, they carry the can-heads towards each other, shape and size the ends, but only the ends, of the can-body that is between them, and then force the heads upon the body. In that machine, the ends of the can-body are received upon the lower part of the flaring jaws. The flaring makes those parts of the jaws which receive the ends of the can-body considerably lower than is the bottom of the edge of he can-head that is in its place in the jaws. When the can-ody is thus received in the jaws it is loose, and rests by

force of its own gravity upon its extreme ends and below the level of the can-heads. In this position it lies loosely. The jaws of the Wheaton machine, with the can-body in this position, move towards each other, and in so doing, the smaller diameter of the cone-shaped hollow in the jaws travels to the ends of the can-body. This causes the ends of the body to be raised by the flaring in the jaws until the body registers with the can-heads. In the Norton machine, the interior of the mold, except at its ends, where exist the annular spaces, conforms accurately in shape and dimension to the exterior of the can-body, and the mold when closed upon the can-body holds it firmly in an immovable position, while the heads are forced by the pistons from their place in the can-head chute into the annular spaces of the mold and thereby applies them to the outside of the can-body—the movement of the heads towards the can-body being a horizontal one.

It is true that at each end of the jaws of the Wheaton machine is cut an annular channel for the reception of the can heads; but it is not true that that machine contains any piston, or any equivalent therefor, for forcing the can heads into those annular spaces and thereby applying them to the outside of the can body. On the contrary, in the Wheaton machine the can heads reach their seat in the annular spaces of the jaw by force of their own gravity, and they are carried in that position in the jaws as they approach each other crosswise of the machine, without any change in the position of the can heads until they are forced on the can body by the coming together of the jaws. The device which, in the Wheaton machine, forces the heads on the can body is not the equivalent of the piston of the Norton machine, for it accomplishes that result, not by forcing the can heads into the annular spaces and thereby applying them to the outside of the can body, but by bringing the jaws together in the essentially different operation already described.

The absence of the piston of the Norton device, or any equivalent therefor, from the Wheaton device is of itself enough to make it necessary to adjudge that the device of Wheaton is no infringement upon the Norton device—the piston being an essential element of each of the combinations covered by the patent of the complainants.

Judgment reversed, and cause remanded, with directions to the court below to dismiss the bill at complainants' cost.

(Endorsed:) Filed Oct. 31st, 1895. F. D. Monckton, Clerk.

I, FRANK D. MONCKTON, Clerk of the United States Circuit Court of Appeals for the Ninth Circuit, do hereby certify the foregoing from page 5 to page 46, both inclusive, to be full, true and correct copies of the bill of complaint (excepting that the drawings are omitted in Exhibit "A," which is a part of said bill of complaint), of the defendant's answer thereto and the replication, and of the opinion of our said Circuit Court of Appeals, in the cause entitled Milton A. Wheaton, Appellant, vs. Edwin Norton and Oliver W. Norton, Appellees, No. 141 in our said Circuit Court of Appeals, as the same appear of record in my office.

WITNESS MY HAND and the Seal of said United States Circuit Court of Appeals for the Ninth Circuit, this 4th day of January, 1896.

[SEAL]

F. D. MONCKTON, Clerk.

165-518

Office Supreme Court, U. S.
FILED
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CLERK.

No. 639.

United States Supreme Court

October Term 1896.

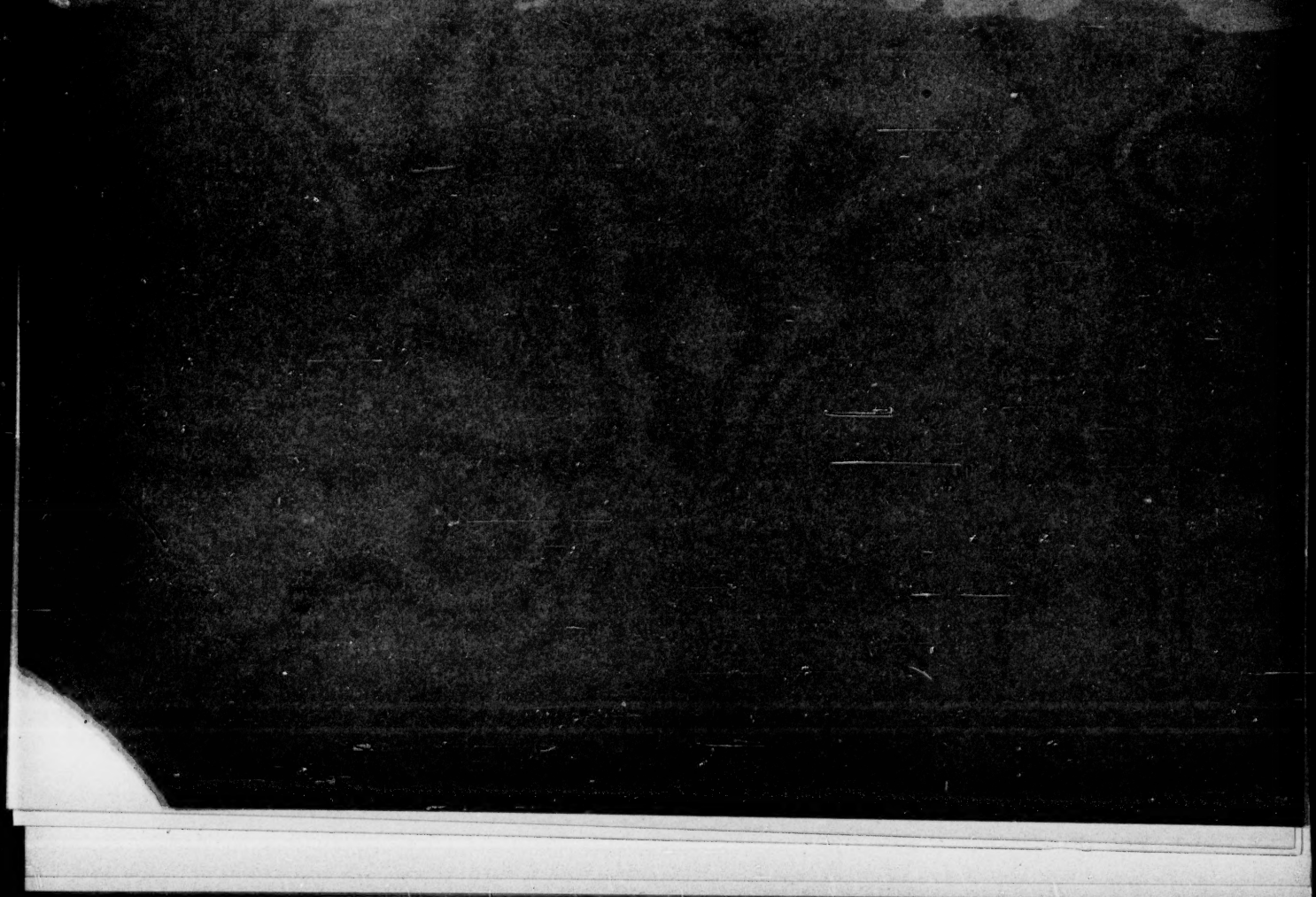
EDWIN NORTON AND OLIVER W. NORTON,
Appellants,

vs.

MILTON A. WHEATON,
Appellee.

In the matter of the application of the above named appellants for a Writ of Certiorari.

Brief of MILTON A. WHEATON, on the order to show cause made herein.



IN THE

SUPREME COURT

OF

THE UNITED STATES.

EDWIN NORTON AND OLIVER W. NORTON,
Appellants,

vs.

MILTON A. WHEATON,
Appellee.

IN THE MATTER OF THE APPLICATION OF THE ABOVE NAMED APPELLANTS FOR A WRIT OF CERTIORARI.

Brief of Milton A. Wheaton Who Appears and Opposes the Granting of Such Writ.

While on this application Edwin Norton and Oliver W. Norton are named as appellants and said Milton A. Wheaton is names as appellee,

none of the said parties hold either of such characters in this proceeding or in any Court. All of the said parties did sustain those characters so long as the case remained in the said Court of Appeals, but after the said Circuit Court of Appeals had finally decided the case and its mandate had been sent down to the Circuit Court from which the appeal had been taken, there were no longer any appellants or any appellee in the case, nor are there now, anywhere along the line of the case, any parties who are appellants in the case or any party who is an appellee in the case.

The said Edwin Norton and Oliver W. Norton have applied to this honorable Supreme Court for a writ of certiorari directed to the Circuit Court of Appeals of the Ninth Circuit commanding that Court to certify and send to this Court a full and complete transcript of the record and all the proceedings of the said Court of Appeals in the case of Edwin Norton and Oliver W. Norton, appellants, vs. Milton A. Wheaton, appellee, as identified by the transcript of the record of said case which was filed in the Court with said petition " to the end that said case may be reviewed and determined by this Court * * * and that said decree of said Circuit Court of Appeals in said case and every part thereof may be reversed "

In response to the said petition this Court on November 16th, 1896, made its order that cause be shown before it on the second Monday of January, 1897, why a writ of certiorari should not issue to bring up the decree of the said United States Circuit Court of Appeals herein. "So that it may be determined whether upon an appeal from an interlocutory appeal granting a term porary injunction in a patent case, the Circuit Court of Appeals can render or direct a final decree on the merits."

This order does not say who may show such cause, but as the said Milton A. Wheaton is one of the parties especially interested in this proceeding, he assumes that he may be permitted to make such showing why the writ should not issue as may be proper, and hence appears and files his affidavit stating material facts in the case and also files this his brief for the same purpose.

Under the order made herein we understand that the only issue to be discussed is the following :

Has a Circuit Court of Appeals the power to direct the Circuit Court to dismiss the action in a case in which the appeal is taken from an interlocutory decree that contains a clause granting an injunction ?

In order to present a strong example of a case in which such action on the part of the Court of

Appeals would be perfectly proper we have made our affidavit, and have enbodied therein and made a part thereof, a duly authenticated copy of the complainant's bill and the defendant's answer thereto shown in the transcript on appeal in the case of *Wheaton* vs. *Norton*, which is the case that is set forth in the petition herein filed and which transcript is indirectly made a part of the transcript on appeal in the case of *Nortons* vs. *Wheaton*, which transcrip is herein filed with said petition, as is shown by the stipulation on page one of said last mentioned transcript, and also by the recitals of the mandate shown on page three of the same.

The patent sued on is made a part of said bill. The said bill also states that the can-ending machines which are alleged to constitute infringements of the complainants' patents were made substantially in accordance with the United States patent that was granted to said Wheaton June 21st, 1892, *and the answer of the defendant admits this allegation*, but denies that such machines constitute any infringement of the complainants' patent.

The said patent to Wheaton was put in evidence, so that with that patent and with the said allegation and the admission of the pleadings that the machines that were made and sold by said Wheaton were made in accordance with the

specification of his patent, there was placed before the Court an exact description not only of the complainants' patent, but also an equally exact description of the machines which were alleged to be an infringement thereof. All that was necessary, therefore, for the Court of Appeals to do in order to decide whether there was any infringement or not was to compare the complainants' patent and the claims thereof with the defendant's patent. Both were simple mechanical patents only, in which no terms of art were employed, and there was no necessity for any expert or other evidence in order to enable the Court to correctly decide whether the defendant's machine infringed the complainants' patent or not.

Heald vs. *Rice*, 104 U. S. 737, page 749.
Miller vs. *Eagle Mauufacturing Co.* 151 U. S., latter part of page 196.

Now, in the petitioners' preliminary brief filed herein, at the first part of page 26, is printed a part of Judge Hanford's opinion, filed on the first decision made by the Court of Appeals, and which decision was afterwards set aside on granting the petition for a rehearing. In this part of Judge Hanford's opinion is recited the fact that the issues to be decided are: "What is the scope of the patent sued on, etc.?" and, second, "*Does the machine devised by the defendant infringe* all or either of the claims of said patent?"

Lower down on the same page of said brief a continuation of the extract from the same opinion shows that *all other grounds were abandoned* by Wheaton, the then appellant.

So here we have it fixed by the record that the only issues on which the case was decided by the Court of Appeals consisted in deciding what was the scope of the complainants' patent, and *whether there had been any infringement of it.* As the evidence upon which the first issue as to the scope of the patent was to be decided the Court had before it the complainants' patent and the file wrapped contents of the patent office appertaining to it. Upon the issue of the infringement the Court had before it the defendant's patent, which the pleadings admitted contained a description of the machines which the defendant made and which were the machines that were claimed by the complainant to constitute the alleged infringement.

A correct decision of the issues involved therefore required *only the construction of these written documents*, the said two patents and the said file wrapper contents.

Under these circumstances it would seem worse than useless to have directed or permitted any further trial of these issued in the Circuit Court after they were once decided by the Circuit Court of Appeals. If a new trial should be had in the Circuit Court it must necessarily have been upon

the same testimony that was before the Court of Appeals, since the pleadings fixed the fact that the defendant's machines were as described in the patent that was before the Court of Appeals, and on a new trial there, the same testimony which was already taken and on file in the Circuit Court would still remain as the testimony in the case and this included the complainants' patent and the said file wrapper contents, and the defendant's patent, and the said admission of the pleadings.

These facts and evidence were matters of record that could not be changed on a further trial and the result of a new trial in the Circuit Court must be one of two things. It must either decide on the same facts, as fixed by the pleadings and *by* the said testimony, just as the Court of Appeals had decided, or it must become contumacious and declare that the Court of Appeals had not decided rightly and that it would not be bound by its decision, and again enter a decree for the complainants in which it would grant another injunction in spite of the Court of Appeals.

If as a fact the Court of Appeals had and has no power to direct the lower court to dismiss the complainant's bill then we have this possiblity presented as a course of practice which the law is powerless to prevent, viz: The Circuit Court may enter its usual interlocutory decree adjudging that the complainants' patent is valid and that it has been infringed, when as a matter of fact the

patent is absolutely void for its face as not covering any patentable invention, and when, whether valid or not, it has not been infringed. On appeal from such decree the Circuit Court of Appeals correctly and properly decides that the patent is invalid and also decides that it has not been infringed, and reverses the interlocutory decree, but not being able to order the case dismissed simply remands it to the Circuit Court. The Circuit Court again enters on the same old testimony another interlocutory decree exactly like the first one which the Court of Appeals has reversed, refusing to acknowledge that the decision of the Court of Appeals has any force or validity or power over the Circuit Court, or over its action. This process may be continued indefinitely and the same defendant be constantly kept under the alternating process of being enjoined one month and liberated the next only to be again enjoined and again liberated. Whatever regard the Circuit Court might have for the decision of the Court of Appeals in any given case where the appeal was taken from an interlocutory decree would be due to its good-natured respect for the higher court, but nothing would be due to the power of the higher court, as it would have no power to control the decree that the Circuit Court should enter after reversing any of its said interlocutory decrees.

Of course, whenever the fact is fixed by permanent record testimony, that cannot be changed on any future trial, that there is and has been no infringement of the complainants' patent there is nothing further to try. And when, as in the present case, the Court of Appeals makes its final decision to the effect that what the defendant makes, or uses, or sells does not constitute any infringement of the complainants' patent, the whole case is ended. It is not like a decision which merely holds that the complainant has failed in proving an infringement which may in fact exist and which the complainant may be able to prove on another trial, nor is it like a case in which there are special circumstances which make it inequitable that an injunction should issue. But it is a case in which what the defendant did was definitely and immutably fixed by the pleadings and by the introduction of his patent. What he did *was all* before the Court. The whole that the defendant did was specifically stated by the complaint and was frankly admitted by the answer. There was no failure for lack of full proof in knowing what the defendant did. It was a case in which the issue of infringement was as fully shown as it ever could have been shown in a trial in which the case had gone on to an accounting and a final decree had been entered. In such case there is no question but that the Court of Appeals would have the power to direct

the lower court to dismiss the action. So far as the issue of infringement was concerned, the record was just the same, and the testimony just the same, all just as full and constituted just as firm and solid a foundation for a correct decision upon the issue of infringement as it could or would have done if the case had gone to an accounting and a full and final decree had been entered before the appeal had been taken. If that final decree had been entered before the appeal had been taken, the Court of Appeals would have decided the issue of infringement upon that portion of the record which contained the showing as to whether there was or was not an infringement, and would have decided that there was no infringement and would have reversed the entire decree, the interlocutory as well as the final, and would have directed the Circuit Court to have dismissed the action. All this the Court of Appeals would have had indisputable power to do. Yet the only portion of the record of the case which it acted upon would have been that portion which ended with the entry of the Interlocutory decree.

The law allows an appeal from the *whole entire interlocutory decree.* Section seven of the act of 1891, cited by petitioners, says that "where "an injunction shall be granted or continued "by an interlocutory order or decree, in a cause "in which an appeal from a final decree may be

" taken under the provisions of this act to the " Circuit Court of Appeals, an appeal may be " taken FROM SUCH INTERLOCUTORY ORDER OR DE- " CREE granting or continuing such injunction to " the Circuit Court of Appeals": &c. The appeal is *not to be taken from a portion* of the order, nor *from a portion of the interlocutory decree but from the whole of it.*

If an interlocutory decree grants an injunction or if it continues an injunction an appeal may be taken from the decree and from the whole of it. Just what disposition shall may be made of the appeal by the Court of Appeals is not specifically stated, but it is certain that the Court is not in any way circumscribed in its appellate jurisdiction on such appeals by any terms to be found in the act, but it is left with its full appellate powers to be exercised on such appeals the same as upon other appeals.

And here we call the attention of this Court to the general rule that pertains to the equity jurisdiction of the courts in patent cases. In cases like the one of *Norton* vs. *Wheaton* where the complainant has a full legal title to his patent and there is a simple charge of ordinary infringement made against the defendant equity can take jurisdiction of the case *only because of the complainants' right to have an injunction granted* to him in the case. If he has a right to an injunction

he may go into a court of equity with his case, but if he has no right to an injunction he has no remedy except a recovery of damages for the infringement, and this, being a legal remedy only, *he must pursue it in a court of law.* There are some exceptions to this general rule which, however, are of no importance here.

When, however, the complainant is entitled to an injunction and brings his suit in equity the court of equity does not rest with merely adjudicating upon the right to the injunction, *but it takes full possession of the case and retains it for the adjudication of all issues that may arise in it both legal and equitable.*

Root vs. *Railway Co.*, 105 U. S., 189—See last two lines on page 215 and page 216.

Keys vs. *Eureka Mining Co.*, 158 U. S., 150.

Clark vs. *Wooster*, 119 U. S. ,322.

Waterman vs. *McKenzie*, 138 U. S., last quarter of page 257.

This is the regular practice and we think the principle ought to be applied to these cases in which an appeal is taken from an interlocutory decree that grants or continues an injunction. While it is the granting or continuing of the injunction alone that authorizes the appeal to be taken and that alone which allows the Court of Appeals to

take any appellate jurisdiction of the case, it is still the fact that the appeal is taken from the *entire decree* and being so taken, we urge, that the appellate jurisdiction attaches to the entire decree and it may adjudicate upon the entire decree and decide the issue of infringement as well as the correctness of the granting or continuing of the injunction, just as a Court of Equity takes full jurisdiction of an entire patent case, although it only gets *any* jurisdiction of it because a right to the injunction is shown.

That this ought to be so is well illustrated by the adjudication of the Court of Appeals in the case of *Norton* vs. *Wheaton*. No attempt was made in that case to defeat complainants' patent. The issue was made upon the *one question of infringement* The patent was admitted to be valid when construed in connection with the file wrapper. The right to an injunction in the case therefore rested upon the outcome of the answer to the question of infringement. *If there was an infringement the complainants were entitled to their injunction. If there was no infringement, of course, they were not entitled to an injunction.*

In order, therefore, to determine whether the complainants were entitled to the injunction, the Court of Appeals had first to decide the issue of infringement and it adjudged that there was no infringement. The adjudication was that the

machines which the defendant made were not covered by the complainants' patent. That therefore there was no infringement, and *because there was no infringement there was no right to the injunction.* The one vital and foundation and first issue to be decided under any view of the case was that of infringement. That the Court of Appeals had jurisdiction of that portion of the interlocutory decree which granted the injunction must be conceded. The issue of infringement and the right to the injunction were one and inseparable and went hand in hand together, except that the infringement must be decided first.

While this is an indisputable fact the petitioners have not made any full presentation of it, but have argued their case in their preliminary brief, (if they have made any other brief herein we have not seen it and know nothing of what it contains), just as though the Court of Appeals could have decided upon the right to the injunction without deciding whether there had been any infringement or not.

Now while the adjudication of the Court of Appeals that there was no infringement was decisive against the complainants right to an injunction it was equally decisive against their right to maintain their action. In this particular case the lack of any infringement was equally conclusive against the complainants' right to an injunction

and against their right to maintain the action, as, without any infringement the complainants had no cause of action whatever and without any cause of action they had no right to recover any thing from the defendant.

When therefore as in this case it became necessary for the Court to decide that there was no infringement in order to decide that the interlocutory decree was wrong in granting the injunction, it became necessary for it to decide in effect that the complainants had no cause of action in the case. The adjudication of both these issues by the Court of Appeals was necessary and legitimate and when it decided that there was no infringement and therefore there could be no cause of action, we submit that it was within its power to give full force and effect to its decision by directing the Circuit Court to dismiss the action. The entire interlocutory decree was before it; it must pass upon the portion that granted the injunction, and the whole decree being before it for one purpose it would retain within its jurisdiction the entire decree for all purposes and would decide all questions involved in it that could properly arise upon the appeal.

We are aware that the only question to be discussed on the present application is that of the power of the Court of Appeals to direct in any case a Circuit Court to dismiss the action in

which an appeal has been taken from an interlocutory decree granting or continuing an injunction. We have put so much of the record of the case in the two appeals of *Wheaton* vs. *Nortons* and *Nortons* vs. *Wheaton* as is embodied in our affidavit for the purpose of showing a case that would illustrate the propriety of so construing the law of 1891, and not for the purpose of having the Supreme Court pass upon the correctness of the adjudications made in the case. While we have no further argument to make, we still desire to call the attention of this Court to the specification of the particulars that was made by the Court of Appeals in its final decision in the case, showing that there was no infringement. The entire decision is embodied in our said affidavit, and it is also reported in 70 Fed. Rep. 833. The part of the decision showing no infringement is on pages 851, 852 and 853 of the said 70 Fed. Rep., beginning with the last paragraph on page 851. As there stated by the Court of Appeals, the first piece of mechanism is a *stationary*, immovable shaft in the complainants' patent, and a *revolving* shaft in Wheaton's machine, and from these two initial devices, which are of diametrically opposite characters as to their operations, all the way through the machines there are no two corresponding devices, no two that do the same work or that operate alike, but the entire machines are built on different plans, are of diff-

erent construction and operation, and are made up of entirely different mechanism from beginning to end. It did not require the said file wrapper contents to limit the scope of the complainants' claims in order to show that there was no infringement.

The claims of the complainants' patent do not cover the machine described in the patent, but only sub-combinations of a limited portion of the devices contained in the machine.

We also urge that all the reasons applicable to the question under discussion are in favor of giving to the Court of Appeals the right to direct the Circuit Court to dismiss the case. Of course, the Court will only exercise this power when it ought to exercise it. Whenever as in the present case, however, the very issues involved in the appeal require and force a decision from the Court of Appeals that there is no infringement, then there is an adjudication in effect that there is no cause of action, and in such a case the Circuit Court of Appeals should have the power to direct the lower Court to dismiss the case. Such a power is proper and has been constantly exercised by the United States Appellate Courts, including this Supreme Court in cases where appeals have been taken from final decrees, and the same reasons which make the exercise of the power proper on appeals taken from final decrees apply

equally to making the exercise of the power proper on appeals from the interlocutory decrees.

In addition we urge that in this instance the application for a writ of certiorari comes too late. As shown by the petitioners own record they allowed the mandate to go down from the Court of Appeals to the Circuit Court, before the made this application. By doing so the Court of Appeals lost all jurisdiction over the case and its judgment became final and forever conclusive upon the parties. The case had then gone to the highest Court of Appeals, to which it could be taken (the mandate having gone down the case could not then be taken to the Supreme Court,) and the decision of that Appellate Court had become the law of the case and its decree had become forever final. We have already filed a prior brief in this Supreme Court in these proceedings citing authorities as to the final character of the decree of the Court of Appeals after its mandate had been sent down to the Circuit Court, and to that brief we beg leave to refer the Court and ask that it be considered as a part of this argument.

As additional authorities upon the general question here submitted we call attention to the Decisions of several of the different United States Courts of Apdeals in which they have reversed these interlocutory decrees with direction to the lower Courts to dismiss the actions.

We append the following list of such decisions, which have been made by the United States Circuit Court of Appeals in the first, second, third, fifth, sixth, seventh and ninth United States Circuits, viz.

Cases in Which Interlocutory Decrees of Circuit Courts were Reversed with Directions to Dismiss the Bill by the Circuit Courts of Appeals.

Dudley E. Jones Co. vs. *Munger Improved Cotton Machine Man. Co.*, 49 Fed. Rep., 61; 1 C. C. A. Rep. 158; 5th Circuit.

Richmond vs. *Atwood*, 52 Fed. Rep., 10; 2 C. C. A., 596; 1st Circuit.

American Heat Insulating Co. vs. *A. Johnston & Co.*, 52 Fed. Rep., 228; 3 C. C. A., 53; 3rd Circuit.

Johnson R. R. Signal Co. vs. *Union Switch & Signal Co.*, 55 Fed. Rep., 487; 5 C. C. A., 204; 3rd Circuit.

Christie vs. *Seybold*, 55 Fed. Rep., 69; 5 C. C. A., 33; 6th Circuit.

Featherstone vs. *Bidwell Cycle Co.*, 57 Fed. Rep., 631; 6 C. C. A., 487; 2nd Circuit.

Temple Pump Co. vs. *Goss Pump & Rubber Bucket Manufacturing Co.*, 58 Fed. Rep., 186; 7 C. C. A., 174; 7th Circuit.

Northwestern Stove Repair Co. vs. *Lee*; 58 Fed. Rep., 182; 7 C. C. A., 160; 7th Circuit.

Jensen vs. *Norton*, 64 Fed. Rep., 599; 12 C. C. A., 324; 9th Circuit.

Card vs. *Colby*, 64 Fed. Rep., 594; 12 C. C. A., 319; 7th Circuit.

Butte City Street R. R. Co. vs. *Pacific Railway Co.*, 60 Fed. Rep., 410; 9 C. C. A., 41; 9th Circuit.

Krick vs. *Jansen*, 61 Fed. Rep., 847; 10 C. C. A., 114; 2nd Circuit.

E. C. Atkins & Co. vs. *Park, et al.*, 61 Fed. Rep., 953; 10 C. C. A., 189; 6th Circuit.

Schoemaker vs. *Merrow*, 61 Fed. Rep., 945, 10 C. C. A., 181; 3rd Circuit.

Union Switch & Signal Co. vs. *Johnson R. R. Signal Co.*, 61 Fed. Rep., 940; 10 C. C. A., 176; 3rd Circuit.

Westinghouse, et al., vs. *Edison Electric Light Co.*, 63 Fed. Rep., 588; 11 C. C. A., 342; 3rd Circuit.

Westinghouse Air-Brake Co. vs. *New York Air-Brake Co., et al.*, 63 Fed. Rep., 962; 11 C. C. A., 528; 2nd Circuit.

Wells vs. *Curtis*, 66 Fed. Rep., 318; 13 C. C. A., 494; 6th Circuit.

Michigan Cent. R. Co. vs. *Consolidated Car Heating Co.*, 67 Fed. Rep., 121; 14 C. C. A., 232; 6th Circuit.

Jansen Can Filling Machine Co. vs. *Norton*, 67 Fed. Rep., 236; 14 C. C. A., 383; 9th Circuit.

Withington-Cooley Manufacturing Co. vs *Kenny*, 68 Fed. Rep., 500; 6th Circuit.

Wright & Colton Wire Cloth Co. vs. *Clinton Wire Cloth Co.*, 67 Fed. Rep., 790; 14 C. C. A., 646; 1st Circuit.

Ney vs. *Manufacturing Co.*, 69 Fed. Rep., 405; 6th Circuit.

Union Iron Works vs. *Smith*, 69 Fed. Rep., 827.

Erie Rubber Co. vs. *American Dunlop Tire Co.*, 70 Fed. Rep., 58, p. 65. 3rd Circuit.